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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a. CUBATABACO,

Petitioner,

v.

GENERAL CIGAR CO., INC.,

Respondent.

Cancellation No. 92025859

PETITIONER'S OPENING TRIAL BRIEF

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Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco ("CT"), a Cuban company, respectfully submits this Trial Brief in support of its petition to cancel Respondent General Cigar Co., Inc. ("GC")'s Reg. No. 1147309 (Feb. 17, 1981) and Reg. No. 1898273 (June 6, 1995) of COHIBA for cigars.

DESCRIPTION OF THE RECORD

The portions of the record on which CT relies include:

- Trial declarations and certain oral examinations of GC's former President (Willner), CT counsel's paralegals (Martini, Bailey, Licata, Suarez, Murdock and Ruiz), CT investigators (Girolami, Bailey, Gregg, Gluth and Linehan), CT's legal counsel (Fernandez), Dir. of Marketing for Cuban Cohiba (Babot), Shkumbin Mustafa, current GC employees (Abbot and Richter); and GC's expert (Hacker);
- CT's discovery depositions and related exhibits of GC employees responsible for GC's Cohiba cigar (Abbot, Richter, Martinez, Lahmann, Maturen, and Jaworski), a market researcher for GC (Cullen) and GC's expert (Hacker); and GC's deposition and related exhibits of a former GC employee (Smith), a CT expert (Ossip), GC's outside marketing agency's account director (Harris), and a salesman/asst. manager at a U.S. cigar chain (Labor);
- Evidence and discovery from the federal action between the parties, 97 Civ. 8399 (S.D.N.Y.);
- The PTO file histories for CT's application to register COHIBA and GC's registrations;
- The parties' pleadings and TTABVUE papers in this proceeding; and
- GC's [redacted] filings in legal proceedings against third-parties concerning COHIBA, and publications concerning COHIBA.

Appendices A and B describe the evidence and its admissibility, and evidentiary objections, respectively.

STATEMENT OF THE ISSUES

1. Is cancellation of Registration No. 1147309 (February 17, 1981) required:
   a. Under Article 8, Pan-American Convention;
   b. On account of GC's fraudulent Section 15 Declaration of five years of continuous use, or
   c. On account of abandonment from more than 5 years of non-use without intent to resume use?

2. Is cancellation of Reg. No. 1898273 (June 6, 1995) required:

a. Under Article 8, Pan-American Convention;

b. On account of CT's analogous use (promotion) in the U.S. prior to GC's Dec. 1992 use and registration application, and a likelihood of confusion either (i) were, as intended, CT's Cohiba cigar to enter the U.S. market for sale upon relaxation of the embargo or (ii) at the present time; or

c. On account of GC adopting and registering COHIBA in Dec. 1992 for a new cigar product in order to exploit and capitalize upon the Cuban Cohiba's renown and reputation in the U.S.?[1]

3. Does GC's failure to allege any facts to support or clarify its conclusory assertion of its remaining Affirmative Defenses require their dismissal, and are those Affirmative Defenses otherwise meritless?

INTRODUCTION

On January 15, 1997, CT applied to register COHIBA for cigars and related goods in IC 34 on the basis of its Cuban registration, and petitioned to cancel the two GC registrations for COHIBA at issue here. The Examiner has refused CT's application because of likelihood of confusion with the GC registrations. The instant proceeding is before the Board on the Federal Circuit's vacatur of its dismissal of CT's Amended Petition. *Empresa Cubana del Tabaco v. Culbro Corp.* 753 F.3d 1270, 1276, 111 USPQ2d 1058, 1065 (Fed. Cir. 2014). Previously, the proceedings had been stayed pending the outcome of a lengthy federal court action. There, the District Court ordered cancellation as well as other relief. Its judgment was vacated on grounds that, as the Federal Circuit held, are unrelated to any of the issues now before the Board.

Cubatabaco, a Cuban company, invokes the protection of the General Inter-American Convention for Trademark and Commercial Protection, 46 Stat. 2907 (1929) ("Pan-American Convention"), to which the U.S. and Cuba are parties, U.S. Dep't of State, Treaties in Force 534 (2020), with respect to both GC

[1] As the Board has rejected Article 6*bis*, Paris Convention, and the well-known marks doctrine as grounds for cancellation, *Bayer Consumer Care AG v. Belmora LLC,* 90 USPQ2d 1587 (TTAB 2009); *Sun He Jung v. Magic Snow,* 124 USPQ2d 1041 (TTAB 2017), CT does not argue its Ninth and Tenth Grounds for cancellation but simply preserves them for any appeal.

registrations. With respect to the first registration, Article 8 requires cancellation upon a showing *either* that GC knew of COHIBA's use, employment or registration in Cuba when it applied to register COHIBA in 1978 *or* when GC adopted and used COHIBA by bringing the mark out of its trademark maintenance program for commercial use for the first time in 1982. CT proves both.

As to the second registration, it is *undisputed* that, when GC applied for a second time to register COHIBA for cigars in Dec. 1992, it knew of the use, employment or registration of COHIBA in Cuba.

It is therefore unnecessary for the Board to address other grounds for cancellation. Nonetheless, CT presents alternative grounds for cancellation with respect to each GC registration.

As to the first registration, two alternative grounds are shown. First, GC's section 15 Declaration of five years' continuous use was fraudulent. Second, the registration must be cancelled because, as the District Court found on the same evidence presented here, GC abandoned the mark through more than five years of non-use without intent to resume use, from 1987 to Dec. 1992.

As to the second registration, cancellation is, in the alternative, required under the analogous use doctrine. CT's spectacularly successful promotion of its Cohiba cigar through *Cigar Aficionado*, which shaped the U.S. market, established the extraordinary reputation and renown of the Cuban Cohiba *prior to* GC applying to register the mark and launching a new COHIBA-branded product in Dec. 1992. Likelihood of confusion is properly assessed were the CT product on sale in the U.S. *post*-embargo, as intended, along with the GC product; there can be no doubt of likelihood of confusion then. CT also shows likelihood of confusion even now, through overwhelming proof. GC's position that the embargo sufficiently dispels same name/same goods confusion is unsupported, and also fails in the face of CT's proof.

Also with respect to the second registration, Section 14(3) requires cancellation. GC has misrepresented, and has permitted its retailers to misrepresent, its COHIBA-branded cigar as having the same original source as the Cuban cigar.

Those of GC's Affirmative Defenses not already rejected by the Federal Circuit must be dismissed as not adequately plead: GC alleges no facts at all to support (or even clarify) its conclusory assertion of laches, acquiescence, estoppel and the like. They also otherwise lack merit.

RECITATION OF FACTS

Procedural History. On January 15, 1997, CT applied to register COHIBA for cigars and related goods in IC 34 based on its Cuban registration, CT Application Serial No. 75226002, 169 TTABVUE 162-63, and petitioned to cancel the two GC registrations for COHIBA in IC 34 at issue here, 1 TTABVUE.[2] The Examiner has refused CT's application because of likelihood of confusion with the GC registrations. 169 TTABVUE 3, 105, 152-55.

Proceedings on CT's cancellation petition were suspended on January 28, 1998 pending the outcome of the action commenced by CT against GC for an injunction, disgorgement of profits, and cancellation of its registrations, *Empresa Cubana del Tabaco, dba Cubatabaco v. Culbro Corp. and General Cigar Co., Inc.,* 97 Civ. 8399 (S.D.N.Y.) ("*Empresa*" or "Federal Action"). 15 TTABVUE. After reviewing evidence that is presented here, the District Court (Sweet, J.):

(a) Granted summary judgment cancelling GC's 1981 registration on grounds of abandonment, 213 F. Supp. 2d 247, 267-71 (S.D.N.Y. 2002); and

(b) after a lengthy bench trial, cancelled GC's 1995 registration and enjoined its use of COHIBA on finding that CT had priority over GC based on the "well-known marks" doctrine and there was current likelihood of confusion. 70 USPQ2d 1650, 1655-82 (S.D.N.Y. 2004).

Although of no preclusive effect because the District Court's judgment was reversed and vacated on grounds unrelated to this cancellation proceeding, the Board can and should consider its detailed assessment of the evidence and legal conclusions for their persuasive value. *See*, *e.g., Silverman v. Miranda*, 213 F. Supp. 3d 519, 530 (S.D.N.Y. 2016).

[2] Culbro Corporation, related to GC, assigned Registration No. 1147309 to the latter in 1987. 61 TTABVUE (Amended Petition, ¶¶ 2, 3, 46); 62 TTABVUE (Answer). For convenience, the two companies will be referred to as General Cigar Co., Inc. ("GC").

Without disturbing the District Court's findings and legal conclusions, the Second Circuit reversed and vacated the District Court's judgment on the basis of the Cuban Assets Control Regulations ("CACR"). 399 F.3d 462, 476-77 (2d Cir. 2005). After further proceedings in the federal court,[3] the Board resumed proceedings on CT's cancellation petition. 60 TTABVUE.

On March 14, 2013, the Board granted GC's motion for summary judgment dismissing CT's Amended Petition, 75 TTABVUE. The Federal Circuit unanimously reversed, holding that: (a) the CACR did not bar the instant cancellation proceeding; (b) none of CT's claims for cancellation were barred by claim or issue preclusion; (c) CT had standing; and (d) CT has a cause of action under the Trademark Act to petition the Board to cancel the Registrations. *Empresa*, 753 F.3d at 1274, 111 USPQ2d at 1062.

After remand, the Board resumed proceedings on Oct. 28, 2015. 88 TTABVUE. Following extensive discovery and motion practice, trial began in October 2018 and concluded on April 2, 2021.

Summary of Facts. For the sake of clarity and context, CT presents the relevant facts in detail, with citation to the record, under each point of the Argument. It provides a brief summary here.

Cubatabaco applied to register COHIBA in Cuba in 1969; the registration issued in 1972. Beginning in 1970, its COHIBA-branded cigar was sold at retail stores, hotels and restaurants in Havana, and also to the Cuban Government, which used it as a state gift. GC learned of the Cuban Cohiba and applied to register COHIBA in the U.S. in March 1978; [redacted]

From Feb. 13, 1978, when it added COHIBA to its "trademark maintenance program" for up to 33 marks, to Nov. 1982, GC attempted to reserve the mark through a practice that could not, and was not intended to, expose the mark to consumers or establish goodwill. In Nov. 1982, upon deciding to fill a market niche and selecting COHIBA from the 33 marks it had reserved, GC began commercial sales. Notwithstanding that there had been no commercial use for almost two years, and being advised by counsel that its trademark maintenance program was legally insufficient, GC filed a section 15

[3] *Empresa Cubana del Tabaco v. Culbro Corp.*, 478 F. Supp. 2d 513, 21-22 (S.D.N.Y. 2007), *aff'd*, 541 F.3d 476, 479 (2d Cir. 2008); 89 USPQ2d 1834 (S.D.N.Y. 2008) *rev'd*, 97 USPQ2d 1510 (2d Cir. 2010).

Declaration of five years of continuous use. After meager and dwindling sales from 1982 to early 1987, GC discontinued use of a COHIBA-branded cigar, without intent to resume use, for more than five years.

General Cigar filed a new application to register COHIBA and put a new COHIBA-branded cigar on the market in Dec. 1992, after publication of *Cigar Aficionado'*s premier issue. It did so, in its own words, in order "to exploit the popularity, familiarity, brand recognition and overall success of the Cuban Cohiba." CT had promoted its cigar in the U.S. through the premier issue of *Cigar Aficionado*, which shaped the U.S. market, with spectacular success. [redacted]. GC's expert acknowledges that the "Cuban COHIBA [is] well known in the United States among premium cigar smokers;" it is "*the* cigar" (emphasis in original).

Undoubtedly, were the Cuban Cohiba for sale on the U.S. market after relaxation of the embargo, as CT intends, there would be a likelihood of confusion between the identical GC and CT marks. In addition and alternatively, there is a likelihood of confusion even now.

ARGUMENT

I. Cancellation of Registration No. 1147309 (February 17, 1981)

A. Article 8, Pan-American Convention, Requires Cancellation (Fifth Ground)

The Pan-American Convention, Article 8 applies when, as here, a registration application has been refused (or when there is a "potential of refusal") on account of the challenged registration. *Lacteos de Honduras, S.A. v. Industrias Sula, S. de RL De CV*, No. 91243095, 2020 WL 973178, *4 (TTAB Feb. 28, 2020). Article 8's requirements for cancellation are met.

> *"Legal protection" in Cuba "prior to the date of the application for the registration or deposit which he seeks to cancel," Art. 8(a).*

In 1969, CT applied to register COHIBA in Cuba in IC 34 for cigars and other tobacco products and cigar accessories; the registration issued on May 31, 1972. 319 TTABVUE 374, 392-397; 190 TTABVUE 233-235 (Garrido, CT's counsel). GC applied to register COHIBA later, on March 13, 1978. 62 TTABVUE 10.

"Knowledge of the use, employment, registration or deposit" of COHIBA in Cuba for cigars either "prior to [GC's] adoption and use thereof" or, alternatively, "prior to the filing of the application or deposit of the mark which is sought to be cancelled," Art. 8(b)

(1) *Prior to GC's Filing Date, March 13, 1978*

[redacted]

A month earlier, on Nov. 15, 1977, *Forbes* published an article, *Help From Havana? The U.S. Cigar Industry is in Bad Odor. Can Cuban Tobacco Help it Relight?*, reporting that the Cuban Cohiba was one of the "brands" that "CubaTobacco . . . is now developing" for export. 192 TTABVUE 62-66. Edgar Cullman, Sr., GC's Chair and President with a controlling interest in the company, received *Forbes*; he admitted that he "must have read" the article. 342 TTABVUE 1460, 1467-1468, 1499, 1500. His son, Edgar Cullman, Jr., Executive VP and later President, 341 TTABVUE 2, 4, admitted that the article would have come to management's attention. 342 TTABVUE 976, 1104-1105. It was the "type of article that would have been circulated to the industry" by Cigar Association of America. 343 TTABVUE 896, 967-969 (Kowalsky, CAA's president at the time). GC's knowledge that COHIBA was a "brand," and being developed for export, necessarily establishes its knowledge that COHIBA was being "used" and/or "employed" in Cuba.

General Cigar's information was accurate. By 1970, COHIBA-branded cigars were being produced in Cuba in substantial numbers,[4] and, from 1970 through March 13, 1978, were sold (a) at two retail outlets in Havana; (b) at Havana's main hotels; (c) at Havana's upscale restaurants; (d) to the Council of State (which includes the office of the Cuban President); and (e) to another Cuban state

[4] Annual production in 1970-75 was approximately 350,000-375,000 cigars; production grew to 450,000 in 1975 and rose to 550,000-600,000 by 1980. 343 TTABVUE 626, 636-637, 640-641, 647-649 (Gonzalez, administration, El Laguito factory).

enterprise, which in turn sold the cigars to government institutions.[5] Cuba's President, Fidel Castro, used Cohiba cigars purchased by the Council of State as gifts throughout the 1970s,[6] including to U.S. persons[7] (the brand, reputedly his personal favorite, became widely associated with him[8]), as did Cuban government bodies,[9] including to U.S. persons;[10] and the Cuban diplomatic missions in New York and Washington, D.C.[11]

Even apart from its knowledge of the Cuban Cohiba's commercial "use" or "employment" in Cuba, its knowledge in 1977 that the Cuban Government gave Cohiba cigars as a state gift, 62 TTABVUE 11 (Answer, ¶ 25); 342 TTABVUE 268, 288-290 (Boruchin) (GC salesman who told Cullman, Sr. that "the brand Cohiba that was given for diplomats and people that have business with the government"), establishes knowledge of "use" and/or "employment." The ordinary meaning of those

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[5] *At retail outlets:* 343 TTABVUE 626, 652-653 (Gonzalez); 198 TTABVUE 147-159 (Gonzalez); 346 TTABVUE 547, 558-563, 607-608 (Martinez, planner for Cubalse). *At hotels* (Habana Libre, Hotel Riviera, Hotel Nacional, Hotel Capri); 343 TTABVUE 626, 653-655, 685 (Gonzalez), 346 TTABVUE 547, 558-560, 564, 573, 610 (Martinez). *At restaurants*: 343 TTABVUE 282, 299 (Fuller, U.S. journalist). *To the Council of State and Cuban enterprises:* 343 TTABVUE 626, 656-657, 662-663 (Gonzalez); 198 TTABVUE 147-159 (Gonzalez); 344 TTABVUE 1071, 1079-1093 (Perez Valdes). Numerous U.S. travelers observed Cohiba on sale at hotels and retail outlets during these years. 343 TTABVUE 998, 1022, 1024 1033 (Landau, U.S. journalist); 343 TTABVUE 282-300 (Fuller); 346 TTABVUE 98, 107, 131-132 (Sherman, former press secretary to VP Humphrey); 346 TTABVUE 631, 639-642 (Withey, U.S. lawyer).

[6] 343 TTABVUE 626, 656-661, 673 (heads of state); 319 TTABVUE 400-411 (heads of state); 343 TTABVUE 626, 673 (when traveling abroad); 345 TTABVUE 253, 296-297 (at Conference of Non-Aligned in Havana).

[7] *See e.g.,* 339 TTABVUE 188-198 (gifts to numerous U.S. journalists and political personalities); 343 TTABVUE 998, 1024-1027 (gifts to Landau and Dan Rather of CBS); 346 TTABVUE 98, 114-119 (gifts to leader of Minn. Chamber of Commerce delegation for VP Mondale and Sen. Humphrey).

[8] 345 TTABVUE 253, 279-281 (Plasencia, interpreter); 346 TTABVUE 631, 636-646 (Withey); 343 TTABVUE 998, 1062-1064 (Landau); 340 TTABVUE 746-753 (Smith, U.S. State Department).

[9] 339 TTABVUE 188, 195 (Jones, U.S. business consultant) (wide range of institutions); 345 TTABVUE 253, 271-275 (sports federation); 343 TTABVUE 998, 1028 (Foreign Ministry).

[10] 339 TTABVUE 188, 195 (Jones).

[11] 343 TTABVUE 998, 1028-1029, 1037, 1071-1074, 1079-1080 (Laudau) (routinely distributed at receptions and as gifts).

terms applies to state gifts, and, moreover, "gifts" and "give-away[s]" establish trademark rights if, as here, they are public, generating good will, 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:118 (5th ed. 2017) ("MCCARTHY"); *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188, 1200 (11th Cir. 2001); *Lens.com, Inc. v. 1-800 Contacts, Inc.*, 686 F.3d 1376, 1380, 103 USPQ2d 1672, 1676 (Fed. Cir. 2012).

(2) *Prior to November 1982 – GC's "Adoption and Use"*

As shown, the evidence establishes GC's requisite knowledge prior to March 13, 1978, when it applied to register COHIBA. Since Article 8's "knowledge" requirement is in the disjunctive, it is alternatively satisfied by GC's knowledge when it commenced commercial sales in Nov. 1982, which, as argued below, is the date of GC's "adoption and use" for purposes of Article 8. In addition to the pre-March 13, 1978 knowledge described above, GC's knowledge included by then:

- [redacted]

This unmistakably conveyed "use" and/or "employment."

- General Cigar admittedly knew CT had registered and was selling COHIBA outside of Cuba.[12]

This unmistakably conveyed the mark's "use," "employment" and/or "registration" in its home country.

For purposes of Article 8, GC's "adoption and use" date is Nov. 1982, when, with all of the above knowledge, it began commercial use of the mark. Prior to then, GC had simply attempted to reserve the mark by shipments that did not give it any trademark rights. More specifically:

On Feb. 13, 1978, GC added COHIBA to its "trademark maintenance program" for up to 33 marks. 346 TTABVUE 314, 360-361 (Sparkes). [redacted]

[12] The July 1982 issue of *World Tobacco* reported on CT's launch of COHIBA for export. 192 TTABVUE 150-158. GC subscribed to *World Tobacco*, which GC executives read. 344 TTABVUE 234, 351-353 (Mayer, GC R. 30(b)(6) witness). [redacted]

[redacted] The cigars were "seconds"—cigars that, because of bruises or other faults, did "not meet the criteria to go out under the label of the original trademark." 346 TTABVUE 161, 213, 368 (Sparkes). *See also* 62 TTABVUE 12-13 (GC Answer, admitting the above practice).

General Cigar expressly told the retailers that the cigars were sent for "trademark maintenance purposes." 345 TTABVUE 749, 768 (Rothman, retailer). Although the two retailers paid the nominal, invoiced amount, they received a full credit back. 345 TTABVUE 749, 758-761 (Rothman). Shipments were "irregularly spaced out," depending on the availability of "seconds." 346 TTABVUE 161, 213 (Sparkes). "There was no continuity…They just appeared…out of the blue." 345 TTABVUE 693, 721 (Rothman). [redacted]

The retailers just "threw [what was received] on the floor" in the same cartons in which a "huge group," 345 TTABVUE 758 (Rothman), of the boxes with different taped-on labels were shipped. No signage identified the cigar names; only the price, $1 per box, was posted for "miscellaneous" cigars. "If the box for Cohiba happened to be…the bottom of the carton that it was received in, then it would not have been visible to a customer." The retailers did not "make any effort to promote these cigars," and did not "talk about them to customers." 345 TTABVUE 749, 769-771 (Rothman); 346 TTABVUE 314, 359-360 (Sparkes); 62 TTABVUE 12-13 (Answer).

[redacted]

In early 1982, GC's Marketing Department was "asked to fill a need in the marketplace" for low-

priced premium cigars. "We then researched how to market that product and we had available the names that we owned;" "*at that point*, it was determined it was a good idea to meet the market need with this type of product and we would brand it COHIBA." 343 TTABVUE 896, 905, 921-922) (Kowalsky, VP for Marketing) (emphasis added). Commercial sales of a Cohiba-branded product, a pre-existing blend already marketed under a different trademark, 343 TTABVUE 896, 906-907, 912, 921 (Kowalsky), began in Nov. 1982. 62 TTABVUE 13-14 (Answer).

The Feb. 1978-Nov. 1982 shipments did not establish trademark rights. Whatever allowance the "token use" doctrine may have provided "to deal with the gap between mark selection and final product commercialization," *Ralston Purina Co. v. On-Cor Frozen Foods,* 746 F.2d 801, 805, 223 USPQ 979, 982 (Fed. Cir. 1984), GC acquired no rights as it had not selected the mark for use, whether on an existing or possible future product, as was required, *Ralston*, at 804, until 1982 but simply reserved it along with 32 other marks. Further, and separately dispositive, its shipments did not meet the requirement that use of the mark "must be open, public and notorious use such that the purchasing public is made aware of the availability of the goods under said mark and of the use of the mark as an indication of the origin of those goods." *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 701 (TTAB 1986); *see also Times Mirror Mags., Inc. v. Sutcliffe*, 205 USPQ 656, 662 (TTAB 1979) (use must be "part of a commercial or related transaction directed to customers or potential customers for such goods with the purpose of establishing goodwill, recognition, and association").[13]

That GC's shipments created no rights in the mark is determinative. When the Pan-American Convention was drafted, "adoption and use", Art. 8, was the standard term denoting the activity necessary at common law to acquire trademark rights. *Hydro-Dynamics v. George Putnam & Co.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987). Then (as now), shipments such as GC made did not give rise to rights.

[13] "To confer rights," there must be "good faith commercial exploitation" such that the mark has the "function . . . [of] designat[ing] the goods as the product of a particular trader and [] protect[ing] his good will." *La Societe Anonyme des Parfums le Galion v. Jean Patou*, 495 F.2d 1265, 1272–74, 181 USPQ 545, 548–49 (2d Cir. 1974); *Wallpaper Mfrs. v. Crown Wallcovering Corp.*, 680 F.2d 755, 759, 214 USPQ 327, 330 (CCPA 1982) (citing *La Societe* with approval). *See also Dynamet Tech., Inc. v. Dynamet, Inc.*, 197 USPQ 702, 710 (TTAB 1977), *aff'd*, 593 F.2d 1007 (CCPA 1979).

Phillips v. Hudnut, 263 F. 643, 644 (D.C. Cir. 1920).

General Cigar's Registered Mark is an "Interfering Mark."

Article 8's final requirement, that GC's is an "interfering mark," is satisfied. In *Mario Diaz v. Servicio de Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320 (TTAB 2007), and *Corporation CIMEX, S.A. v. DM Enters. & Distribs., Inc.*, No. 91178943, 2008 WL 5078739 (TTAB 2008) (non-precedent) (involving a Cuban trademark), the Board found that the registered marks at issue were "interfering" marks within Article 8 on the ground that they were identical and for the same goods as the mark on the party invoking the Convention, and that the registered mark was cited by the PTO against that party's application for registration or relied upon in opposition to the application. Under these two decisions, GC's registrations are "interfering."

Moreover, and also dispositive, there is no doubt that, were the CT Cohiba, as intended, and GC Cohiba for sale in the U.S., there would be a likelihood of confusion. The Convention does not require any showing of a likelihood of confusion before the party invoking the Convention's protection has entered the foreign market. To the contrary, Article 8, and its parallel provision for oppositions, Article 7, are structured precisely to protect Convention nationals that have not yet entered the market of another treaty country. Article 8 provides *alternative* predicates for cancellation: (a) knowledge of the mark's registration, use or employment in the country of the party invoking the Convention, *or* (b) "that goods designated by this mark have circulated" in the foreign country. Article 8(c).

Since Article 8 does not require that the goods of the party invoking its protection be present in the foreign market, it clearly does not, and could not, require that there be a likelihood of confusion even before their sale in that market. Such a requirement would, indeed, transform Articles 7 and 8 into what they are not—provisions implementing the analogous use doctrine, the well-known marks doctrine or Article 6*bis*, Paris Convention, since it would require enough of a renown in the foreign country as to make likelihood of confusion possible prior to sale. As is plain and as the Board has stressed, the Convention "goes much further than the Paris Convention in protecting prior users' rights. The latter protects such rights under the conditions of article 6*bis* (pertaining to well known marks), while the

Convention of 1929 includes articles 7, 8…" *British-American Tobacco Co., Ltd. v. Philip Morris*, 55 USPQ2d 1585, 1588 (TTAB 2000) (parenthetical in original).[14]

The terms of the Convention are given their "ordinary meaning in the context of the treaty and are interpreted, in accordance with that meaning, in the way that best fulfills the purposes of the treaty." *Mario Diaz*, 83 USPQ2d at 1325. The "ordinary meaning" of "interfering" mark "in the context of the treaty," and the "best"—indeed, only—construction that "fulfills the purpose of the treaty" precludes any requirement of likelihood of confusion before sales in the foreign market.[15] Even were it necessary to show likelihood of confusion now, CT has done so, *infra*, pp.37-48, but it is not necessary.

B. Fraud in Respondent's Section 15 Declaration Requires Cancellation (Third Ground)

Fraud in a section 15 Declaration requires cancellation of the registration. *Crown Wallcovering Corp. v. Wall Paper Mfrs. Ltd.*, 188 USPQ 141, 145 (TTAB 1975). There was fraud here.

In its June 23, 1986 filing, 321 TTABVUE 365-372, accepted on Nov. 3, 1986, 321 TTABVUE 373-374, GC declared "that the mark shown therein has been in continuous use in interstate commerce for five consecutive years from February 17, 1981 to the present." *Id.* This was false. For 21 months (over one-third of the five-year period), from Feb. 1981 until Nov. 1982, the mark had simply been maintained in the above-described trademark maintenance program.[16] [redacted]

[14] *See also*, Thomas Drescher, Nature and Scope of Trademark Provisions and the Pan-American Convention, 87 *T.M.R.* 319, 326 (1997) (under Articles 7 and 8, unlike the Paris Convention, "it is not the public's knowledge of the mark, but, rather, the infringer's knowledge of the owner's mark…that is significant.")

[15] The Conference adopting the Convention also adopted a Glossary, which provides, in English, that "interfering" mark "means a mark which so resembles one previously registered, deposited, or used by another person as to be likely, when applied to goods, to cause confusion or mistake or deceive." Pan-American Convention, 46 Stat. at 2976-77. Nothing in this definition requires looking to likelihood of confusion prior to sales in the foreign market.

[16] [redacted]

[redacted] This establishes all the elements of fraud.[17]

General Cigar's Fifth Affirmative Defense, that CT did not plead fraud with sufficient specificity, is frivolous. CT alleged in detail that GC had only made the shipments described above, and then alleged that GC's Declaration of five years continuous use was a knowing, material misrepresentation with the specific intent to have the PTO find that GC had satisfied the statutory requirements, which finding GC knew would otherwise not be made. 61 TTAVUE 12-15 (Amended Petition).

C. The Registration Must Be Cancelled Because of Abandonment

General Cigar has admitted that "there were…no sales by General Cigar of its Cohiba from sometime in 1987 until no earlier than November of 1992," 342 TTABVUE 878 (GC R.30(b)(6) witness); *id*. ("the brand was resting between the years of 1988 and 1992"), including no shipments, 62 TTABVUE 14 (Answer ¶ 47), far longer than the two-year period for the statutory presumption of abandonment then in effect.[18] No evidence exists of any sales or other use of COHIBA by GC during this five-plus year period; the evidence of nonuse is overwhelming and indisputable. *See Empresa*, 213 F. Supp. 2d at 269 ("undisputed" on CT's summary judgment motion "that [GC] did not have any commercial use of the COHIBA mark from sometime in 1987 to November 20, 1992—a period of five years"); *see, e.g.*, 342 TTABVUE 831, 860-62, 865-878, 887-89 (GC R.30(b)(6) witness); [redacted] GC's decision to end sales was consistent with its deliberate abandonment policy. (Cullman, Jr., GC's President).[19]

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[17] *See Mister Leonard Inc. v. Jacques Leonard Couture Inc.*, 23 USPQ2d 1064, 1065 (TTAB 1992); 6 MCCARTHY § 31:81 ("[F]raud may arise if the registrant intentionally falsifies that it has continually used the mark on the registered goods or services for five years").

[18] Prior to 1996 a mark was deemed abandoned "(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. 'Use' of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127, Pub. L. 100-667, Title I, § 134(8), 102 Stat. 3946 (1988).

[19] "[W]e would make an active decision to stop selling, unless otherwise we would continue to sell even if it was limited sales…we were never passive in these areas. We either continued to sell or we made a decision to abandon, so yes, we have abandoned products or brands, trademarks in the past." 342 TTABVUE 1137.

Abandonment requires only that the challenger show, by a preponderance of the evidence, an *intent not to resume use* during a two-year abandonment period, not an intent to abandon.[20] Crucially, "[t]he presumption [of abandonment from two years of nonuse] eliminates the challenger's burden to establish the intent element of abandonment as an initial part of its case." *Imperial Tobacco*, 899 F.2d at 1579, 14 USPQ2d at 1393.

To overcome the presumption, "[t]he registrant must put forth *evidence* with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred.…If the activities are insufficient to excuse nonuse, the presumption is not overcome." *Id*. at 1581 (emphasis added). The supporting evidence must show reasonable business plans to resume use in the reasonably foreseeable future, not mere conclusory, speculative say-so. "In every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise there would be no contest…. [O]ne must, however, proffer more than conclusory testimony or affidavits." *Id*.; *see Rivard v. Linville*, 133 F.3d 1446, 1449, 45 USPQ2d 1374, 1377 (Fed. Cir. 1998) ("actions during his period of nonuse are not those that a reasonable businessman would take pursuant to a plan to use the mark"); *Empresa,* 213 F. Supp. 2d at 268-69 (relying on *Imperial Tobacco* and *Rivard*); *Executive Coach Builders, Inc. v. SPV Coach Co.,* 123 USPQ2d 1175, 1199 (TTAB 2017) ("plans must be to resume commercial use of a mark within the 'reasonably foreseeable future"') (*quoting Hornby v. TJX Cos*., 87 USPQ2d 1411, 1421-22 (TTAB 2008)); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1488 (TTAB 2017) ("record simply is devoid of any evidence showing a specific and consistent plan to resume use"). Evidence of activities to resume use or resumed use after the abandonment period cannot cure a prior abandonment.[21]

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[20] *Imperial Tobacco, Ltd. v. Philip Morris, Inc.,* 899 F.2d 1575, 1581, 14 USPQ2d 1390, 1394 (Fed. Cir. 1990); *On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 1087, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). *See Empresa*, 213 F. Supp.2d at 270 (rejecting as "insufficient as a matter of law" GC's claim that it did not intend to abandon the mark).

[21] *See Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1027, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) (evidence of nonuse between 1977 and 1984 is not rebutted by evidence of an intent to resume use after 1984); *Hornby,* 87 USPQ2d at 1422; 194 TTABVUE 421 (GC counsel's

That GC cannot meet its burden to rebut the abandonment presumption with actual evidence of reasonable business plans to use the mark in the U.S. in the reasonably foreseeable future is so crystal clear, indisputable, and overwhelming that the District Court found abandonment on summary judgment, even applying the Second Circuit's "clear and convincing" standard, rather than the Federal Circuit's preponderance of the evidence standard. *Empresa*, 213 F. Supp. 2d at 267-71. Notably, GC has not proffered any additional evidence here; the record on abandonment is as it was before the District Court.

That record establishes that, until after the publication of *Cigar Aficionado* in Sept. 1992, GC had *no* business plans whatsoever to resume use of the COHIBA mark. For over five years, it engaged in only minimal activities related to the mark, similar to the minimal activities rejected as insufficient to overcome the abandonment presumption in *Imperial Tobacco*, whether considered "separately or combined," *Imperial Tobacco*, 899 F.2d at 1582, 14 USPQ2d at 1395: [redacted] *See Empresa*, 213 F. Supp. 2d at 270-71. Nothing further was done from 1987 until after the Sept. 1992 publication of *Cigar Aficionado*, when, in Nov. 1992, GC "simply began selling" "COHIBA"-labeled cigars, "as it could have all along," *Imperial Tobacco*, 899 F.2d at 1582, 14 USPQ2d at 1395—simply a pre-existing, unbanded TEMPLE HALL cigar in a wooden box stamped "COHIBA" in lettering almost identical to the Cuban COHIBA box. 345 TTABVUE 390-91, 516-18; 198 TTABVUE 497. *See Rivard*, 133 F.3d at 1449, 45 USPQ2d at 1376 ("sporadic trips to the United States, cursory investigations of potential sites for salons, and half-hearted attempts to initiate the business relationships necessary to open a salon" during five years of nonuse do not establish intent to resume use); *Silverman v. CBS*, 870 F.2d 40, 47-48, 9 USPQ2d 1770, 1783-84 (2d Cir. 1989) ("periodically reconsidering whether to resume use"; challenging infringing uses; licensing for non-commercial uses; and renewing copyrights are "minor activities" that fail to show "an intent to resume commercial use"

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acknowledgement in 1991 that a mark is abandoned by absence of "shipments in the regular course of business" for over two years and "it cannot be proven that an intention to resume such 'use' existed during that time period…even where legitimate use of the mark resumed").

because they "do not sufficiently rekindle the public's identification of the mark with the proprietor, which is the essential condition for trademark protection").

[redacted] Rather than choose from the universe of possible trade dresses, GC again did nothing concerning use of the COHIBA mark until *after Cigar Aficionado* was launched. Simply put, GC had no other plan for the mark. There is not a single document after 1987 until Sept. 1992 showing any consideration of using the mark other than the trade dress copying notions rejected for legal reasons.

In almost the identical situation, *Imperial Tobacco* held that a desire to use the "trade dress similar to that used by [petitioner]," abandoned because of concerns over potential litigation, cannot overcome the abandonment presumption. *Imperial Tobacco,* 899 F.2d at 1582-83, 14 USPQ2d at 1395-96. The reason is obvious: an idea abandoned for legal reasons is not, and cannot be, a plan to resume use of a mark in the reasonably foreseeable future.

[redacted]

[redacted] over the course of five years of nonuse does not overcome the abandonment presumption. *See Silverman,* 870 F.2d at 47-48, 9 USPQ2d at 1783-84 ("challenging infringing uses is not use"; such "minor activities" are insufficient to show intent to resume use). [redacted] cannot rebut either the presumptive period of abandonment of 1987-1992, [redacted]

[redacted] GC chose to do absolutely nothing for over five years to use the COHIBA mark, or to maintain or revive whatever goodwill or commercial value might have existed in the COHIBA mark in 1987 [redacted]). No goodwill existed when GC commenced a new use of the mark in Nov. 1992 for the express purpose of capitalizing upon and exploiting the renown of the Cuban Cohiba. Indeed, GC admittedly wanted the public to "forget" this failed product. 342 TTABVUE 1136. The late 1992 Cohiba was a different product, with a completely different trade dress, channel of trade

and price point;[22] and neither GC nor Alfred Dunhill of Dunhill, its exclusive retailer, sought to tie this COHIBA-branded cigar to the earlier product. When there is a loss of goodwill in the marketplace, "the state of mind of the public should prevail" in favor of finding abandonment. 3 MCCARTHY § 17:15; *see Silverman,* 870 F.2d at 48, 9 USPQ2d at 1784.

The evidence is also overwhelming that GC did no work on a new COHIBA-branded product until after the Sept. 1992 launch of *Cigar Aficionado*, when GC decided "to somehow capitalize on the success of the Cuban brand and especially at this point in time the good ratings that it got, the notoriety that it got from *Cigar Aficionado*." 344 TTABVUE 749. The hundreds of pages of designs, memoranda, correspondence, and legal opinions and research, all generated *after* Sept. 1992, stand in sharp contrast to the tiny handful of documents concerning COHIBA over a five-year period, all cited above.[23]

[redacted] GC filed a new, intent-to-use application for COHIBA on Dec. 30, 1992. 210 TTABVUE 13-18. [redacted]

[22] [redacted]); 342 TTAB 412, 413, 442-444 (Burgh, GC Exec. VP), 806-10, 815 (Conder, GC R. 30(b)(6)); 343 TTABVUE 896, 905, 921-922 (Kowalsky) (aimed at lower end of premium market); [redacted] 344 TTABVUE 968, 975 (Perez, of Dunhill) (Dunhill "a luxury retailer that also happens to sell cigars"); 178 TTABVUE 1974, 1979 (Dunhill catalog, box of 25 priced at $165-$185). Afterwards, in 1993, GC also began sales to Mike's Cigars in Miami, to protect the mark in Florida, where Dunhill had no stores, against a third-party. 342 TTABVUE 310-311 (Boruchin of Mike's Cigars); 342TTABVUE 886, 893-894 (Conder, GC R. 30(b)(6) witness) (1992 product was repackaged Temple Hall cigar; began selling to Mike's in 1993 for trademark protection).

[23] Notably, when confronted with documents that had not been produced by the time of his first deposition, GC's head of marketing expressly *recanted* his prior testimony that GC "started to develop packaging designs" for COHIBA "[p]erhaps sometime in 1990," and admitted that in fact GC "started working on the packaging design sometime in the fall of 1992." 345 TTABVUE 353, 526-27.

[redacted].

Thus, even if there had been evidence of the development of a marketing strategy prior to Fall 1992 (which there is not), it would be irrelevant, as GC did not use any such pre-*Cigar Aficionado* strategy; it "simply began selling cigar[]s in [Nov. 1992], as it could have all along." *Imperial Tobacco,* 899 F.2d at 1582, 14 USPQ2d at 1395 (claimed development of a "marketing strategy" for five years that Imperial did not implement does not excuse non-use; "when Imperial finally made sales of [its] cigarettes, there was no implementation of a complex marketing strategy to introduce them"). As the District Court found in rejecting GC's contrived and false "restaging" claim:

> the claims of "restaging" are belied by the fact that the "new" COHIBA cigar introduced in 1992 was nothing more than an existing General Cigar, the Temple Hall, with a COHIBA label on it. Even the new label was created in the fall of 1992, after the launch of Cigar Aficionado with its cover story on the Cuban COHIBA. If General Cigar truly spent five years engaged in ruminating over complex marketing strategies, it apparently did not implement the results.

Empresa, 213 F. Supp. 2d at 269-70 (citing *Imperial*, 899 F.2d at 1582, 14 USPQ2d at 1395).

The only other purported evidence concerning COHIBA from 1987-late 1992 are bits of vague testimony about vague plans of possible "eventual use" of COHIBA. *See* 342 TTABVUE 879-82 ("there were discussions during those periods of the *eventual use* of Cohiba"; "general discussions"; "Cohiba was a topic. *Not a specific about whether we would finally end up with it,* but it was a topic of conversation.") (emphasis added); *id*. 1177-78. The District Court, relying upon *Imperial Tobacco* and *Cerveceria,* explicitly rejected such conclusory testimony. *Empresa,* 213 F. Supp. 2d at 271 ("testimony of Cullman and others that [GC] intended to resume use of the COHIBA mark is insufficient in light of the lack of *any supporting evidence*. To refute an allegation of abandonment, the contesting party must 'proffer more than conclusory testimony or affidavits.' *Imperial Tobacco*, 899 F.2d at 1581; *see also Cerveceria* [] 892 F.2d [at 1027] ('vague' testimony regarding intent to resume given 'little [or] no weight'").

General Cigar has failed to rebut the presumption of abandonment from over five years of non-use. Therefore, GC's first COHIBA registration must be cancelled.

II. Registration No. 1898273 (June 6, 1995)

A. Article 8, Pan-American Convention, Requires Cancellation (Seventh Ground)

On the *undisputed* facts, Article 8, Pan-American Convention, requires cancellation of GC's second registration. The Cuban Cohiba "enjoyed legal protection" in Cuba "prior to the date of the application," Art. 8(a), for GC's second registration. 190 TTABVUE 233-235 (Garrido, CT counsel). GC "admits that [it] knew that Cohiba was used for cigars in Cuba prior to November 20, 1992." 62 TTABVUE 20 (Answer, ¶ 96). As shown, GC's second registration is an "interfering" mark. The long and short of it is that GC cannot avoid cancellation on the basis of Article 8.

While this is dispositive, CT nonetheless advances additional grounds for cancellation, mindful, in particular, that the Federal Circuit has not yet ruled on whether Article 8 provides grounds for the Board's cancellation of a registration.

B. Petitioner's Prior Analogous Use Requires Cancellation (Sixth Ground)

1. **Prior Analogous Use**. Cubatabaco had promoted the Cuban Cohiba in the U.S. with spectacular success prior to GC's shipping COHIBA-branded cigars on Nov. 20, 1992 and its applying for registration of COHIBA on Dec. 30, 1992.[24] CT thereafter consistently made efforts to maintain and augment the association of COHIBA with its cigar until filing its application for registration on Jan. 15, 1997, with continued, great success (and thereafter, until today, also with success).

Cubatabaco's promotion and its success, detailed below, are more than sufficient, together with its showing of likelihood of confusion, to require cancellation under the analogous use doctrine. Its promotional effort was "sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods, [and] the activities claimed to create such an association [could] reasonably be expected to have a substantial impact on the purchasing public before a later user acquire[d] proprietary rights in a mark." *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162, 64 USPQ2d 1375 (Fed. Cir. 2002). The association was "created among more than an insubstantial

[24] 342 TTABVUE 878 (GC R. 30(b)(6) witness); U.S. Reg. No. 1898273 (Application, Dec. 30, 1992; Statement of Use, Jan. 5, 1995).

number of potential customers." *T.A.B. Sys. v. PacTel Teletrac*, 77 F.3d 1372, 1377, 37 USPQ2d 1879, 1883 (Fed. Cir. 1995). CT "engaged in a continuing effort to cultivate an association" and the resulting association "continued up until the date" of CT's filing an application for registration. *Dyneer Corp. v. Automotive Prods.*, 37 USPQ2d 1251, 1256 (TTAB 1995) (and beyond, until today). CT's promotion through the press is a recognized form of analogous use.[25] Sales have not followed promotion because of the U.S. embargo, which excuses non-use. *Arechabala Rodrigo v. Havana Rum*, No. 22881 at 14-19 (TTAB Oct. 19, 1996) (non-precedent); *see also* TMEP § 1604.1 (trade embargo excuses non-use).[26]

Prior to Nov. 22, 1992, CT had achieved spectacular success in promoting COHIBA through *Cigar Aficionado*. Early in 1992, Marvin Shanken traveled to Havana to seek the "support and collaboration" of CT for a new magazine, *Cigar Aficionado*, that he intended to launch later that year. CT agreed and promised to assist *Cigar Aficionado* by, *inter alia*, facilitating the travel of its journalists to Cuba, organizing visits to tobacco farms and cigar factories; arranging interviews; and taking out advertisements. 339 TTABVUE 199, 267-269 (Lopez Garcia, Director of Marketing); 338 TTABVUE 2, 57-62 (Lopez Garcia).[27] In the 1992 meeting, CT urged Shanken to select Cohiba for a major article in the premier issue. 339 TTABVUE 199, 268 (Lopez Garcia). CT then assisted *Cigar Aficionado*'s staff in their in-depth reporting on Cohiba for the premier issue. 339 TTABVUE 199, 268-269 (Lopez Garcia). It placed a full-page, color ad for the cigar in the premier and second issues of *Cigar Aficionado*. 339 TTABVUE 199, 269 (Lopez Garcia).

The premier issue, published on September 1, 1992, achieved an extraordinary circulation equal

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[25] *Nat'l Cable Television Assn. v. American Cinema Eds.*, 937 F.2d 1572, 1577 19 USPQ2d 1424 (Fed. Cir. 1991); *Malcolm Nicol & Co., v. Witco Corp*., 881 F.2d 1063, 1065, 11 USPQ2d 1638 (Fed. Cir. 1989); *American Stock Exchange v. American Express Co.*, 207 USPQ2d 356, 363 (TTAB 1980).

[26] [redacted]. 339 TTABVUE 266-284 (Lopez Garcia, Director of Marketing); [redacted]

[27] Shanken had already made "The Allure of Cuban Cigars, Special Report from Havana 30 Years After the United States Embargo" the cover story of the Feb. 15, 1992 issue of his publication *The Wine Spectator*, 185 TTABVUE 2-30, circulation 100,000 readers, 185 TTABVUE 525-536. While in Havana writing the cover story, Shanken decided to launch *Cigar Aficionado.* 180 TTABVUE 415, 420.

to *twenty-five percent (25%) of all premium cigar smokers*.[28] Its reach was still greater because of robust pass-along readership. 340 TTABVUE 306, 326 (Siegel, CT branding expert); 340 TTABVUE 2, 15, 61, 82-85 (Ossip, CT market research expert). With pass-along readership, the issue reached a "substantial portion, if not a majority," of premium cigar smokers. 340 TTABVUE 2, 15 (Ossip). *Cigar Aficionado* was the *only* publication for premium cigar smokers, and remained so for many years. 344 TTABVUE 822, 839-840 (Mott, *Cigar Aficionado* executive).

Cubatabaco's eminent expert on branding, Alan Siegel, testified that "in my more than 35 years of experience, I cannot recall any product in any category getting more powerful and favorable publicity than the Cuban Cohiba received in the premier issue of *Cigar Aficionado*. This was a dream come true for any product." 340 TTABVUE 306-310, 314-315. GC's expert, cigar book author Richard Carleton Hacker, testified that in 1992-93 "Shanken had given COHIBA a big, big push…everybody talked about it [the Cuban COHIBA]," 362 TTABVUE 841-842 (Hacker); the magazine had "clout." 347 TTABVUE 160 (Hacker). Writing a mere eighteen months after the premier issue, Alfred Dunhill of London, the primary distributor of the GC cigar, considered the Cuban Cohiba to be "the most legendary cigars in the U.S. market," 312 TTABVUE 304-305, 308, because of the "hype" that "started with the article in the premier issue of *Cigar Aficionado*," 344 TTABVUE 968, 995 (Perez, of Dunhill), "the mystique built around them by" the publication. 312 TTABVUE 304, 317 (Dunhill); 344 TTABVUE 968, 1008-1009.[29]

The premier issue, 180 TTABVUE 415-578, prominently featured the Cuban COHIBA in a six-page spread, "The Legend of Cohiba: Cigar Lovers Everywhere Dream of Cuba's Finest Cigar," 180

[28] At year-end 1991, there were 467,900 premium cigar smokers in the U.S.; by year end 1992, there were 483,100. 234 TTABVUE 92-93 (market study commissioned by GC). The premier issue's U.S. circulation was 115,000. Of these, 73,000 represented paid subscriptions; 32,000 "newsstands" (inclusive of cigar retail stores, street newsstands and bookstores); and 10,000 were promotional. 178 TTABVUE 1700-1706. It was distributed to 453 cigar retail outlets for display and/or sale to consumers, 178 TTABVUE 1702, approximately two-thirds of the members of the Retail Tobacco Dealers of America ("RTDA"), 178 TTABVUE 1943-1948, the principal U.S. cigar retailers' association. 342 TTABVUE, 1359, 1412 (Cullman, Jr.).

[29] The cigar boom that "started in 1992-93," 347 TTABVUE 2, 69 (Hacker), was the "*Cigar Aficionado* revolution," since it "created the boom," 342 TTABVUE 268, 364-365 (Boruchin, retailer of GC Cohiba).

TTABVUE 458-465, which lauded the Cuban Cohiba as "perhaps the world's finest smoke," "legendary to most cigar aficionados," "the cigar of the world cognoscenti," a "symbol of financial success." No other brand was mentioned in any other article's title; no other article was devoted to a particular brand. 340 TTABVUE 306, 321, 323-324 (Siegel). In a separate feature rating 22 brands, COHIBA was ranked first. *Id*. 31. There were still other, highly positive references and the issue's running theme on the excellence and cachet of Cuban cigars gave its proclaiming Cohiba as Cuba's best still greater force. *Id*. 325. *See* 340 TTABVUE 319-324 (Siegel) for a comprehensive review of the premier issue.

While CT's promotion through the premier issue of *Cigar Aficionado* was a spectacular success, CT had long been active in promoting Cohiba in the U.S. through the press, also with results.[30]

CT's market research expert estimated that, prior to Nov. 22, 1992, over 50% of U.S. premium cigar smokers knew of the Cuban Cohiba. 340 TTABVUE 2, 6 (Ossip). He based his estimates on GC market studies and other materials. *Id*. 10-40.

GC's own reaction to *Cigar Aficionado*'s premier issue provides still additional, compelling evidence of its impact, and is relevant to still other issues. In September, immediately following *Cigar Aficionado*'s publication, GC management, pleased that it rated the Cuban Cohiba so well, decided it would be advantageous "to capitalize on those good ratings." 338 TTABVUE 805, 1052-1053 (Milstein, GC's VP Assistant General Counsel). GC told Hacker, then working on the first edition of his book, that its plan to introduce a new cigar under the COHIBA name was "just [because of] the cachet of the name … as a result of the Cuban COHIBA." 347 TTABVUE 43. After five years of non-use, there was no remaining goodwill in GC's original COHIBA-branded product, 340 TTABVUE 344, 356-357 (Siegel), and thus no other reason to select COHIBA.

General Cigar's plan, as GC's own executives conceded, was "to somehow capitalize on the

[30] In 1977-Nov. 22, 1992, there were 57 U.S. newspaper, magazine and wire service articles referencing the Cuban Cohiba, including the *Miami Herald* (7), *Wall Street Journal* (3), *NY Times* (3), *USA Today* (2), *Forbes* (3), *Newsweek* (2), *Chicago Tribune* (2), and *San Francisco Chronicle* (2). Nine used superlatives for the Cuban COHIBA such as "famous," and "legendary" (226 TTABVUE 2, 16-20, at ¶ 6). No articles referenced the GC COHIBA. 226 TTABVUE 2, 16-20. The February 15, 1992 *Wine Spectator* featured an interview with "The Man Behind the Coveted Cohiba." 185 TTABVUE 2, 16.

success of the Cuban brand, and especially at this point in time the good ratings that it got, the notoriety that it got from *Cigar Aficionado*." 344 TTABVUE 687, 749 (Milstein); 338 TTABVUE 805, 1058 (Milstein). As part of that plan, GC rushed a product with the same blend as an existing product, 338 TTABVUE 2, 142, 178 (Rano, VP for Marketing), to market by the end of Nov. 1992. 341 TTABVUE 2, 15-16 (Cullman, Jr.); 342 TTABVUE 763, 888-889 (GC R. 30(b)(6) witness). GC told its design firm to create a box design from the Cuban Cohiba's packaging. 338 TTABUE 147-150; 154; 157-158 (Rano). The box put on the market used a virtually identical typeface and design as the Cuban Cohiba's box, with the exception of CT's Indian Head.[31] GC also adopted three of the Cuban Cohiba's frontmarks (which identify different varieties of a cigar brand). 234 TTABVUE 437-438; 339 TTABVUE 199, 255. Dunhill carried the GC product because of the strength of the Cohiba name attributable to the Cuban Cohiba. 338 TTABVUE 2, 178-179 (Rano).

In late 1992-early 1993, GC decided to seek CT's permission to use its registered, Cohiba trade dress, 338 TTABVUE 805, 940 (Cullman, Jr.); 338 TTABVUE 805, 1060-1064 (Millstein); 180 TTABVUE 594-597 (Jan. 14, 1993 memorandum, misdated 1992, 338 TTABVUE 1062), which was "familiar" to U.S. consumers, 180 TTABVUE 595. The "rationale" was that "[t]o aid GC in successfully repositioning and relaunching its Cohiba brand cigar, it would be useful to exploit the popularity, familiarity, brand recognition and overall success of the Cuban Cohiba," 180 TTABVUE 595; 338 TTABVUE 1063 (Millstein).

Contemporaneously, GC developed a strategy with its advertising agency, "Marketing the Cohiba Cigar," which was premised on the Cuban Cohiba's renown in the U.S.:

> Cohiba is the magic word in the cigar industry. It is consistently given top ranking by the industry judges and the name has a high recognition factor here in the U.S. despite the fact that it cannot be purchased in the country.

180 TTABVUE 274, 276. The "STRATEGY: Phase 1," was to "exploit the Cohiba name, with its

[31] *Compare* 179 TTABVUE 1092-1098 (Cuban) with 180 TTABVUE 255-262 (GC); 338 TTABVUE 2, 171-172 (Rano) ("very similar;" "very close;" "professional graphic designer" could tell not "exact."). The cigars had no bands. 338 TTABVUE 2, 178 (Rano).

reputation as one of the world's finest cigars, to build a brand image for the U.S. Product." 180 TTABVUE 277, 280.[32]

Cubatabaco's promotion continued after *Cigar Aficionado*'s premier issue. CT invited Shanken and his lead writer to the launch of a new COHIBA line in Havana; the second issue (March 1993) praised the new line. 339 TTABVUE 199, 270-271 (Lopez Garcia). CT arranged for Shanken to interview President Fidel Castro; the cover of *Cigar Aficionado*'s June 1994 issue was a close-up photo of the Cuban President with a Cohiba cigar in hand; in the eleven-page interview, he dwelt particularly on Cohiba. 339 TTABVUE 271-272 (Lopez Garcia). At CT's invitation, more than 30 U.S. journalists attended the gala celebration of the 30th Anniversary of COHIBA in Havana in Feb. 1997. NBC and CNN covered the event, as did *Newsweek, Time, Cigar Aficionado* and other media. 339 TTABVUE 199, 279-283 (Lopez Garcia). There were more than 65 articles in the U.S. press.[33]

In addition to the above, CT constantly assisted numerous U.S. journalists and cigar book authors, almost all of whom pursued a particular interest in Cohiba. 339 TTABVUE 274-277 (Lopez Garcia); 339 TTABVUE 144-151 (Silveira, Marketing Department staff). Several TV programs including content on Cohiba were broadcast from or shot in Cuba. 339 TTABVUE 199, 275 (Lopez Garcia).

Review of the press between GC's introduction of a COHIBA-branded product on Nov. 22, 1992 and Jan. 15, 1997, when CT applied to register COHIBA, and also until GC's launch of a new COHIBA-branded product in Sept. 1997, shows the great success achieved by CT's promotion, and that the Cuban Cohiba's renown dwarfed GC's brand:[34]

Nov. 23, 1992 – Jan. 15, 1997/ Sept. 25, 1997: U.S. Newspapers, Magazines and Wire Services
226 TTABVUE 20-25, 43-51 (Licata ¶¶ 7, 13, 15-16 and Annexes cited therein)

[32] Every marketing and creative strategy document from 1992-93 restated GC's plan to "Exploit the Cohiba name with its reputation as one of the world's finest cigars amongst cigar smokers, to build a brand image for the U.S. product." 180 TTABVUE 290-308. The reference was to the Cuban Cohiba. 338 TTABVUE 2, 212-213; 345 TTABVUE 2, 62 (Pfaff, ad agency's R. 30(b)(6) witness).

[33] 182 TTABVUE 192-207 (list of articles identified as PX 1124(c)(2) 271-287, 290-98, 303-06, 310-16, 318-21, 323-26, 328-33, 335, 337-46, 351-359); 182 TTABVUE 251-522 (articles).

[34] The tables below analyze U.S. news articles in the Westlaw, Lexis and *N.Y. Times* databases. Some of the "total" references were to the Melia Cohiba hotel in Havana, bars or clubs in the U.S. named Cohiba and the like. They were excluded from the tabulation of the other categories shown on the tables.

Total	Only Cuban	Only GC	Both	Unclear	Superlatives**		Associate w/Celebrities	
					Cuban	GC	Cuban	GC
513* (266 pre-1/15/1997)	408 (223 pre-1/15/1997)	24 (12 pre-1/15/1997)	9 (1 pre-1/15/1997)	68 (25 pre-1/15/1997)	69 (15 pre-1/15/1997)	0	71 (27 pre-1/15/1997)	0

*Of the total, 21 were from AP and 8 from other wire services. **"Famous," "Iconic," "Best," "Legendary," and the like.

1992 – Jan. 15, 1997/Dec. 31, 1997: *Cigar Aficionado*

226 TTABVUE 11-16 (Licata ¶¶ 4, 5 and Annexes cited therein)

Total	Only Cuban	Only GC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GC	Cuban	GC
182 (145 pre-1/15/1997)	150 (114 pre-1/15/1997)	4 (3 pre-1/15/1997)	10 (9 pre-1/15/1997)	16 (15 pre-1/15/1997)	14 (14 pre-1/15/1997)	0	20 (14 pre-1/15/1997)	0

Cigar Aficionado gave the Cuban Cohiba high ratings issue after issue. GC's Cohiba was not rated. 339 TTABVUE 199, 287, 385 (Lopez Garcia). The numerous cigar books published in this period lavished praise on the brand. 182 TTABVUE 881-884 (list); 182 TTABVUE 885-1100 (books).

In the wake of this extraordinary, spectacularly successful promotion of the Cuban Cohiba, GC prepared a national launch of a new COHIBA-branded product in 1997, to replace its 1992 "interim" product sold through Dunhill and a Miami retailer. 338 TTABVUE 2, 173 (Rano). GC's premises and strategies remained the same. GC's 1997 Marketing Plan for the new product stated: "Cohiba: Objective: Leverage mystique of Cuban name with comprehensive product line-up." 178 TTABVUE 1840, 1870. Its Product Development Guide stated that "[i]ts Cuban cigar heritage and the near 'cult' status of the Cohiba Cuban version will be a benefit to generate initial trial of the brand, and easy brand recognition, but not the main engine driving the brand." 312 TTABVUE 2, 6; 345 TTABVUE 333, 452 (Rano). GC's "competitive position" was "1. Cohiba brand name is powerful. Leverages Cuban mystique, positive brand name recognition, consumer expectation of high quality, intrinsic prestige associated with the brand equates to easy super premium price justification and increased consumer trial." 312 TTABVUE 2, 7; 338 TTABVUE 2, 254-255 (Rano); 345 TTABVUE 333, 455 (Rano); 343 TTABVUE 2, 35, 64 (Farrington, GC Director of Marketing).

[redacted]

Review of the press from the time when GC launched a new Cohiba-branded product in Sept. 1997 to Dec. 2016 shows the extraordinary attention that continued to be paid to the Cuban Cohiba, which continued to eclipse GC's product:

Sept. 5, 1997 – Dec. 6, 2016: U.S. Newspapers and Magazines[36]

226 TTABVUE 25-30, 37-40, 47-53, 61-69 (Licata ¶¶ 8, 11, 14-15, 16, 17, 19 and Annexes cited therein)

Total	Only Cuban	Only GC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GCC	Cuban	GCC
1775	914	234	159	299	103	0	85	8

Sept. 1997 – Feb. 24, 2001: Television and Radio Programs

226 TTABVUE 30-34 (Licata ¶ 9 and Annexes cited therein)

Total	Only Cuban	Only GC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GCC	Cuban	GCC
23	12	0	4	6	5	0	2	0

[35] [redacted]

[36] For the period 2002-16, 48 articles were by the AP and 11 by other wire services. For the period Oct. 1997-Sept. 12, 2002, articles by AP and other wire services are not included but stated in a separate chart.

Oct. 1, 1997 – Sept. 12, 2002: AP and Other Wire Services
226 TTABVUE 34-37 (Licata ¶ 10 and Annexes cited therein)

Total	Only Cuban	Only GC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GCC	Cuban	GCC
172	141	9	10	10	16	0	12	0

1998 – Feb. 2019: *Cigar Aficionado*
226 TTABVUE 40-43, 53-58 (Licata ¶¶ 11, 18); 217 TTABVUE 111-14 (Martini ¶¶ 44-45) and Annexes cited therein [37]

Total	Only Cuban	Only GC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GCC	Cuban	GCC
281	198	22	32	27	18	0	34	2

Post- Sept.1997, *Cigar Aficionado*'s ratings of the Cuban Cohiba were significantly higher and more frequent than of the GC product. 217 TTABVUE 52-55; 339 TTABVUE 199, 287, 385.

The story was the same in *Smoke*, the only cigar consumer publication that lasted on the market in addition to *Cigar Aficionado*, 344 TTABVUE 822, 839-840:

2003 – Nov. 2016: *Smoke*
226 TTABVUE 53, 58-61 (Licata ¶ 18 and Annexes cited therein)

Total	Only Cuban	Only GCC	Both	Unclear	Superlatives		Associate w/Celebrities	
					Cuban	GCC	Cuban	GC
41	28	9	2	2	3	0	4	2

Halfwheel, a cigar website GC's expert singled out, 347 TTABVUE 55-56, carried 266 articles in Oct. 2009-Feb. 2019 mentioning only the Cuban Cohiba, 91 mentioning only GC Cohiba, and 26 both. 217 TTABVUE 104-109.

[redacted]

The Cuban Cohiba band was copied by counterfeiters, who, beginning in mid-1995, began to

[37] Premium cigar smokers using *Cigar Aficionado* as a source of information on cigars ranged from 28% to 52% of premium cigar smokers during 1997-2001. 340 TTAB 83 (Ossip). Issue audience was 764,000-1,031,000 in 1998-99, and paid circulation ranged between 125,000 and 400,000 in 1992-2000. 178 TTABVUE 1704, 1700-1768. Weekly visits to *Cigar Aficionado*'s website averaged 63,600 in 1998, 109,000 in 1999, and 110,000 in 2000. 178 TTABVUE 1700, 1703.

flood the U.S. market with counterfeit Cuban Cohibas. 346 TTABVUE 781, 836-838 (GC General Counsel); 342 TTABVUE 268, 368-370 (Boruchin, GC retailer); 178 TTABVUE 1703-04 (Counterfeit Gallery feature on *Cigar Aficionado*'s website).

Hacker, GC's expert, testified unequivocally at his June 2017 deposition that the "Cuban COHIBA [is] well known in the United States among premium cigar smokers." 347 TTABVUE 2, 60. In the edition of his book published in 2015, he wrote of the Cuban COHIBA: "Yes, this is *the* cigar" (emphasis in original). 362 TTABVUE 841-842 (Hacker). Hacker explained that he wrote this "because this was a cigar that everybody was talking about." *Id*. There was a "big hubbub" about the Cuban Cohiba – "it's the excitement. It's a Cuban brand that's supposed to be the top of the mark, and it is the one they hear the most about." 362 TTABVUE 840-841.

2. Likelihood of Confusion

i. Likelihood of Confusion Were the Cuban COHIBA to Enter the U.S. Market for Sale

There undeniably would be a likelihood of confusion were the CT Cohiba, as intended, and the GC Cohiba both sold in the U.S. market. Indeed, GC, in its Answer, (¶ 98), 62 TTABVUE 20, "avers that the [two marks] so resemble[] [each other] as to be likely to cause confusion, or to cause mistake, or deceive." That the two marks are identical (the typeset and block lettered word COHIBA without design)[38] and are for the same goods would make this case "open and shut," 4 MCCARTHY § 23:20; in such situations, confusion is "inevitable." *Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125, 1131 (TTAB 1990).

Cubatabaco shows below that there is a likelihood of confusion even now. However, the Board need not reach that issue, as it suffices that there would be a likelihood of confusion were the Cuban Cohiba to enter the U.S. market upon relaxation of the embargo. As there is "use" in the U.S. within section 2(d), the "area of probable expansion" is the proper focus of likelihood of confusion, just as it is

[38] That CT's mark is in typeset and one of GC's registrations is in block letters is of no import. *In Re Pollio Dairy Prod. Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (party "registering its mark in block letters" is "free to change the display of its mark at any time").

when the two concurrent, geographically remote parties are domestic companies. *Application of Beatrice Foods*, 429 F.2d 466, 475, 166 USPQ 431 (CCPA 1970); *Over the Rainbow, Ltd. v. Over the Rainbow, Inc.*, 227 USPQ 879, 883 (TTAB 1985); *Old Swiss House, Inc. v. Anheuser-Busch, Inc.*, 193 USPQ 502 (TTAB 1976), *rev'd on other grounds*, 569 F.2d 1130 (CCPA 1979) (analogous use case, likelihood of confusion to be assessed when product would be sold in area of probable expansion); 5 MCCARTHY § 26:20. That trademark law looks to future, planned use is also evident in the assessment of likelihood of confusion for intent-to-use applications,[39] and the Board's assessment of consent agreements. *See In re Bay State Brewing Co., Inc.*, 117 USPQ2d 1958 (TTAB 2016). In a closely related context, the Examining Attorney has argued that the Board must look to the end of the embargo in evaluating a goods/place association for marks with Cuban geographic indications under section 2(e) (primarily geographically deceptively misdescriptive).[40] There is nothing in the Act's language that precludes looking to post-embargo likelihood of confusion.

Not only is there support in the precedent, and no bar in the statutory language, but trademark relations with Cuba illustrate why likelihood of confusion is properly evaluated *post*-embargo. The U.S. embargo prohibits the sale of U.S. goods in Cuba as well as the sale of Cuban goods in the U.S. (with limited exceptions). 31 C.F.R. §§ 515.201 *et seq.* Nonetheless, U.S. policy is to allow for "reciprocal protection" of trademarks by authorizing U.S. companies to register their marks in Cuba, and Cuban companies to register their marks in the U.S., and, relatedly, to bring opposition and cancellation proceedings, 31 C.F.R. §§ 515.527, 515.528; 169 TTABVUE 170 (OFAC Director), all in anticipation of the time when the trade embargo is relaxed. Similarly, the Board, expressly in anticipation of that time, has held that the embargo excuses Cuban parties from the Act's use requirements. *Arechabala*, Cancellation No. 22881 at 13-14. So, too, has the Federal Circuit recognized a Cuban party's standing in

[39] *See, e.g., The Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1487 (TTAB 2007) (sustaining opposition to intent-to-use application although mark "not yet used").

[40] *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945-46 (TTAB 2000) (David Reihner); Examining Attorney Appeal Brief in *In re Compañia de Licores Internacionales*, 2011 WL 8584839, Opposition No. 75010230 (TTAB June 7, 2011) (Karen Strzyz).

opposition and cancellation proceedings in consideration of "future domestic sales." *Empresa*, 753 F.3d at 1274. Because of "reciprocal protection," hundreds of U.S. companies have registered perhaps thousands of trademarks in Cuba. 198 TTABVUE 499-517.[41]

All this would be futile, and U.S. trademarks in Cuba would be vulnerable, if, to protect a Cuban mark in the U.S., it was necessary to show likelihood of confusion at the present time, rather than when trade is possible. On the principle of reciprocity, protection of U.S. marks against third-party use or registration in Cuba would be limited to those U.S. marks which can be shown to have substantial, present renown there, as otherwise there could not be present confusion.

ii. Likelihood of Confusion at the Present Time

Even were the assessment made as of the present, likelihood of confusion is established. As noted, the Board has repeatedly held that confusion is "inevitable" when identical marks are used for the same goods. Here, in addition, the mark is arbitrary and fanciful; confusion is to be assessed by the matrix of consumers buying COHIBA-branded cigars for "a buck each or less" at a liquor or convenience store or gas station; the Cuban Cohiba enjoys extraordinary reputation and renown; and GC's enforcement actions effectively concede likelihood of confusion.

This more than suffices under *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In addition, the other *du Pont* factors—including extensive proof of recent actual confusion, as shown, *inter alia*, [redacted] and own expert—also strongly favor a finding of likelihood of confusion.[42]

General Cigar attempts to overcome same name/same goods and CT's additional, extensive showing by relying on the opinion of its expert, Hacker, and one of if its current employees that, because

[41] The President has ample authority to authorize the importation of Cuban goods into the U.S. 31 C.F.R. § 515.201 (transactions prohibited "except" as authorized by licenses). President Obama exercised this authority to authorize certain Cuban imports. 31 C.F.R. § 515.582. Legislation is pending in the Senate to lift the embargo in its entirety. S.249, 117th Congress, United States – Cuba Trade Act of 2021.

[42] Confusion need not be likely among all U.S. consumers, but only "an 'appreciable' number of purchasers…" *Bottega Veneta, Inc. v. Volume Shoe Corp.*, 226 USPQ 964, 967 (TTAB 1985).

they know about the embargo, U.S. premium cigars consumers believe the GC Cohiba "is not a Cuban cigar." However, these opinions fall far short. They are irreconcilable with the substantial proof of actual confusion provided by CT and, indeed, by Hacker himself. The issue is not confined to whether consumers believe GC's is a Cuban cigar, but includes association confusion. Hacker and the GC employee say nothing about the least sophisticated potential purchasers. Even as to premium cigar smokers, their assertions are simply inferences drawn from the consumers *silence* about confusion in casual conversations, and, further, the conversations were only with a narrow range of high-end and/or particularly interested cigar smokers.

1. Same Name, Same Goods/Arbitrary and Fanciful Mark (*du Pont* Factor No. 1)

As the two marks at issue are identical, confusion is normally "inevitable." That the mark COHIBA is arbitrary and fanciful as well, as GC has acknowledged,[43] makes this case even more of a "slam dunk." 4 MCCARTHY § 23:20.

2. Extent of Public Recognition and Renown (*du Pont* Factor No. 5)

The Cuban Cohiba's "extensive public recognition and renown" among "the class of customers and potential customers of" cigars "plays a dominant role" in assessing likelihood of confusion. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1374, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005) (internal quotations and citations omitted). *See supra* pp.26-35, for the extraordinary reputation and renown since *Cigar Aficionado*'s premier issue and continuing to today, thirty years later, as GC's own expert acknowledges (Cuban Cohiba is "well-known," "it is *the* cigar" (emphasis in original).[44]

3. Conditions Under Which, and Buyers to Whom, Sales Are Made (*du Pont* Factor No. 4)

Where, as here, both marks are simply for "cigars" without limitation as to type (*e.g.*, premium

[43] 179 TTABVUE 231-32, 257; *General Cigar Co., Inc. v. G.D.M., Inc.*, 988 F. Supp. 647, 660-61, 45 USPQ2d 1481 (S.D.N.Y. 1997). *See also* 169 TTABVUE 3, 40, 136-143 (PTO: ancient word for tobacco in extinct language).

[44] *See e.g., Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1373, 1375-76, 63 USPQ2d 1303, 1307, 1309 (Fed. Cir. 2002) (fame can be based on critical assessment in the press).

versus machine-made), channel, consumer, origin or price, the Board bases its decision "on the least sophisticated potential purchasers." *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) (quotations omitted). Those purchasers are *not* premium cigar consumers, but someone buying cigars for "a buck each or less" at a liquor or convenience store or gas station. [redacted] ars.[45] GC's expert acknowledges that purchasers of non-premium cigars are not "interested in discovering" the "specific details concerning the cigars he is interested in buying." 347 TTABVUE 2, 97 (Hacker). [redacted][46] That cigars are sold at liquor and convenience stores and gas stations adds to the impulse nature of purchases.[47] [redacted]

Although the appropriate metric is consumers purchasing low priced cigars, it is also the case that the premium cigar market is segmented. At a specialty premium cigar chain, 20-30% of customers are inexperienced smokers who "often" ask if the GC's Cohiba is "from Cuba." 348 TTABVUE 1724, 1738-1741, 1754-56, 1775-1776, 1838 (Labor, salesman/asst. manager, 2013-2017); *see also* below for other evidence of actual confusion. [redacted]

[45] 205 TTABVUE 2, 17-19, 238-45; 215 TTABVUE 2-3, 55-60. Prices for GC's other Cohiba cigars can be around $10 per cigar. 217 TTABVUE 2-3, 70-79; 216 TTABVUE 90-125.

[46] [redacted]).

[47] The Board has repeatedly recognized what GC has conceded. *See, e.g.*, *In re Sailerbrau Franz Sailer*, 23 USPQ2d 1719, 1720 (TTAB 1992) (wine and beer "are not expensive… requiring…careful thought and/or expertise"; "More often" they are "purchased on a somewhat casual basis"); *Up in Smoke, Inc. v. What A Life, LLC*, No. 91213604, 2015 WL 4779215, at *5 (TTAB July 27, 2015) (non-precedent) (no "extraordinary degree of care" for cigars at $12.10 per box); *First Coast Energy, L.L.P. v. Dhukani Holdings, LLC*, No. 91231925, 2019 WL 1491528, at *5 (TTAB Mar. 18, 2019) (non-precedent) ("convenience store purchases are often prompted by impulse or immediate need").

[redacted]

Each of the Other du Pont Factors Favors a Likelihood of Confusion

Although the Board need not consider the other *du Pont* factors in light of the above, each of them also strongly favors a finding of likelihood of confusion.

4. General Cigar's Enforcement Actions (*du Pont* Factor No. 13)

General Cigar's enforcement actions effectively concede likelihood of confusion. Perhaps most strikingly, for over 25 years and continuing to today, GC has recorded its registrations with U.S. Customs pursuant to 19 C.F.R. § 133.22(a), which bar the importation of products bearing a mark that so resembles the recorded mark "as to be likely to cause the public to associate [the foreign mark] with the recorded mark," [redacted]. GC obtained three injunctions in 2006-13 [redacted]

5. Evidence of Actual Confusion / How Confusion Is Engendered (*du Pont* Factor Nos. 7 & 8)

[redacted]).

[49] *See also* GC's acknowledgments that Cuban Cohiba's trade dress well-known to U.S. consumers since 1992. 180 TTABVUE 594 (1992); 342 TTABVUE 977, 1261 (Cullman, Jr.).

There is substantial evidence of actual confusion, as well as of how confusion is engendered.

(a) <u>Evidence of Actual Confusion</u>

i. [redacted]

ii. [redacted]

iii. [redacted]

[redacted]

iv. A salesperson/asst. manager at a retail premium cigar chain testified that in 2013-17 "9 out of 10" inexperienced smokers asked him if "these [are] the Cuban ones" when they walked by the GC Cohiba area. Inexperienced smokers were 20-30% of the "hundreds" of in-store customers he interacted with at the store each week. 348 TTABVUE 1724, 1754-56, 1771-1776, 1836-1839 (Labor).

v. Salespersons at six different retail stores (in four different towns in Pennsylvania and Florida, including at GC's sister company's store, Cigars International) told CT's investigators that cigar consumers asked if the Cohiba cigar they sell is the Cuban Cohiba cigar. 167 TTABVUE 433-36 (question "very common"; get it "all the time"), 462-65, 473-76.

vi. Numerous different Instagram, Twitter and Facebook users link images of the Cuban Cohiba to GC's Cohiba Instagram, Twitter and Facebook accounts; show a GC Cohiba with the hashtag "#cuba", "#cuban", "#cubancigars" and/or "#cubancigar"; or link images of the GC Cohiba to accounts dedicated to the Cuban Cohiba. 219-20 TTABVUE (evidence from 2013-2018); *see also* 200-201 TTABVUE. This both shows actual confusion and engenders confusion among these users' hundreds of thousands of social media followers.[50] Individual posts express actual confusion, *e.g.*: "is this the real cohiba brand? aka the cuban state-owned group." 167 TTABVUE 6-7, 323, 328 (GC Cohiba's YouTube account, 2017).

vii. Several U.S. retailers use the Cuban Cohiba trade dress to sell the GC Cohiba (downloaded 2017-18). Because this confusion was online, its impact is not isolated, a position GC has advanced.[51]

viii. [redacted]

[50] GC successfully argued this type of evidence showed confusion in a 2013 case when the defendant used 'Cohiba' with the familiar Cuban Cohiba trade dress. 169 TTABVUE 11, 486-87, 494. ("potential customers searching for [GC] online may mistake Defendants' website and/or social media presence for that of [GC] and be erroneously drawn to Defendants' offerings").

[51] 205 TTABVUE 2, 19-20 (¶ 10), 246-52; 217 TTABVUE 2, 79-82 (¶ 28 and Annexes cited); 167 TTABVUE 2, 9-12; 225 TTABVUE 2, 50-51 (¶ 32), 457-67; 169 TTABVUE 571, 579-81 (GC argued this is actual confusion); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975).

[52] [redacted]

[redacted] [53]

ix. Several articles about the *Cuban* Cohiba on U.S. online publications (2015-18) hyperlink the word 'Cohiba,' *to GC's Cohiba website*. 217 TTABVUE 2, 29-33, 393-423, 428-29, 434-39.

x. [redacted]

"[A]ctual confusion…is not required," *Time Warner Entm't Co. v. Jones*, 65 USPQ2d 1650, 1662 (TTAB 2002), especially when the marks and goods are identical, *Towers v. Advent Software Inc.*, 17 USPQ2d 1471, 1473 (TTAB 1989); "evidence of actual confusion is notoriously difficult to come by" *Time Warner*, 65 USPQ2d at 1662. Nonetheless, CT has shown actual confusion, which is "highly probative, if not conclusive, of a high likelihood of confusion." *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Even "a single instance of actual confusion" can be sufficient to find likelihood of confusion, as it can be "illustrative of a situation showing how and why confusion is likely."[54] Even if some of CT's evidence is not considered actual confusion, which it is, it is still "at least illustrative of how and why confusion is likely."[55]

xi. [redacted]

[redacted]

[53] [redacted]

[54] *Molenaar, Inc.*, 188 USPQ at 471 (internal quotation and citation omitted); *see also Amtrol, Inc. v. Mid-Atl. Plumbing & Water Treatment Sys.*, No. 92041101, 2006 WL 936994 (TTAB Mar. 30, 2006) (non-precedent); *Standard Tools & Equip. Co. v. Dropship LLC*, No. 91222920, 2018 WL 2129883 (TTAB May 7, 2018) (non-precedent).

[55] *See Great Adirondack*, 2019 WL 646098, *10 (even without direct testimony about certain evidence, Board found evidence "as a whole" established that "there ha[d] been instances … of confusion").

[redacted]

(b) Evidence Illustrating "How and Why Confusion Is Likely"

Still other evidence "illustrat[es]…how and why confusion is likely."

i. [redacted]

ii. [redacted] numerous U.S. retailers, [redacted] promote GC's Cohiba as associated with or connected to the Cuban Cohiba. 282 TTABVUE 6. For example, GC's sister company, Cigars International, promotes it as: "Originally crafted in the streets of Havana, Cuba, this is a classic that everyone's heard of"; "This line originated from the special blend of tobaccos that Fidel Castro himself used to smoke…"; "Castro…commissioned Cohiba….today they are considered the greatest cigar brand in Cuba." 221 TTABVUE 3-5; *see also id.*, at 6-21, 28-29, for other U.S. retailers,

[56] [redacted]

From July 2012 until at least July 26, 2018, GC placed on its Cohiba Facebook page the "Milestone"—"1982—Cohiba cigars are introduced worldwide with the exception of the United States"—showing an image of a GC Cohiba, even though 1982 was the year CT began exporting Cohiba and GC has never exported its Cohiba. 167 TTABVUE 6 (¶ 15), 305-19; 217 TTABVUE 37 (¶ 14), 609-11; 349 [redacted]

[redacted], *see* 35[redacted] 171 TTABVUE 716-19 (retailer promotions in 2004); 216 TTABVUE 193-96 (print catalog). GC's expert testified that even U.S. *premium* cigar consumers not familiar with the GC and Cuban Cohiba cigars could "misconstrue" these promotions to think that there is "an association" between the two cigars or that GC "licensed the Cohiba name from the Cubans." 347 TTABVUE 62-68, 70, 73.

General Cigar acknowledged 20 years ago that such retailer descriptions, prevalent then as now, link GC's Cohiba with the Cuban Cohiba, 169 TTABVUE 25 (¶50); 171 TTABVUE 680-82, 685, but, despite conceding that it is "inappropriate," [redacted] To the contrary, and significantly, GC *links* its Cohiba website to ten of these retailers. 200 TTABVUE 8, 566-598 (Mustafa); [redacted]

iii. A cigar app for mobile devices, identified by GC's expert as one of cigar consumers' "favorite[s]" for "fact checking", lists under "Cuban Cigars" several different Cuban Cohiba cigars with a description of *GC's* "Red Dot" Cohiba cigars, identifying the cigar's "Country" as the "Dominican Republic" where GC's Cohiba cigars are produced; it also lists a GC Cohiba cigar as a "Cuban Cigar" whose "Country" is "Cuba" and includes a description and image of the Cuban Cohiba cigar. 217 TTABVUE 84-89; 347 TTABVUE 36-37, 157 (Hacker); 200 TTABVUE 602-663.

iv. The famous musician Jay-Z linked his social media announcement of a GC Cohiba-branded cigar he co-developed to an account for the Cuban Cohiba cigar. [redacted] Numerous U.S. consumers commented to the post by stating "that's why" Jay-Z went to Cuba right before. 217 TTABVUE 37-38, 612-45.

6. The Extent of Potential Confusion Is Substantial (*du Pont* Factor No. 12)

The extent of potential confusion is substantial because: (1) cigars are marketed to, and purchased

by, the public at large;[57] (2) consumers paying $1 or less for a cigar at a liquor or convenience store or gas station cannot be expected to exercise care; (3) the marks are identical for identical goods; (4) U.S. retailers and GC itself falsely link the GC Cohiba to the Cuban Cohiba; and (5) persons on social media regularly link the GC and Cuban Cohiba.

7. Both Cohibas Target the Same Trade Channels, Appear in the Same Media and Would be Sold in Same Trade Channels *Post*-Embargo (*du Pont* Factor No. 3)

Although CT currently is precluded from selling Cohiba in the U.S., [redacted]

- There are multiple digital and print articles concerning the Cuban Cohiba cigar in publications where GC advertises its Cohiba. 221 TTABVUE 2, 30-35; 169 TTABVUE 27 (¶ 58); 231 TTABVUE. Articles about the GC and Cuban Cohiba appear in the same cigar magazines and general circulation newspapers. 226 TTABVUE 2, 53-54, 58-59, 61-65; 217 TTABVUE 104-07 (¶ 40); [redacted] Although the Cuban COHIBA is mentioned in the press by itself far more often, a substantial number of press articles mention both cigars, as shown above.
- Individuals frequently post images on social media of the GC and Cuban Cohiba side-by-side. 220 TTABVUE 3, 6 (¶¶ 3(f) & 4), 21-23; 219 TTABVUE 105-165.
- [redacted]).[58]
- A Google search for "Cohiba" and "Cohiba cigar" results in images of both the GC and Cuban Cohiba, as well as links to websites concerning either. 167 TTABVUE 2, 5-6 (¶¶ 13-14), 229-304.
- A search for "#cohiba" on social media leads to images of either the GC or the Cuban Cohiba. 200 TTABVUE 399-564; 350 TTABVUE 1027-28 (Harris, hashtag used "to be part of that content stream").

[57] *In re M&D Wholesale Distrib., Inc.*, No. 86182803, 2016 WL 4437717, at *4 (July 25, 2016) (non-precedent) (cigars "frequently purchased by the public at large;" potential confusion "is substantial").

[58] [redacted]

- [redacted][59]

8. GC's Copying and Intent to Exploit the Cuban Cohiba's Renown (*du Pont* Factor No. 13)

As shown, GC selected and applied to register COHIBA in 1992 to exploit the reputation and renown of the Cuban Cohiba, and its marketing plan has been based on doing just that. It has long known that U.S. retailers promote GC's Cohiba by connecting it to the Cuban Cohiba, but, instead of stopping the practice, it *links* its Cohiba website to these retailers. [redacted]

9. No Evidence of Similar Marks on Similar Goods (*du Pont* Factor No. 6)

A mark's relative weakness due to widespread use by third parties weighs against confusion, *Palm Bay Imports*, 73 USPQ2d at 1694, but there is no suggestion here by either Party that COHIBA has become weak, and none would be possible.[60]

10. The Variety of Goods, Market Interface and Right to Exclude (*du Pont* Factor Nos. 9-11)

Factor No. 9 favors CT as consumers are likely to view GC's Cohiba cigars "as a[] [line]

[59] [redacted] *see also Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (because no limits in registrations or application here, "all channels of trade normal for those goods" are "presumed").

Both the GC and Cuban Cohiba cigars are currently sold on the same U.S. resale marketplaces, such as Craigslist. 217 TTABVUE 3, 91-94 (¶ 32). Until recent amendments, U.S. travelers to Cuba were permitted to bring back Cuban cigars up to certain limits. 169 TTABVUE 24; 171 TTABVUE 316-679.

[60] That third-parties counterfeit the Cuban Cohiba only reinforces the strength of the mark. 176 TTABVUE 23-25, 29 (Cuban Cohiba commonly counterfeited).

extension of" the Cuban Cohiba cigar.[61] Factor No. 10 is not relevant as there has been no market interface between the Parties. Because this proceeding is to determine the validity of GC's Cohiba registrations and its right to exclude others from use of COHIBA, Factor No. 11 is neutral.[62]

General Cigar Does Not Overcome the Substantial Showing of Likelihood of Confusion and That Even Premium Cigar Smokers Do Not Know If It Is Illegal to Buy Cuban Cigars in the U.S,

General Cigar's position that the embargo sufficiently dispels confusion faces an insuperable uphill challenge that GC does not come even close to scaling.

i. The above is more than sufficient to show that, even for *premium* cigar smokers, there is a likelihood of confusion now *despite 60 years of the embargo*. CT similarly showed a likelihood of confusion among premium cigar smokers in the Federal Action, on evidence (also presented here) that the District Court found sufficiently compelling to find likelihood of confusion, *Empresa*, 70 USPQ2d at 1655-59, *despite 40 years of the embargo*.[63] There is no plausible reason to assume the embargo prevents confusion for the "*least sophisticated potential purchaser*" when it has not for *premium* cigar smokers after either 40 or 60 years. GC has offered no proof to support such a notion, let alone sufficiently compelling proof; and CT's evidence clearly shows that the embargo is not the cure GC proffers but cannot substantiate.

To the contrary, GC's expert confirms that an appreciable number of *even U.S. premium cigar consumers* do not know if it is illegal to purchase Cuban cigars in the U.S. He testified that: (i) 20-30% of premium cigar smokers ask retailers "if they could buy Cuban cigars in the U.S.", 273 TTABVUE 11 (¶ 27); 347 TTABVUE 2, 83, 106-107, 138-139, which is consistent with testimony by a premium cigar

[61] *Shannon DeVivo v. Celeste Ortiz*, 2020 USPQ2d 10153, at *14-15 (TTAB 2020) (purchasers likely to view other party's goods "as an extension" supports likelihood of confusion).

[62] *Hormel Foods Corp. v. Spam Arrest LLC*, No. 9204213, 2007 WL 4287254, at *15 (TTAB Nov. 21, 2007) (non-precedent).

[63] If the embargo did not sufficiently dispel confusion arising from the same name being applied to the same goods after 40 years, there is no reason to assume it would do the trick after 60 years. Moreover, CT's expert in the Federal Action explained at GC's deposition of him here that the same factors that engendered and reinforced consumer confusion after 40 years remain at work, including the way retailers promote the GC Cohiba. 347 TTABVUE 353-55, 711-34 (Ossip).

chain salesperson/assistant manager, other retail sales staff interviewed by CT investigators, [redacted] *supra* p.41-42;[64] (ii) the U.S. media's "misconception" that "Cuban tobacco was legal in the U.S." after President Obama's steps towards normalization produced articles whose headlines would make people "believe that Cuban cigars could be legally sold in the United States," 347 TTABVUE 92-94, 138; and (iii) consumers would think there is "an association between Cuba and [GC's] Cohiba" based on U.S. retailers' online descriptions of GC's Cohiba cigar, at least people "who didn't know" the GC and Cuban Cohiba cigars. 347 TTABVUE 68, 56-68 (Hacker).

There is still further, ample evidence that the embargo does not sufficiently dispel confusion. Consumer requests to purchase Cuban cigars from a Florida cigar chain are so frequent, 348 TTABVUE 1769-1771, 1843-1847 (Labor), that its website's "tutorial" section includes the question: "Do you carry Cuban cigars?" *Id.* at 1767-68, 1840-42 (updated in 2015). GC's VP testified in Oct. 2006 in a criminal case that he "do[es]n't think" the American public "know[s] that Cohiba [Esplendidos, a Cuban Cohiba] are not sold in the United States." 171 TTABVUE 850-54, 868.

Finally, and importantly, even if U.S. consumers believe the embargo prohibits the sale of Cuban cigars in the U.S., they may think that U.S. law does not prohibit arrangements that would constitute association confusion,[65] including, correctly, that a Cuban company may hold a minority interest in, or provide technical advice and quality review, to a third-country company that exports COHIBA-branded cigars to the U.S. without Cuban tobacco. *Empresa*, 213 F. Supp. 2d at 275 n.43.[66]

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[64] [redacted]

[65] There is likelihood of confusion when consumers believe goods are "somehow associated with or sponsored by the same entity" or are "authorized by, or are otherwise connected to the same source." *Hilson Research Inc. v. Soc'y for Human Res.*, 27 USPQ2d 1423, 1429 (TTAB 1993) & *Joel Gott*, 107 USPQ2d at 1431.

[66] *See* 216 TTABVUE 335-36, 217 TTABVUE 3, 110 (2015 U.S. Reddit poster thought Cuban company "had maybe branched off to other countries where they could export their product to the US"). [redacted]

(*continued*)

ii. The opinion offered by Hacker, GC's expert, and Abbot, GC's Senior Brand Manager, that knowledge of the embargo dispels confusion among premium cigar smokers does not stand up to the strength of CT's above showing to the contrary, [redacted] and, indeed, Hacker's own multiple acknowledgments of confusion. 287 TTABVUE 5, 20 (¶¶ 8(d), 37) (Abbot); 273 TTABVUE 11 (¶ 26) (Hacker). In addition, their opinions are entitled to little or no weight even aside from this, for multiple reasons.

First, they say nothing about the least sophisticated cigar consumers' knowledge of the embargo.[67] *Second*, Hacker opines on whether premium cigar consumers understand that Cuban cigars cannot be sold in the U.S., which does not address association confusion. *Third*, it is unclear whether Hacker addresses association confusion at all, as he only asserts that consumers know that the two *cigars* are "completely different and unconnected," 273 TTABVUE 12, and, in any event, his opinion that there is no association confusion, if that is what he meant, expressly rests entirely on his patently fallacious assumption that consumers know there is no association "because they can buy the [GC Cohiba] but not the [Cuban Cohiba]." *Id. Fourth,* Hacker never asked consumers about whether they think the GC Cohiba is connected to the Cuban Cohiba. 347 TTABVUE 107-10. *Fifth*, Hacker's opinion, in addition to being contradicted by his own, noted testimony supporting likelihood of confusion, is based on negative inferences he draws from consumers not asking him questions or volunteering comments indicating that "he or she was confusing" the GC Cohiba with the Cuban Cohiba, an unreliable inference that, moreover,

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Cigar consumers are familiar with "line extensions," including for COHIBA: GC's Cohiba cigars are made in multiple countries (D.R., Honduras and Nicaragua) using tobacco from several countries and packaging identifying various manufacturers. 225 TTABVUE 2, 110, 130, 135, 142; 287 TTABVUE 2, 10, 12-14, 72, 76, 86, 95-96 (Abbot).

[67] Hacker "do[es]n't deal with" mass market cigars; his report is not about that part of the cigar market. 347 TTABVUE 38, 51-52. Abbot similarly only testifies as to premium smokers. 287 TTABVUE 5, 20.

Hacker's testimony is not even about the broad spectrum of premium cigar smokers, but only highly-engaged premium cigar smokers. He bases his opinion on interactions with consumers at cigar seminars, places like a private cigar club in Beverly Hills, wine and cigar tastings and, even though he acknowledges that brick and mortar retail tobacco stores are dwindling in number, 10-12 stores. 347 TTABVUE 16-17, 38-41, 46, 48 (Hacker); 273 TTABVUE 7-8, 24 (Hacker).

does not apply to association confusion. *Sixth*, Hacker, although asserting that consumers are now more informed than previously because of the internet, is not qualified to opine on this topic, as he admittedly is "computer illiterate," "do[esn't] have a smart phone" and did not even visit the cigar apps he relies upon in his report, 347 TTABVUE 23, 36, and his unqualified opinion is contradicted by the ample proof shown above that the internet is riddled with misinformation about Cohiba and spreads confusion.

As to Abbot, *First,* his opinion is *not* based on interactions with consumers at all, he never discussed the Cuban Cohiba with consumers, 354 TTABVUE 98, 117-118 (Abbot), but purely on: (i) "the long duration of the embargo," which is insufficient and says nothing about what consumers' understand to be its prohibitions; and (ii) purported "representative" articles that mention the embargo, which Abbot *assumes* are read carefully and understood, and one of which recognized that most press engenders *widespread confusion* about the embargo and the availability of Cuban cigars.[68] 287 TTABVUE 20 (¶ 37 Annex S). *Second*, none of the articles he references as representative identify prohibitions on the sort of relationships and arrangements that would tend to dispel association confusion, only prohibitions on Cuban imports. *Third*, Abbot opines about whether consumers believe Cuban cigars cannot be sold in the U.S., not about association confusion, notwithstanding random nods to that issue thrown in without any cited support in his supposed sources of his information. 287 TTABVUE 5-6, 20-21 (Abbot).

Even if CT had not presented compelling evidence of a likelihood of confusion, and that consumer knowledge of the embargo, whatever it may be, does not sufficiently dispel confusion, Board precedent would require GC to present more than Hacker and Abbot's opinions. The Board has rejected arguments based on the embargo when the "applicant has offered no evidence that the embargo on Cuban products would have any effect on the perception of KUBA KUBA as a geographically deceptive term." *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1646-47 (TTAB 2011).[69] GC's offer of Hacker and Abbot's

[68] [redacted]

[69] The Board has done the same in *In re G & R Brands, LLC*, No. 77417467, 2010 WL 2604975, *5 (TTAB June 14, 2010) (non-precedent) (rejecting argument based on purported consumer knowledge of

unsubstantiated, internally inconsistent, illogically reasoned, and off-point opinions on the embargo's effect on the similar issue of source confusion can fare no better.

iii. As the Board has also explained, showing that consumers know some things about the embargo—essentially, all that Hacker and Abbot even arguably accomplish—is not enough, since consumers "might incorrectly think that applicant's cigars are somehow eligible for an exception to the embargo." *In re Drew Estate Holding Co.*, No. 77840485, 2014 WL 1390500, at *5 (TTAB Mar. 25, 2014) (non-precedent). The point is far more powerful here than in *Drew* because, unlike there and in the Board's other Cuban geographic indicator cases, the issue is not only whether consumers' knowledge of the embargo leads them to believe there cannot be a Cuban-origin cigar sold in the U.S., but also whether it leads them to believe there cannot be any association between the maker of the imported cigar and a Cuban company.

iv. Inasmuch as GC has objected to CT's rebuttal evidence, 333 TTABVUE, and in order to facilitate the Board's review of the objection, CT has not cited that evidence in its discussion so far. Nonetheless, it is both proper and provides additional, powerful support for rejecting GC's embargo argument. It shows that: one of only nine "Frequently Asked Questions" *GC itself* posted *to its own website in 2019* is "Are Cuban cigars legal in the United States?" 308 TTABVUE 2, 31 (¶ 27), 309 TTABVUE 65-68; consumers in the U.S. frequently ask questions in search engines about the legality of purchasing Cuban cigars in the U.S., such as "Are Cuban cigars legal in the US." 308 TTABVUE 29-31; 309 TTABVUE 46-64; numerous posts on Reddit by U.S. consumers express confusion over the embargo, such as "Is it now legal to buy Cuban cigars in the US?" 308 TTABVUE 31-37; 309 TTABVUE 84-131; and searches for the Cuban Cohiba on the Yahoo and Bing search engines direct U.S. consumers to retailers selling GC's Cohiba cigars. 308 TTABVUE 37-50; *see also id.* at 5-20 (actual confusion despite embargo).

C. Cancellation Is Required Because GC Adopted and Used the Mark to Exploit Another's Reputation and Renown (Eighth Ground)

embargo in GDM case); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944, 1945-47 (TTAB 2000) (same); *In re Compania de Licores Internacionales*, 102 USPQ2d 1841, 1848 (TTAB 2012) (same, citing cases).

The case for cancellation under section 14(3); 15 U.S.C. § 1604(3), is compelling. As shown, GC selected and registered COHIBA in 1992 in order to exploit the reputation and renown of the Cuban COHIBA, and its marketing plans have attempted to do just that.

Further, as part of that plan, GC has propagated a false common history with the Cuban COHIBA, and it has both permitted its retailers to do the same and linked its own marketing to their false histories. The retailers expressly, continuously and prominently misrepresent the source of the GC Cohiba as once having been the source of the Cuban Cohiba. *See supra* pp.44-45 and 221 TTABVUE 3-14 for this misrepresentation running through the promotions of 18 retailers. This has been the common retailer practice continuously since Dunhill promoted the GC Cohiba as "the celebrated range of Cuban origin," 191 TTABVUE 330-31, 349.[70] GC [redacted] added a *link* to 10 of these retailers in the "Find Online Retailers" section of its Cohiba website. *See supra* pp.45, 47.

Additionally, GC's "intent from the beginning [was] to market Cohiba the same way [it] marketed [its] other" parallel "Cuban-origin brands." 341 TTABVUE 10 (Cullman, Jr.). GC's expert acknowledged that, "from the fact that there are so many dual nationals [Hacker's apt term for "parallel brands]" on the market, many of them "well-known," "some people are likely to believe" that the GC Cohiba "is also a dual national"—that is, made by the family that made the brand in Cuba before leaving after the 1959 Revolution (or their successors). 347 TTABVUE 111-113. The false parallel brand perception and the false intermingling of the two cigars' histories augment the misrepresentation.

Section 14(3) provides for cancellation where, as here, there is "blatant misuse of the mark" by using, or permitting others to use, it "in a manner calculated to trade on the goodwill and reputation of petitioner." *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Trading upon a false common history, or permitting others to do so, merits section 14(3)'s application. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 713 (4th Cir. 2016); *see also Belmora LLC v. Bayer Consumer*

[70] For other retailers during 1997-2002, *see, e.g.*, 178 TTABVUE 1967, 1969; 2026, 2028;183 TTABVUE 109, 112; 285, 288.

Care, 110 USPQ2d 1623, 1637 (TTAB 2014) (ordering cancellation), *upheld by* 987 F.3d 284 (4th Cir. 2021). So too, as is also the case here, does use, or permitting others to use, a mark to "blur the distinctions…between the marks and the goods of the parties." *McDonnell Douglas Corp. v. Nat'l Data Co.*, 228 USPQ 45, 47 (TTAB 1985). The situation is remarkably akin to *Cuban Cigar Brands v. Upmann Int'l., Inc.* 457 F. Supp. 1091, 199 USPQ 193 (S.D.N.Y. 1978), another case involving misrepresentation of a cigar as a parallel Cuban brand, where cancellation was ordered.

While section 14(3) is broader in its application, GC's conduct is "palming off" even in a strict sense. GC is misrepresenting, and permitting its retailers to misrepresent, the source of its Cohiba as the company that once made Cohiba-branded cigars in Cuba. Neither section 14(a)(3)'s text nor purpose requires that petitioner be the source as to which misrepresentation is made, or that the source be real.

III. Respondent's Affirmative Defenses Are Not Properly Plead and Lack Merit

The Federal Circuit rejected GC's First – Fourth Affirmative Defenses. GC's Fifth Affirmative Defense, that fraud was inadequately alleged, has been addressed in Point IB.

General Cigar expressly waived its Sixth Affirmative Defense, unclean hands, for the period after Jan. 1, 2003. 352 TTABVUE 413-420. As to the prior period for unclean hands, and also the Ninth Affirmative Defense of laches, acquiescence, waiver and estoppel, their dismissal is required because GC did not allege any facts at all in support of its bare conclusory assertion that "Petitioner's claims are barred by the doctrine of unclean hands," and "Petitioner's claims are barred under the principles of laches, acquiescence, waiver and estoppel." 62 TTABVUE.[71] If GC makes fact allegations and advances evidence in its Opposition, CT will address these Affirmative Defenses further in its Reply.

General Cigar's Seventh Affirmative Defense, that section 14's "statute of limitations" bars CT's claims, is groundless. As to the First Registration, the section's time limits do not apply to Pan-American

[71] *See, e.g., Jill E. Peterson v. Awshucks Sc, LLC*, No. 9206695, 2020 WL 7888976 (TTAB Dec. 23, 2020) (waiver and estoppel), *quoting Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc*., 5 USPQ2d 1067, 1069 (TTAB 1987) (unclean hands); *Lodestar Anstalt v. Bacardi and Co.*, No. 91216163, 2017 WL 513974, at *3 (TTAB Feb. 2, 2017) (non-precedent) (unclean hands, laches, acquiescence, estoppel and waiver).

Convention, Art. 8 claims. *British-American Tobacco Co. v. Philip Morris,* 55 USPQ2d 1585, 1590 (TTAB 2000); claims of fraudulent filings and abandonment are expressly exempt. CT's cancellation petition was filed less than five years after GC's application that matured into its second Registration.

General Cigar's Eighth Affirmative Defense, that CT abandoned its mark through non-enforcement was stricken in *Empresa*, 213 F.R.D. at 155, for persuasive reasons. "Failure to sue third-party infringers is relevant to 'abandonment' only when the failure causes the mark to lose all trademark significance" 3 MCCARTHY § 17:17, *see also Leatherwood Scopes Int'l, Inc. v. Leatherwood*, 63 USPQ2d 1699 (TTAB 2002), but no such allegation has been made, and none is possible. And, even aside from this fatal failure, the Affirmative Defense does not allege who were the third-party infringers that CT should have but did not sue. Finally, it is also preposterous on its face: CT has pursued GC, by far the largest infringer of CT's asserted rights, for 24 years before this Board and the federal courts.[72]

As to the Tenth Affirmative Defense, that there was no leave for CT to file an Amended Petition, the Board has found that "by an order dated June 23, 2011 [Docket 60], the Board… permitted petitioner to file a motion or pleading, as it deemed appropriate, relevant to its petition to cancel. The same day, petitioner filed an amended petition to cancel." 75 TTABVUE at *1 & n. 3.

CONCLUSION

For the foregoing reasons, Registration Nos. 1147309 and 1898273 should be cancelled.

Dated: July 1, 2021

Respectfully submitted,

By: /Michael Krinsky/

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[72] CT also brought proceedings in the Dominican Republic against Monte Cristi, the principal D.R. exporter of COHIBA-branded cigars to the U.S. after GC. 339 TTABVUE 65, 69-72 (Garrido).

APPENDIX A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a. CUBATABACO,

Petitioner,

v.

GENERAL CIGAR CO., INC.,

Respondent.

Cancellation No. 92025859

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PETITIONER'S INDEX OF EVIDENCE

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Dated: July 1, 2021

APPENDIX A

Pursuant to the Board's September 29, 2018 Order, Petitioner Empresa Cubana del Tabaco, d.b.a. Cubatabaco ("CT") provides an "index of the evidence with each entry consisting of a description of the item and the TTABVUE entry number … [and] a reference to the TTABVUE entry for the stipulation that addresses the admissibility.[1]

For ease of reference, CT (1) has organized the Index by TTABVUE Docket No; and (2) includes in this Index evidence relied upon by CT whose admissibility is not based on a Stipulation.

TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
139 TTABVUE	Declaration of Enrique Babot Espinosa, Director of Operational Marketing for the Cuban Cohiba	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
141 TTABVUE	Declaration of Lisset Fernandez Garcia, CT's Legal Counsel	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
167 TTABVUE 002-432	Trial Declaration of Brenna Murdock, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
167 TTABVUE 433-61	Trial Declaration of David Girolami, CT investigator	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
167 TTABVUE 462-65	Trial Declaration of Tom Bailey, CT investigator	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
167 TTABVUE 473-76	Trial Declaration of Kevin A. Gregg, Esq., CT investigator	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
169 TTABVUE 003, 105, 107, 152-55	CT's Notice of Reliance Exhibit No. 01: PTO's refusal of CT's Application for the mark COHIBA	CT Application subject of Board inter partes proceeding, 37 C.F.R. § 2.122(b)(1), TBMP § 704.03(a); 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07

[1] The Federal Action trial transcript, written direct testimony, and deposition transcripts, identified in the Index below, were designated and filed with the Board pursuant to the procedure approved by the Board in 138 TTABVUE; 136 TTABVUE. The transcripts of the discovery depositions taken in this proceeding and introduced as evidence, identified in the Index below, were designated and filed with the Board pursuant to the procedure approved by the Board in 165 TTABVUE; 157 TTABVUE.

The Parties stipulated that they need not utilize a Notice of Reliance to introduce the above as well as the other Federal Action materials identified in this Index. *Supra* & 132 TTABVUE 3 (¶¶ 1-3); 137 TTABVUE 5 (¶ 6).

[2] Citations to the Parties' confidential filings with the Board assume that there is a cover page added to the first page of the docket entry.

APPENDIX A

TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
169 TTABVUE 011-13 (¶¶27-31 and exhibits cited therein); 169 TTABVUE 523-679	CT's Notice of Reliance Exhibit Nos. 27-31: GC's actions for trademark infringement against third parties for those third parties' use of a COHIBA trademark on cigars that included a design similar to the design used by the Cuban COHIBA cigar; documents produced by GC	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE; to the extent not covered by the above, Fed. R. Evid. 201; TBMP § 704.12 and 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
169 TTABVUE 018-21 (¶¶39-41 and exhibits cited therein); 170 TTABVUE 099-185	CT's Notice of Reliance Exhibit Nos. 39-41: Printouts from TTABVUE Trademark Trial and Appeal Board Inquiry System of the dockets for eleven (11) Opposition Proceedings and (13 Cancellation Proceedings in the TTAB initiated by CT against third parties; copies of the following nine (9) current USPTO Trademark Registrations issued to CT and printouts of the Status of each of these Trademark Registrations printed from the USPTO's Trademark Status & Document Retrieval system	37 C.F.R. § 2.122(e)(1) (Official records); Fed. R. Evid. 201; TBMP § 704.07
169 TTABVUE 136-143	CT's Notice of Reliance Exhibit No. 01: Jan. 20, 1998 Translation of the Mark 'Cohiba' by PTO, part of CT's application file	CT Application subject of Board inter partes proceeding, 37 C.F.R. § 2.122(b)(1), TBMP § 704.03(a); 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
169 TTABVUE 162-163	CT's Notice of Reliance Exhibit No. 1: CT's July 3, 1996 application to the PTO for the mark COHIBA	CT Application subject of Board inter partes proceeding, 37 C.F.R. § 2.122(b)(1), TBMP § 704.03(a); 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
169 TTABVUE 170	CT's Notice of Reliance Exhibit No. 02: A letter from R. Richard Newcomb, Director, Office of Foreign Assets Control U.S. Department of the Treasury, to Michael Krinsky, Esq., of Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C., dated August 19, 1996	37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
169 TTABVUE 486-522	CT's Notice of Reliance Exhibit No. 26: General Cigar's Complaint and Stipulation and Order in *General Cigar Company, Inc. vs. Agopian, et al.*, Case No. 2013-cv-00840, U.S. District Court for the Northern District of California (D.E. 1, Feb. 25, 2013 – Complaint; D.E. 19, June 14, 2013 - Stipulation).	132 TTABVUE 6 (Stipulation, ¶6(h)); 134 TTABVUE
169 TTABVUE 570-600	CT's Notice of Reliance Exhibit No. 28: Transcript of Motion for Summary Judgment in *GCC vs. Cohiba Caribbean's Finest* (D.E. 264; June 27, 2008)	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE
169 TTABVUE 680-691	CT's Notice of Reliance Exhibit No. 32: General Cigar Co., Inc.'s Responses and Objections to Empresa Cubana del Tabaco, d.b.a. Cubatabaco's Second Set of Requests for the Production of Documents in this proceeding, dated November 6, 2017.	37 C.F.R. § 2.120(k) (Interrogatory answers); TBMP § 704.10
171 TTABVUE 316-679	CT's Notice of Reliance Exhibit No. 49: excerpts concerning the legal import of Cuban cigars into the United States, from U.S. Department of Treasury's Office of Foreign Assets Control's Cuban Assets Control Regulations (1977-2018)	Fed. R. Evid. 201; TBMP § 704.12; 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
171 TTABVUE 680-687	CT's Notice of Reliance Exhibit No. 50: GC's Reply in Support of Motion to Stay in the Federal Action, April 20, 2004	132 TTABVUE 4 (Stipulation, ¶4); 134 TTABVUE; 37 C.F.R. § 2.122(e)(1) (Official records); TBMP § 704.07
171 TTABVUE 714-21	CT's Notice of Reliance Exhibit No. 53: printouts from U.S. cigar retailer websites included in Exhibit A to the Declaration of David Goldstein, Docket No. 246, dated April 19 2004 in the Federal Action	37 C.F.R. § 2.122(e)(1) (Printed publication); TBMP § 704.08

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
171 TTABVUE 739-40	CT's Notice of Reliance Exhibit No. 57: Printout from the U.S. Customs and Border Protection's Intellectual Property Rights Search (IPRS) system for the Customs Recordation of "Cohiba" in International Class 34 for "CIGARS" by General Cigar Co., Inc., Customs Recordation Number TMK 05-01010, with an "Effective Date" of December 15, 2005 and an "Expiration Date" of June 6, 2015	37 C.F.R. § 2.122(e)(1) (Official records); Fed. R. Evid. 201; TBMP § 704.07
171 TTABVUE 850-54, 868	CT's Notice of Reliance Exhibit No. 61: Excerpts from "Transcript of Jury Trial" from October 11, 2006 at 9:30am in *U.S. v. Penton*, Case No. 2006-cr-20169 (S.D. Fla. 2006) (Docket Entry 152).	132 TTABVUE 6 (Stipulation, ¶6(h)); 134 TTABVUE
174 TTABVUE 004-5, 40-41, 57-61, 84-85, 94-98, 122-23, 137-41	CT's Notice of Reliance Exhibit Nos. 3-5: [redacted]	132 TTABVUE 4 (Stipulation, ¶¶5, 7); 134 TTABVUE. These documents are also admissible as [redacted]
174 TTABVUE 163-179	CT's Notice of Reliance Exhibit No. 6: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE
174 TTABVUE 180-97	CT's Notice of Reliance Exhibit No. 7: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE
175 TTABVUE 113-120	CT's Notice of Reliance Exhibit No. 42: [redacted]	132 TTABVUE 7 (Stipulation, ¶7); 134 TTABVUE

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
175 TTABVUE 176-194	CT's Notice of Reliance Exhibit No. 70: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE. This document is also admissible as [redacted]
176 TTABVUE 023-46	CT's Notice of Reliance Exhibit No. 72: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE. This document is also admissible as [redacted]
176 TTABVUE 047-57	CT's Notice of Reliance Exhibit No. 73: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE. This document is also admissible as [redacted], [redacted].
176 TTABVUE 130-142	CT's Notice of Reliance Exhibit No. 82: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE. This document is also admissible as [redacted].

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
176 TTABVUE 2-22	CT's Notice of Reliance Exhibit No. 71: [redacted]	132 TTABVUE 4 (Stipulation, ¶5); 134 TTABVUE. This document is also admissible as [redacted]
178 TTABVUE 1700-1768	Federal Action CT's Trial Exhibit No. PX247 (*Cigar Aficionado)*: Stipulation in the Federal Action (2001)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
178 TTABVUE 1840-1876	Federal Action CT's Trial Exhibit No. PX284: 1997 GC Marketing Plan	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
178 TTABVUE 1943-1948	Federal Action CT's Trial Exhibit No. PX311 (Retail Tobacco Dealers of America): Stipulation in the Federal Action (2001)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
178 TTABVUE 1967-1973	Federal Action CT's Trial Exhibit No. PX327: Aug. 4, 1998 fax to GC's Rano re promotion	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
178 TTABVUE 1974, 1979	Federal Action CT's Trial Exhibit No. PX335: Dunhill catalog	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
179 TTABVUE 1092-1098	Federal Action CT's Trial Exhibit No. PX764: Cuban Cohiba's box	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
179 TTABVUE 231-295	Federal Action CT's Trial Exhibit No. PX647: GC's Post-Hearing Reply Memorandum in Support of Its Motion for Preliminary Injunction, dated Nov. 24, 1997, in *General Cigar Co,, Inc. v. G.D.M. Inc.*, Case No. 97-cv-7783 (S.D.N.Y.)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 255-262	Federal Action CT's Trial Exhibit No. PX953: GC Cohiba Box 1992-97	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 274-276	Federal Action CT's Trial Exhibit No. PX966: GC "Marketing the Cohiba Cigar"	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
180 TTABVUE 277-289	Federal Action CT's Trial Exhibit No. PX967: GC "Marketing the Cohiba Cigar"	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 290-308	Federal Action CT's Trial Exhibit Nos. PX968, PX970-71: June 4, 1993 memo to GC from its marketing company and June 29, 1993 Creative Strategy Development Statement	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 415-578	Federal Action CT's Trial Exhibit No. PX1062: *Cigar Aficionado* premier issue (Autumn 1992)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
180 TTABVUE 594-597	Federal Action CT's Trial Exhibit No. PX1084: Jan. 14, 1993 GC memorandum, misdated 1992. GC "Proposed Negotiations with Cuba re Cohiba"	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
182 TTABVUE 192-207 (list of articles identified as PX 1124(c)(2) 271-287, 290-98,303-06, 310-16, 318-21, 323-26, 328-33, 335, 337-46, 351-359; 182 TTABVUE 251-522)	Federal Action CT's Trial Exhibit No. PX1124 Schedule C(2): Newspaper, Magazine and Wire Service Articles Referencing Cohiba (Nov. 23, 1992-Sept. 25, 1997)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
182 TTABVUE 881-1100	Federal Action CT's Trial Exhibit No. PX1129 Schedule H: books referencing Cohiba	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
183 TTABVUE 109, 112	Federal Action CT's Trial Exhibit No. PX1131, Schedule J-001: Amalfi Cigar Co. website printout	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
183 TTABVUE 285, 288	Federal Action CT's Trial Exhibit No. PX1131, Schedule J-017: Famous Smoke 2001 website printout	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
185 TTABVUE 002-30	Federal Action CT's Trial Exhibit No. PX1157: The Wine Spectator (Feb. 15, 1992)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
185 TTABVUE 525-536	Federal Action CT's Trial Exhibit No. PX1221: 1992 circulation statistics for The Wine Spectator	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
190 TTABVUE 233-235	Federal Action GC's Trial Exhibit No. DX651: Declaration of Adargelio Garrido de la Grana, CT counsel	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
191 TTABVUE 330-350	Federal Action CT's Deposition Exhibit No. 72: Dunhill Catalog	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
192 TTABVUE 062-66	Federal Action CT's Deposition Exhibit No. 341: Forbes (Nov. 15, 1977)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
192 TTABVUE 150-158.	Federal Action CT's Deposition Exhibit No. 357: World Tobacco (July 1982)	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 109-115	Federal Action CT's Deposition Exhibit No. 28: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 116-123	Federal Action CT's Deposition Exhibit No. 29: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 241-255	Federal Action CT's Deposition Exhibit No. 69: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 286-287	Federal Action CT's Deposition Exhibit No. 110: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 378-383	Federal Action CT's Deposition Exhibit No. 127: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 678-686	Federal Action CT's Deposition Exhibit No. 232: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

APPENDIX A

TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
193 TTABVUE 698-753	Federal Action CT's Deposition Exhibit Nos. 234-241: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
193 TTABVUE 854-859	Federal Action CT's Deposition Exhibit Nos. 253-255: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 134-135	Federal Action CT's Deposition Exhibit No. 302: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 135-137	Federal Action CT's Deposition Exhibit No. 303: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 188-198	Federal Action CT's Deposition Exhibit No. 314: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 248-49	Federal Action CT's Deposition Exhibit No. 332: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 283-305	Federal Action CT's Deposition Exhibit No. 360: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 321-323	Federal Action CT's Deposition Exhibit No. 369A: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 326-29	Federal Action CT's Deposition Exhibit No. 371: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 401-402	Federal Action CT's Deposition Exhibit No. 398: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 420-22	Federal Action CT's Deposition Exhibit No. 405: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

APPENDIX A

TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
194 TTABVUE 424-425	Federal Action CT's Deposition Exhibit No. 406: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 520-521	Federal Action CT's Deposition Exhibit No. 433: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
194 TTABVUE 592-595	Federal Action CT's Deposition Exhibit No. 463: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
195 TTABVUE 124-25	Federal Action CT's Deposition Exhibit Burgh 7: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
195 TTABVUE 874-78	Federal Action CT's Deposition Exhibit Sharp 16: [redacted]	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
198 TTABVUE 142-145	Federal Action CT's Summary Judgment Exhibit No. 58: 12/12/77 memo in GC trademark file re Cuban Cohiba	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
198 TTABVUE 147-159	Federal Action CT's Summary Judgment Exhibit No. 81: Declaration of Mercedes Gonzalez Vazquez, administrator, factory that produced Cuban Cohibas	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
198 TTABVUE 496-98	Federal Action CT's Summary Judgment Exhibit No. 160: Cuban Cohiba box and trade dress	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
198 TTABVUE 499-517	Federal Action CT's Summary Judgment Exhibit No. 161: Declaration of Marta Moreno Cruz concerning trademark registrations by U.S. companies in Cuba	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
199 TTABVUE 002-043	Federal Action CT's Summary Judgment Exhibit No. 6: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
199 TTABVUE 044-76	Federal Action CT's Summary Judgment Exhibit No. 45: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
199 TTABVUE 077-79	Federal Action CT's Summary Judgment Exhibit No. 52: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
199 TTABVUE 080	Federal Action CT's Summary Judgment Exhibit No. 52: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
199 TTABVUE 091-95	Federal Action CT's Summary Judgment Exhibit No. 158: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
199 TTABVUE 096-98	Federal Action CT's Summary Judgment Exhibit No. 158: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
200 TTABVUE	Trial Declaration of Shkumbin Mustafa	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
201 TTABVUE	Trial Declaration of Shkumbin Mustafa (continued)	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
205 TTABVUE	Trial Declaration of Gerardo Ruiz, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
210 TTABVUE 013-18	Federal Action CT's Deposition Exhibit No. 2: GC 12/30/92 application to PTO	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
215 TTABVUE (Confidential)	Trial Declaration No. 3 of Annalisa Martini, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
216 TTABVUE (Public)	Trial Declaration No. 3 of Annalisa Martini, paralegal at counsel for CT (continued)	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
217 TTABVUE (Public)	Trial Declaration No. 3 of Annalisa Martini, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
219 TTABVUE (Public)	Trial Declaration No. 2 of Annalisa Martini, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
220 TTABVUE	Trial Declaration No. 2 of Annalisa Martini, paralegal at counsel for CT (continued)	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
221 TTABVUE	Trial Declaration of Susan Bailey, legal staff at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
223 TTABVUE (Confidential)	Trial Declaration of Alan Willner. Willner was GC's President in 2016 and Vice-President of Marketing from 2011-2016.	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
225 TTABVUE	Trial Declaration of Miguel Suarez Medina, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
226 TTABVUE	Trial Declaration of Christina Licata, paralegal at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
231 TTABVUE	CT's Notice of Reliance Exhibit No. 58: excerpts from *Cigar Aficionado* showing GC advertising its Cohiba cigar in issues with articles and rating about the Cuban Cohiba cigar (Nov./Dec. 2005 - Nov./Dec. 2016)	37 C.F.R. § 2.122(e)(1) (Printed publication); TBMP § 704.08
234 TTABVUE 092-93	Federal Action CT's Trial Exhibit PX182: market study commissioned by GC	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
234 TTABVUE 437-438	Federal Action CT's Trial Exhibit PX824: 11/20/92 GC shipments to Alfred Dunhill of London in U.S.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
234 TTABVUE 566-568	Federal Action CT's Trial Exhibit PX1134-02: GC's January 31, 1996 Recordation of its COHIBA trademark registration with the U.S. Customs Service	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
273 TTABVUE	Trial Declaration of Richard Carleton Hacker, GC's Expert	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
279 TTABVUE 124-204	GC Notice of Reliance Exhibit 8, Holt's Cigar Company's October 2019 Catalog	132 TTABVUE 6 (Stipulation, ¶6(k)); 134 TTABVUE
282 TTABVUE	Trial Declaration of Eugene Paul Richter, III. Richter is GC's Vice-President of Sales	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
284 TTABVUE 70 (Confidential)	Trial Declaration of Steven Abbot, Annex S: [redacted]	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
287 TTABVUE (Public)	Trial Declaration of Steven Abbot. [redacted]	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
308 TTABVUE	Trial Second Declaration of Susan Bailey, legal staff at counsel for CT	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
309 TTABVUE	Trial Second Declaration of Susan Bailey, legal staff at counsel for CT (continued)	Trail Testimony, 37 C.F.R. § 2.123(a)(1)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
312 TTABVUE 002-13	Federal Action CT's Trial Exhibit PX98: May 13, 1997 GC Product Development Guide	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
312 TTABVUE 304-18	Federal Action CT's Trial Exhibit PX899: Dunhill memorandum	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
319 TTABVUE 289-291	Federal Action CT's Summary Judgment Exhibit No. 59: Cover GC trademark file for Cohiba	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
319 TTABVUE 374-399	Federal Action CT's Summary Judgment Exhibit No. 80: Cuban Trademark Office documents	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
319 TTABVUE 400-411	Federal Action CT's Summary Judgment Exhibit No. 82: 1977 documents re store gifts by Fidel Castro	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
320 TTABVUE 136-140	Federal Action CT's Summary Judgment Exhibit No. 185: [redacted]	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
321 TTABVUE 365-372	Federal Action CT's Summary Judgment Exhibit No. 78: GC Section 15 Declaration	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
321 TTABVUE 373-374	Federal Action CT's Summary Judgment Exhibit No. 79: Acceptance of GC Section 15 Declaration	132 TTABVUE 3 (Stipulation, ¶1); 135 TTABVUE (Stipulation granted)
338 TTABVUE 2-1338	Designated Federal Action Trial Transcript	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
339 TTABVUE 065-143	Designated Federal Action Plaintiff's Written Direct Testimony and Appendices of Adargelio Garrido de la Grana, CT counsel	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
339 TTABVUE 144-179	Designated Federal Action Plaintiff's Written Direct Testimony and Exhibits of Bernardo Gonzalez Silveira, CT/Habanos S.A. Marketing Department staff	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
339 TTABVUE 188-198	Designated Federal Action Plaintiff's Written Direct Testimony of Kirby Jones, U.S. business consultant	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
339 TTABVUE 199-385	Designated Federal Action Plaintiff's Written Direct Testimony and Appendices of Ana Lopez Garcia, CT/Habanos S.A. Director of Marketing	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
340 TTABVUE 002-305	Designated Federal Action Plaintiff's Written Direct Testimony and Appendices of Alvin Ossip, CT market research expert	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
340 TTABVUE 306-745	Designated Federal Action Plaintiff's Written Direct Testimony and Appendices of Alan Siegel, CT branding expert	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
340 TTABVUE 746-753	Designated Federal Action Plaintiff's Written Direct Testimony of Wayne Smith, U.S. State Department	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
341 TTABVUE 002-32	Designated Federal Action Plaintiff's Written Direct Testimony of Edgar M. Cullman Jr., GC VP and later President	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 0073-226	Designated Federal Action Discovery Deposition Transcript of GC design firm, taken on June 30, 2000	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 0268-389	Designated Federal Action Discovery Deposition Transcript of Oscar L. Boruchin, taken on July 25, 2000. GC employee and later retailer	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 0763-950	Designated Federal Action Discovery Deposition Transcript of William M. Conder, taken on Nov. 07, 2000. GC R.30(b)(6) witness	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 0976-1298; 1359-1459	Designated Federal Action Discovery Deposition Transcript of Edgar M. Cullman Jr., taken on March 5-6 and Dec. 19, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
342 TTABVUE 1460-1566	Designated Federal Action Discovery Deposition Transcript of Edgar M. Cullman Sr., GC President and Chair, taken on April 03, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
343 TTABVUE 002-115	Designated Federal Action Discovery Deposition Transcript of Dickson Farrington, taken on Nov. 16, 2000, GC Director of Marketing.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 282-322	Designated Federal Action Discovery Deposition Transcript of James C. Fuller, taken on Dec. 11, 2001, U.S. journalist.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 626-700	Designated Federal Action Discovery Deposition Transcript of Mercedes Gonzalez Vasquez, Administrator at factory that made Cuban Cohibas, taken on Jan. 9, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 701-790	Designated Federal Action Discovery Deposition Transcript of Scott Greenberg, GC outside counsel, taken on July 23, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 896-997	Designated Federal Action Discovery Deposition Transcript of Michael J. Kowalsky, taken on Dec. 24, 2001, VP for Marketing, previously CAA's president	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
343 TTABVUE 998-1096	Designated Federal Action Discovery Deposition Transcript of Saul Landau, U.S. journalist, taken on May 21, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
344 TTABVUE 0234-366	Designated Federal Action Discovery Deposition Transcript of Alfons Mayer, 07.07.2000. GC R. 30(b)(6) witness	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
344 TTABVUE 0687-821	Designated Federal Action Discovery Deposition Transcript of Ronald S. Milstein, GC VP for Legal Affairs, taken on July 10, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
344 TTABVUE 0822-913	Designated Federal Action Discovery Deposition Transcript of Gordon Mott, taken on April 24, 2001, Cigar Aficionado executive	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
344 TTABVUE 0968-1070	Designated Federal Action Discovery Deposition Transcript of Marc Perez, Dunhill buyer, taken on July 02, 2001. Dunhill.	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
344 TTABVUE 1071-1120	Designated Federal Action Discovery Deposition Transcript of Fernando M. Perez Valdes, Employee at establishment that provided Cuban government bodies with taken on Dec. 05, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
345 TTABVUE 002-152	Designated Federal Action Discovery Deposition Transcript of Warren Pfaff, GC design firm, taken on April 27, 2000, ad agency's R. 30(b)6) witness	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 253-332	Designated Federal Action Discovery Deposition Transcript of Rosalie Plasencia, interpreter, taken on Sept. 21, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 333-596	Designated Federal Action Discovery Deposition Transcript of John Rano, taken on May 23 and July 19, 2000, GC's head of marketing	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
345 TTABVUE 693-790	Designated Federal Action Discovery Deposition Transcript of Lewis Rothman, retailer, taken on Oct. 31, 2000 and Feb. 14, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 098-160	Designated Federal Action Discovery Deposition Transcript of Norman Sherman, former press secretary for U.S. VP Humphrey, taken on Nov. 14, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 161-472	Designated Federal Action Discovery Deposition Transcript of Charles H. Sparkes, GC trademark custodian, taken on July 14, 2000 and Aug. 07, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 547-630	Designated Federal Action Discovery Deposition Transcript of Manuel Valdes Martinez, taken on Jan. 09, 2001. planner for Cubalse, Cuban company	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 631-671	Designated Federal Action Discovery Deposition Transcript of Michael E. Withey, U.S. attorney, taken on May 22, 2001	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
346 TTABVUE 781-959	Designated Federal Action Discovery Deposition Transcript of A. Ross Wollen, GC general counsel, taken on Nov. 30, 2000	89 TTABVUE 2-3 (Stipulation, ¶¶2-3); 91 TTABVUE (Stipulation granted)
347 TTABVUE 2-295 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Richard Carleton Hacker, GC expert, taken on June 15, 2017	132 TTABVUE 7 (Stipulation, ¶8); 135 TTABVUE (Stipulation granted)
347 TTABVUE 296-1010 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Alvin Ossip, CT's expert, taken on June 29-30, 2017	137 TTABVUE 4-5 (Stipulation, ¶5); 138 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
348 TTABVUE 1724-1847 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Rene Labor, taken on July 25, 2018. Labor was a salesman and then assistant manager of a Florida retail cigar chain from 2013-2017	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
349 TTABVUE 0002-690 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Steven Abbot, taken on Sept. 26, 2017. [redacted]	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
349 TTABVUE 0691-1120 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Edward Lahmann, taken on Nov. 16, 2017. [redacted]	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
349 TTABVUE 1121-1723 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Andrew Maturen Maal, taken on Oct. 11, 2017. [redacted]	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
350 TTABVUE 002-566 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Augustin Martinez III, taken on Sept. 28, 2017. [redacted]	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
350 TTABVUE 809-976 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Michael Cullen, taken on June 21, 2017. [redacted]	132 TTABVUE 8 (Stipulation, ¶9); 135 TTABVUE (Stipulation granted)
350 TTABVUE 977-1450 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of Michael Harris, taken on Sept. 14, 2017. [redacted]	132 TTABVUE 8 (Stipulation, ¶9); 135 TTABVUE (Stipulation granted)
351 TTABVUE 002-566 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Augustin Martinez III, taken on Sept. 28, 2017. [redacted]	137 TTABVUE 2-3 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
351 TTABVUE 809-976 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Michael Cullen, taken on June 21, 2017. [redacted]	132 TTABVUE 8 (Stipulation, ¶9); 135 TTABVUE (Stipulation granted)
351 TTABVUE 977-1450 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Michael Harris, taken on Sept. 14, 2017. [redacted]	132 TTABVUE 8 (Stipulation, ¶9); 135 TTABVUE (Stipulation granted)
352 TTABVUE 0002-788 (Public)	Designated TTAB Discovery Deposition Transcript and Exhibits of GC's Rule 30(b)(6) Witness (Eugene Paul Richter, III), taken on November 21, 2017. Richter has been GC's Vice-President of Sales since 2012	37 C.F.R. § 2.120(k)(1), TBMP § 704.09
353 TTABVUE 0002-788 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of GC's Rule 30(b)(6) Witness (Eugene Paul Richter, III), taken on November 21, 2017. Richter has been GC's Vice-President of Sales since 2012	37 C.F.R. § 2.120(k)(1), TBMP § 704.09
353 TTABVUE 0789-1010 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Blair Smith, taken on July 27, 2018. [redacted]	137 TTABVUE 2 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
353 TTABVUE 1011-1350 (Confidential)	Designated TTAB Discovery Deposition Transcript and Exhibits of Victoria McKee Jaworski, taken on October 13, 2017. [redacted]	137 TTABVUE 2 (Stipulation, ¶1); 138 TTABVUE (Stipulation granted)
354 TTABVUE 002-261 (Public)	TTAB Trial Examination of Steven Abbot, taken on December 13, 2019. [redacted]	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections
355 TTABVUE 262-695 (Confidential)	TTAB Trial Examination of Eugene Paul Richter, III, taken on November 24, 2019. Richter has been GC's Vice-President of Sales since 2012	Trail Testimony, 37 C.F.R. § 2.123(a)(1), subject to Evidentiary Objections

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TTABVUE No. [2]	Description of Item	Stipulation Addressing Admissibility
360 TTABVUE (Public)	TTAB Trial Examination of Alan Willner, taken on December 13, 2019. [redacted]	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
361 TTABVUE (Confidential)	TTAB Trial Examination of Alan Willner, taken on December 13, 2019. [redacted]	Trail Testimony, 37 C.F.R. § 2.123(a)(1)
362 TTABVUE 703-997	TTAB Discovery Deposition of GC's expert, Richard Carleton Hacker, taken on June 15, 2017	132 TTABVUE 7 (Stipulation, ¶8); 135 TTABVUE (Stipulation granted)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registration No. 1147309
For the mark COHIBA
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273
For the mark COHIBA
Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO d.b.a. CUBATABACO,

Petitioner,

v.

GENERAL CIGAR CO., INC.,

Respondent.

Cancellation No. 92025859

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PETITIONER'S EVIDENTIARY OBJECTIONS

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Dated: July 1, 2021

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Empresa Cubana del Tabaco d.b.a Cubatabaco ("CT") submits the following evidentiary objections:

With regard to the trial testimony and discovery depositions taken in this proceeding, CT identifies the following evidentiary objections:

No.	Description	TTABVUE No.[1]	Objection
1.	Declaration of Steven Abbot, Paragraph 8(d): "U.S. consumers of premium cigars are well aware that since 1962, the U.S. Government has imposed a strict embargo on commercial importation and sale of Cuban-origin goods. As a result, they are aware that no Cuban cigar may be commercially sold in the United States, and that any cigar they buy from a U.S. cigar store or a U.S. cigar Internet or mail-order merchant is not a Cuban cigar."	287 TTABVUE 5	**FRE 403, 602, 701**: Abbot's testimony and lay opinion as stated is limited to premium cigar consumers. To the extent not so limited or concerns cigar consumers who purchase cigars at gas stations or convenience or liquor stores, they are not admissible because speculative; lack of foundation; and opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). Abbot testifies only as to premium cigar consumers, which is different than the non-premium segment of the U.S. cigar market. *See* 347 TTABVUE 51-52 (Deposition of Richard Carleton Hacker, taken on June 15, 2017, "Hacker Dep.", at 49:24-50:2) (Hacker testifies that "Premium cigar smokers is one segment of the market"; "the other segment [is] mass-produced cigars, machine-made cigars.")  Moreover, there is no evidence that Abbot had any conversations with U.S. premium cigar consumers about their awareness of the restrictions of the U.S. embargo against Cuba.

[1] Citations to the Parties' confidential filings with the Board assume that there is a cover page added to the first page of the docket entry.

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No.	Description	TTABVUE No.[1]	Objection
2.	Declaration of Steven Abbot, Paragraph 8(e): "U.S. consumers do not buy a COHIBA cigar on impulse or without considering the purchase and other cigar options before parting with their money. They are thus unlikely to be confused into thinking, before making a decision to buy a General Cigar COHIBA, that the cigar originates in Cuba or is sponsored or approved by a Cuban cigar maker."	287 TTABVUE 5-6	**FRE 403, 602, 701**: Abbot's testimony and lay opinion as stated is not limited to premium cigar consumers. To the extent it is not limited to premium cigar consumers or concerns cigar consumers who purchase cigars at gas stations or convenience or liquor stores, Abbot's testimony and lay opinion are not admissible because speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). *See* Evidentiary Objection No. 1.
3.	Declaration of Steven Abbot, Paragraph 8(g): "U.S. premium cigar consumers are well aware that this is a different cigar from the COHIBA sold by General Cigar in the U.S., and that they cannot buy this "Cohiba" in the U.S."	287 TTABVUE 6	**FRE 403, 602, 701**: speculation, lack of foundation and opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a), to the extent that his opinion concerning U.S. premium cigar consumers' awareness that Cuban Cohiba cigar is "different" than the GC Cohiba and they cannot buy the Cuban Cohiba in the U.S. is based on his "own knowledge, discussions with consumers." 355 TTABVUE 88-89 (Abbot Examination, at 87:14-88:7). [redacted] Moreover, there is no evidence that Abbot had any conversations with U.S. premium cigar consumers about their awareness of the restrictions of the U.S. embargo against Cuba. Additionally, Abbot's testimony and lay opinion as stated is limited to premium cigar consumers. To the extent not so limited or concern cigar consumers who purchase cigars at gas stations or convenience or liquor stores, they are not admissible because speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). *See* Evidentiary Objection No. 1.

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No.	Description	TTABVUE No.[1]	Objection
4.	Declaration of Steven Abbot, Paragraph 31: "As the manager who was charged with marketing the COHIBA cigar to U.S. consumers, and who continues to work in the marketing of premium cigars, and based on my many interactions with cigar consumers and retailers, I have concluded that the decision of a consumer to purchase COHIBA cigars is made carefully, not casually or without knowledge as to what is being bought. COHIBA is not an 'impulse buy.'"	287 TTABVUE 17-18	**FRE 403, 602, 701**: Abbot's testimony and lay opinion as stated is limited to premium cigar consumers. To the extent not so limited or concern cigar consumers who purchase cigars at gas stations or convenience or liquor stores, they are not admissible because speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). *See* Evidentiary Objection No. 1.

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No.	Description	TTABVUE No.[1]	Objection
5.	Declaration of Steven Abbot, Paragraph 37: "Given the long duration of the embargo, I do not believe there are any appreciable number of premium cigar smokers who are unaware that Cuban cigars are barred from sale in the United States, or who believe that cigars that can be commercially purchased in the United States either were made in Cuba or originate with or are approved by a Cuban manufacturer."	287 TTABVUE 20	**FRE 403, 602, 701**: Inference merely from length of embargo is speculative, lacks foundation and is not "rationally based on the witness's perception." Fed. R. Evid. 701(a). Abbot's testimony and lay opinion as stated is limited to premium cigar consumers. To the extent not so limited or concern cigar consumers who purchase cigars at gas stations or convenience or liquor stores, they are not admissible because speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). *See* Evidentiary Objection No. 1. To the extent, if any, that Abbot's testimony has an adequate foundation in his knowledge that consumers know that the embargo bars importation of Cuban cigars, his testimony that consumers also believe that Cohiba cigars made in a third-country are not approved by a Cuban manufacturer is speculative, lacks foundation, and not rationally related to his knowledge, if any, that consumers know that the importation of Cuban cigars is prohibited.

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No.	Description	TTABVUE No.[1]	Objection
6.	Declaration of Steven Abbot, Paragraph 39: "U.S. cigar consumers have been aware for many years …that the cigar brands they buy or see advertised in the United States have no current connection with the corresponding parallel brands used by the Cuban state tobacco monopoly for non-U.S. exports."	287 TTABVUE 21	**FRE 403, 602, 701**: Abbot's testimony and lay opinion as stated is not limited to premium cigar consumers. To the extent they are not limited to premium cigar consumers or concern cigar consumers who purchase cigars at gas stations or convenience or liquor stores, they are not admissible because speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a). *See* Evidentiary Objection No. 1. [redacted] speculative; lack of foundation; opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a).
7.	BLANK		

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No.	Description	TTABVUE No.[1]	Objection
8.	Declaration of Steven Abbot, Paragraph 59	287 TTABVUE 33	**FRE 403, 602, 701**: opinion that "General Cigar's COHIBA cigars are considered to be of high quality and comparable to the best of Cuban cigars" is vague, misleading, confusing, as it does not identify who Abbot believes has this opinion; lacks an adequate foundation and opinion not "rationally based on the witness's perception." Fed. R. Evid. 701(a). Abbot cites to Annex CC to support his claim that "The General Cigar COHIBA has received numerous positive ratings and reviews from magazine and on-line cigar reviewers in the cigar press"; however, neither Annex CC nor any other annex includes any positive ratings or press reviews. Annex CC consists of two pages of consumer reviews located on GC's website (each page is reproduced twice). Annex CC shows that there are 54 more pages of reviews which GC did not include. Even as to the handful of consumer reviews GC attached, they include statements like "rough tasting" "a let down for me" and "consistently have a 'plastic' taste to me. I'm now leary [*sic*]" 290 TTABVUE 181-82.
9.	Abbot Examination 129:13-130:5	355 TTABVUE 131	**FRE 403, 602**: lack of foundation; speculative, as to Abbot's knowledge of sales in the marketplace.
10.	Abbot Examination 131:13-19	355 TTABVUE 133	**FRE 403, 602**: lack of foundation; speculative, as to Abbot's knowledge of price increases of other consumer goods
11.	Abbot Examination 131:25-132:5	355 TTABVUE 133	**FRE 403, 602**: lack of foundation; speculative, as to Abbot's knowledge of price increases of other consumer goods
12.	Abbot Dep. 306:3-7	349 TTABVUE 270	**FRE 403, 602**: lack of foundation; speculative
13.	Abbot Dep. 306:19-307:1	349 TTABVUE 270	**FRE 403, 602**: lack of foundation; speculative

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14.	Declaration of Richard Carleton Hacker, Paragraph 21: "Today's cigar smokers and potential cigar smokers are much more sophisticated and informed than those of 1992 or 2002 regarding the origin and quality of premium cigars, particularly when they are considering making a purchase of cigars."	273 TTABVUE 9	**FRE 702**: 1. Opinion inadmissible expert opinion because not "based on sufficient facts or data," Fed. R. Civ. P. 702(b). Hacker primarily, or substantially, bases his testimony on his assertion that "premium cigar smokers get information on brands … primarily from the internet today", 347 TTABVUE 53 (Hacker Examination 51:14-23), and cigar apps for mobile devices "are another source of available information." 273 TTABVUE 10 (¶24). However, he is not qualified to testify as to what information and its accuracy consumers are exposed to by those sources of information, and does not establish a foundation for testifying on that. By his own account, Hacker is "computer illiterate," "do[esn't] have a smart phone" and has never visited the cigar apps he relies upon in his report. 347 TTABVUE 23, 36 (Hacker Dep. at 21:4-11, 34:15-25). 2. Additionally, Hacker's experiences are with ultra-high end and/or highly engaged consumers of premium cigars at physical locations, which is not representative of even all segments of the premium cigar market. He has conducted a handful of cigar seminars at high-end places, like the Ritz-Carlton, and otherwise encounters highly-engaged premium cigar smokers at places like a private cigar club in Beverly Hills, wine and cigar tastings and 10-12 retail tobacco stores in the past 2 years. 347 TTABVUE 16-17, 38-41, 48; 273 TTABVUE 7-8, 24. 3. Hacker's visits to retail stores are an inadequate foundation for his opinion. He acknowledges that the number of tobacco stores are "dwindling," 347 TTABVUE 38; "there are fewer of them each year" across the whole country. *Id.* at 46. He has used no methodology at all to extrapolate his personal anecdotes at a dwindling number of physical locations to the entire U.S. premium cigar consuming population who "get information on brands…primarily from the internet today", let alone a methodology

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No.	Description	TTABVUE No.[1]	Objection
			that might be tested for its validity and reliability, as required by Fed. R. Evid. 702. 4. Hacker's testimony and expert opinion as stated is limited to premium cigar consumers. To the extent not so limited, they are not admissible because not "based on sufficient facts or data," Fed. R. Civ. P. 702(b). Hacker "do[es]n't deal with" mass market cigars; his report is not about that part of the cigar market. 347 TTABVUE 38, 51-52.
15.	Declaration of Richard Carleton Hacker, Paragraph 23: "From my experience, I have concluded that the potential purchaser of premium cigars is far better informed and more sophisticated about the origin and nature of premium cigars than the consumer of 18 or 20 years ago was, and particularly about the General Cigar Cohiba cigar."	273 TTABVUE 10	**FRE 702**: Hacker's opinion is inadmissible expert opinion because the testimony is not "based on sufficient facts or data," Fed. R. Civ. P. 702(b), and for the reasons stated in Evidentiary Objection No. 14.
16.	Declaration of Richard Carleton Hacker, Paragraph 26: "One very important fact in the cigar market, which in my experience is known to even potential smokers of premium cigars, is that the U.S. embargo against Cuba, which has been in place for close to sixty years, prohibits the commercial importation or sale of Cuban cigars in the U.S."	273 TTABVUE 11	**FRE 702**: *See* Evidentiary Objection No. 14, ¶ 4.

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No.	Description	TTABVUE No.[1]	Objection
17.	Declaration of Richard Carleton Hacker, Paragraph 28: "From my thousands of interactions with both cigar smokers and tobacconists, I have concluded that today, potential and actual smokers of premium cigars are aware that they cannot legally obtain Cuban cigars, including the Cuban Cohiba cigar, in the U.S. They are also aware that the Cohiba cigars made by General Cigar and sold in the U.S. is completely different and unconnected to the Cuban cigar, because they can buy the former but not the latter."	273 TTABVUE 12	**FRE 702**: Hacker's opinion is not admissible because it is not "based on sufficient facts or data," Fed. R. Civ. P. 702(b). Hacker opines on whether premium cigar consumers understand that Cuban cigars cannot be sold in the U.S., which does not address association confusion. It is unclear whether Hacker addresses association confusion at all, as he only asserts that consumers know that the two *cigars* are "completely different and unconnected," and, in any event, his opinion that there is no association connection, if that is what he meant, expressly rests entirely on the patently fallacious assumption that consumers know there is no association "because they can buy the [GC Cohiba] but not the [Cuban Cohiba]." Hacker never asked consumers about whether the GC Cohiba is connected to the Cuban Cohiba. 347 TTABVUE 107-10. Hacker's opinion, in addition to being contradicted by his own testimony supporting likelihood of confusion, CT's Opening Trial Brief at pp.48-49, is based on negative inferences he draws from consumers not asking him questions or volunteering comments indicating that "he or she was confusing" the GC Cohiba with the Cuban Cohiba, 273 TTABVUE 8 (¶17), an unreliable inference that, moreover, does not apply to association confusion. *See also* Evidentiary Objection No. 14, ¶ 4. As to Hacker's opinion with respect to premium cigar consumers, *see* Evidentiary Objection No. 14 ¶ 2.

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No.	Description	TTABVUE No.[1]	Objection
18.	Declaration of Richard Carleton Hacker, Paragraph 31: "Where the consumer is thinking about buying the General Cigar Cohiba, they will always know in advance – from Internet information, from the origin information put on cigar labels and boxes, and from the generally known fact that the embargo prohibits sale of Cuban cigars in the U.S. – that they are buying a non-Cuban cigar, not the Cohiba produced in Cuba."	273 TTABVUE 13	**FRE 702**: Hacker's opinion is not admissible under Fed. R. Evid. 702. Hacker's experiences are with ultra-high end consumers of premium cigars, which are not representative of even all segments of the premium cigar market. He has used no methodology at all to extrapolate his personal anecdotes at a dwindling number of physical locations to the entire U.S. premium cigar consuming population who "get information on brands…primarily from the internet today", let alone a methodology that might be tested for its validity and reliability, as required by Fed. R. Evid. 702. To the extent Hacker bases his opinion on information on the internet and cigar apps, *see* Evidentiary Objection No. 14, ¶ 1. *See also* Evidentiary Objection No. 14, ¶ 4.
19.	Declaration of Richard Carleton Hacker, Paragraph 32	273 TTABVUE 13	**FRE 702**: Hacker's opinion is not admissible under Fed. R. Evid. 702. Hacker's experiences are with ultra-high end consumers of premium cigars, which is not representative of even all segments of the premium cigar market. He has used no methodology at all to extrapolate his personal anecdotes at a dwindling number of physical locations to the entire U.S. premium cigar consuming population who "get information on brands…primarily from the internet today", let alone a methodology that might be tested for its validity and reliability, as required by Fed. R. Evid. 702. *See also* Evidentiary Objection No. 14, ¶¶ 1, 4.
20.	Declaration of Eugene Paul Richter, III, Paragraph 24	282 TTABVUE 7	**FRE 403, 602, 701**: speculation, lack of foundation and opinion not "rationally based on the witness's perception," Fed. R. Evid. 701(a), as to Richter's opinion that "Cigar smokers and merchants generally know that under Federal law, it is illegal to sell any Cuban cigar in the United States."

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No.	Description	TTABVUE No.[1]	Objection
21.	TTAB Discovery Deposition of General Cigar's Rule 30(b)(6) Witness (Eugene Richter III) ("Rule 30(b)(6) Dep.") 301:22-302-10	353 TTABVUE 273-74	**FRE 602, 802**: hearsay; lack of foundation; vague
22.	Rule 30(b)(6) Dep. 303:5-9	353 TTABVUE 275	**FRE 602**: lack of foundation; compound question; vague
23.	BLANK		
24.	Examination of Eugene Paul Richter, III ("Richter Examination") 154:9-21	354 TTABVUE 415	mischaracterization
25.	Richter Examination 157:21-158:3	354 TTABVUE 418-19	Leading
26.	Richter Examination 164:4-6	355 TTABVUE 425	outside the scope of cross-examination
27.	Richter Examination 164:12-13	355 TTABVUE 425	outside the scope of cross-examination
28.	Richter Examination 164:20-21	355 TTABVUE 425	outside the scope of cross-examination; leading
29.	Richter Examination 165:4-6	355 TTABVUE 426	outside the scope of cross-examination; leading
30.	Richter Examination 165:15-18	355 TTABVUE 426	outside the scope of cross-examination; leading
31.	Richter Examination 166:8-9	355 TTABVUE 427	outside the scope of cross-examination
32.	Richter Examination 166:19-20	355 TTABVUE 427	outside the scope of cross-examination
33.	Richter Examination 167:8-11	355 TTABVUE 428	outside the scope of cross-examination; leading
34.	Richter Examination 167:14-18	355 TTABVUE 428	outside the scope of cross-examination; leading
35.	Maturen Dep. 254:8-15	349 TTABVUE 1346	**FRE 403, 602**: Vague, does not identify marketing materials; leading

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No.	Description	TTABVUE No.[1]	Objection
36.	Maturen Dep. 257:7-10	349 TTABVUE 1349	Vague; leading
37.	Maturen Dep. 263:20-264:1	349 TTABVUE 1355	Compound question, vague, leading
38.	Maturen Dep. 266:4-269:11	348 TTABVUE 1358-62	Witness testimony based on exhibit GC did not designate, exhibit is improper evidence, does not qualify as printed materials, no source or date included, GC's own counsel recognizes that it is cut off
39.	Maturen Dep. 268:14-18	348 TTABVUE 1360	**FRE 403, 602**: speculative, lack of foundation
40.	Martinez Dep. 339:15-340:5	350 TTABVUE 274-75	**FRE 602**: lack of foundation; speculative; vague
41.	BLANK		
42.	Martinez Dep. 341:22-342:3, 343:13-14, 345:10-16	350 TTABVUE 276-80	**FRE 602**: lack of foundation; calls for expert opinion; vague
43.	Martinez Dep. 347:15-16	350 TTABVUE 282	**FRE 602**: lack of foundation; calls for expert opinion; vague
44.	Martinez Dep. 348:7-8	350 TTABVUE 283	**FRE 602**: lack of foundation; calls for expert opinion; vague,
45.	Lahmann Dep. 207:20-208:1	348 TTABVUE 884-85	**FRE 602**: lack of foundation; vague; compound question
46.	Mustafa Examination 7:4-6	363 TTABVUE 9	outside the scope of direct testimony
47.	Mustafa Examination 8:2-5	363 TTABVUE 10	outside the scope of direct testimony
48.	Mustafa Examination 8:11-14	363 TTABVUE 10	outside the scope of direct testimony
49.	Mustafa Examination 8:21-23	363 TTABVUE 10	outside the scope of direct testimony
50.	Mustafa Examination 18:24-19:3	363 TTABVUE 20	outside the scope of direct testimony

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No.	Description	TTABVUE No.[1]	Objection
51.	Mustafa Examination 37:24-25	363 TTABVUE 37	vague
52.	Mustafa Examination 45:8-15	363 TTABVUE 47	compound question
53.	Mustafa Examination 51:5-9	363 TTABVUE 53	vague
54.	Mustafa Examination 53:21-25	363 TTABVUE 55	outside the scope of direct testimony
55.	Mustafa Examination 54:10-13	363 TTABVUE 56	outside the scope of direct testimony
56.	Mustafa Examination 54:22-55:3	363 TTABVUE 56	outside the scope of direct testimony
57.	Mustafa Examination 55:9-13	363 TTABVUE 57	outside the scope of direct testimony
58.	Mustafa Examination 55:19-22	363 TTABVUE 57	outside the scope of direct testimony
59.	Mustafa Examination 56:18-22	363 TTABVUE 58	outside the scope of direct testimony
60.	Mustafa Examination 57:4-6	363 TTABVUE 59	outside the scope of direct testimony
61.	Mustafa Examination 57:11-15	363 TTABVUE 59	outside the scope of direct testimony
62.	Mustafa Examination 66:21-22	363 TTABVUE 68	outside the scope of direct testimony
63.	Mustafa Examination 67:19-25	363 TTABVUE 69	outside the scope of direct testimony
64.	Mustafa Examination 69:7-8	363 TTABVUE 71	mischaracterization
65	Mustafa Examination 75:6-12	363 TTABVUE 77	compound question; vague; mischaracterization
66	Mustafa Examination 91:19-20	363 TTABVUE 93	outside the scope of direct testimony

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No.	Description	TTABVUE No.[1]	Objection
67	Mustafa Examination 91:24-25	363 TTABVUE 93	outside the scope of direct testimony
68	Mustafa Examination 92:6-7	363 TTABVUE 94	outside the scope of direct testimony
69	Mustafa Examination 98:17-21	363 TTABVUE 100	outside the scope of direct testimony
70	Mustafa Examination 104:10-14	363 TTABVUE 106	outside the scope of direct testimony
71	Mustafa Examination 106:13-16	363 TTABVUE 108	outside the scope of direct testimony
72	Mustafa Examination 106:20-22	363 TTABVUE 108	outside the scope of direct testimony
73	Mustafa Examination 107:12-14	363 TTABVUE 109	outside the scope of direct testimony
74	Mustafa Examination 108:5-7	363 TTABVUE 110	outside the scope of direct testimony
75	Mustafa Examination 108:11-13	363 TTABVUE 110	outside the scope of direct testimony
76	Mustafa Examination 122:24-123:3	363 TTABVUE 124	outside the scope of direct testimony
77	Mustafa Examination 123:10-13	363 TTABVUE 125	outside the scope of direct testimony
78	Mustafa Examination 127:13-15	363 TTABVUE 128	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
79	Mustafa Examination 128:14-19	363 TTABVUE 130	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
80	Mustafa Examination 130:22-131:1	363 TTABVUE 132	Vague, misleading, confusing
81	Mustafa Examination 131:6-10	363 TTABVUE 133	vague, misleading, confusing
82	Mustafa Examination 132:5-10	363 TTABVUE 134	outside the scope of direct testimony; calls for speculation

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No.	Description	TTABVUE No.[1]	Objection
83	Mustafa Examination 133:18-20	363 TTABVUE 135	outside the scope of direct testimony; calls for speculation
84	Mustafa Examination 137:20-22	363 TTABVUE 139	outside the scope of direct testimony
85	Mustafa Examination 171:9-11	363 TTABVUE 173	outside the scope of direct testimony; calls for speculation
86	Mustafa Examination 172:23-24	363 TTABVUE 174	outside the scope of direct testimony; vague, misleading, confusing
87	Mustafa Examination 173:5-11	363 TTABVUE 175	outside the scope of direct testimony
88	Mustafa Examination 178:2-4	363 TTABVUE 180	vague, misleading, confusing
89	Mustafa Examination 178:7-10	363 TTABVUE 180	outside the scope of direct testimony; vague
90	Mustafa Examination 178:16-19	363 TTABVUE 180	vague, misleading, confusing
91	Mustafa Examination 179:22-25	363 TTABVUE 181	outside the scope of direct testimony; vague
92	Mustafa Examination 184:24-185:1	363 TTABVUE 186	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
93	Mustafa Examination 190:22-23	363 TTABVUE 192	mischaracterization
94	Mustafa Examination 193:18-20	363 TTABVUE 195	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
95	Mustafa Examination 193:25-194:3	363 TTABVUE 195	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
96	Mustafa Examination 194:13-16	363 TTABVUE 196	**FRE 403, 602**: outside the scope of direct testimony; calls for speculation
97	Mustafa Examination 205:4-6	363 TTABVUE 207	outside the scope of direct testimony
98	Bailey Examination 19:9-11	364 TTABVUE 233	vague, misleading, confusing

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No.	Description	TTABVUE No.[1]	Objection
99	Bailey Examination 21:20-21	364 TTABVUE 235	vague, misleading, confusing
100	Bailey Examination 22:3-7	364 TTABVUE 236	vague, misleading, confusing
101	Bailey Examination 41:7-16	364 TTABVUE 255	compound question
102	Bailey Examination 56:24-57:2	364 TTABVUE 270-271	calls for legal conclusion
103	Bailey Examination 58:20-25	364 TTABVUE 272	mischaracterization of the evidence
104	Bailey Examination 66:23-25	364 TTABVUE 280	vague, misleading, confusing
105	Bailey Examination 79:24-80:2	364 TTABVUE 293-294	**FRE 602**: lack of foundation
106	Bailey Examination 80:7-10	364 TTABVUE 294	**FRE 602**: lack of foundation
107	Bailey Examination 88:22-25	364 TTABVUE 302	vague, misleading, confusing
108	Bailey Examination 89:21-23	364 TTABVUE 303	beyond the scope of direct testimony
109	Bailey Examination 90:19-20	364 TTABVUE 304	**FRE 602**: lack of foundation
110	Bailey Examination 94:20-24	364 TTABVUE 308	vague; mischaracterization of the evidence
111	Bailey Examination 100:8-12	364 TTABVUE 314	mischaracterization of the evidence
112	Bailey Examination 104:20-22	364 TTABVUE 318	**FRE 403, 602**: calls for speculation; beyond the scope of direct testimony
113	Bailey Examination 105:5-7	364 TTABVUE 319	**FRE 403, 602**: calls for speculation; beyond the scope of direct testimony
114	Bailey Examination 106:3-4	364 TTABVUE 320	beyond the scope of direct testimony

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No.	Description	TTABVUE No.[1]	Objection
115	Bailey Examination 108:5-8	364 TTABVUE 320	compound question; vague, misleading, confusing
116	Bailey Examination 124:6-9	364 TTABVUE 338	vague, misleading, confusing
117	Bailey Examination 124:24-125:3	364 TTABVUE 338-339	beyond the scope of direct testimony
118	Bailey Examination 126:3-5	364 TTABVUE 340	beyond the scope of direct testimony
119	Bailey Examination 126:13-15	364 TTABVUE 340	**FRE 602**: lack of foundation
120	Bailey Examination 127:24-128:2	364 TTABVUE 341	assumes facts not in evidence
121	Bailey Examination 129:16-20	364 TTABVUE 343	**FRE 602**: vague, misleading, confusing, lack of foundation
122	Bailey Examination 132:16-18	364 TTABVUE 346	**FRE 401, 402**: vague, misleading, confusing; not relevant
123	Bailey Examination 132:24-133:2, 133:8-9	364 TTABVUE 346-347	**FRE 403, 602**: calls for speculation; beyond the scope of direct testimony
124	Bailey Examination 134:23-25	364 TTABVUE 348	**FRE 403, 602**: calls for speculation
125	Bailey Examination 136:5-7	364 TTABVUE 350	beyond the scope of direct testimony
126	Bailey Examination 136:13-17	364 TTABVUE 350	beyond the scope of direct testimony
127	Bailey Examination 140:20	364 TTABVUE 354	vague, misleading, confusing
128	Bailey Examination 144:25-145:3	364 TTABVUE 358-359	**FRE 403, 602**: calls for speculation
129	Bailey Examination 145:11-15	364 TTABVUE 359	**FRE 403, 602**: calls for speculation
130	Linehan Examination 21:23-25	364 TTABVUE 23	outside the scope of direct testimony

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No.	Description	TTABVUE No.[1]	Objection
131	Linehan Examination 52:11-13	364 TTABVUE 54	lack of foundation as to knowledge of the General Cigar trade dress
132	Linehan Examination 52:19-21	364 TTABVUE 54	lack of foundation as to knowledge of the General Cigar trade dress
133	Linehan Examination 55:8-9	364 TTABVUE 57	lack of foundation as to knowledge of the General Cigar trade dress
134	Gluth Examination 36:23-25	364 TTABVUE 158	**FRE 401, 402**: outside the scope of direct testimony; not relevant
135	Gluth Examination 37:6	364 TTABVUE 159	**FRE 401, 402**: outside the scope of direct testimony; not relevant
136	Gluth Examination 39:9-11	364 TTABVUE 161	**FRE 403, 602**: calls for speculation
137	Gluth Examination 59:18-23	364 TTABVUE 181	mischaracterization
138	Babot Examination 12:10-13 (re-read 13:2)	359 TTABVUE 13-14	12-A.[2] as to form, vague, misleading and confusing. Also, proper question would ask whether the witness has been shown in advance any of the questions prepared by Cubatabaco's counsel that he will be asked at this examination.
139	Babot Examination 13:4-8	359 TTABVUE 14	12-B. as to form, vague, misleading and confusing. Also, proper question would ask whether the witness has been shown in advance any of the questions prepared by General Cigar's counsel that he will be asked at this examination.
140	Babot Examination 13:11-14	359 TTABVUE 14	20-A. as to form, vague, misleading and confusing. A proper question would ask whether the witness has been told what specific written questions will be asked of him today by Cubatabaco's counsel
141	Babot Examination 13:20-24	359 TTABVUE 14	20-B. as to form, vague, misleading and confusing. A proper question would ask whether the witness has been told what specific written questions will be asked of him today by General Cigar's counsel.

[2] The number before the objection, both here and below, refers to the question number in the transcript. The examinations of Enrique Babot Espinosa and Lisset Fernández García were taken on written questions.

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No.	Description	TTABVUE No.[1]	Objection
142	Babot Examination 15:14-15	359 TTABVUE 16	36. as to form, vague, misleading and confusing as "write" does not distinguish between draft, redraft, reviewing final product or similar concepts.
143	Babot Examination 15:24-16:1	359 TTABVUE 16-17	38. as to form, vague, misleading and confusing.
144	Babot Examination 16:5-10	359 TTABVUE 17	39. as to form, vague, misleading and confusing.
145	Babot Examination 16:14-19	359 TTABVUE 17	40. as to form, vague, misleading and confusing.
146	Babot Examination 16:23-17:1	359 TTABVUE 17-18	41. as to form, vague, misleading and confusing.
147	Babot Examination 17:5-10	359 TTABVUE 18	42. as to form, vague, misleading and confusing.
148	Babot Examination 17:21-24	359 TTABVUE 18	44. as to form, vague, misleading and confusing.
149	Babot Examination 20:19-21:1	359 TTABVUE 21-22	45-K. witness should only refer to Spanish; lack of foundation that witness is competent in English.
150	Babot Examination 22:11-23	359 TTABVUE 23	47. as to form, does not define "firsthand experience"; compound question; advises witness that he can answer paragraph by paragraph; as vague, misleading and confusing (from Word Doc). From Examination: Advises witness that he can answer paragraph by paragraph."
151	Babot Examination 23:12-15	359 TTABVUE 24	48. as to form, vague, misleading and confusing.
152	Babot Examination 23:18-21	359 TTABVUE 24	49. as to form, vague, misleading and confusing.
153	Babot Examination 24:18-20	359 TTABVUE 25	50-B. as to form, vague, misleading and confusing; lack of foundation.
154	Babot Examination 25:8-21	359 TTABVUE 26	53. as to form, does not define "firsthand experience" ; as to form, vague, misleading and confusing; compound question.
155	Babot Examination 25:23-26:3	359 TTABVUE 26-27	54. as to form, does not define "firsthand experience"; as to form, vague, misleading and confusing; compound question.

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No.	Description	TTABVUE No.[1]	Objection
156	Babot Examination 26:7-14, 24	359 TTABVUE 27	55. as to form, does not define "firsthand experience"; as to form, vague, misleading and confusing; compound question (from Word Doc); From Examination: advises witness that he can answer paragraph by paragraph.
157	Babot Examination 30:6-20	359 TTABVUE 31	67. beyond the scope of Declarant's Declaration; lacks foundation.
158	Babot Examination 38:14-18	359 TTABVUE 39	97. as to form, vague; lack of foundation.
159	Babot Examination 51:7-11	359 TTABVUE 52	131. to the extent it calls for legal conclusion as to U.S. law, but witness can answer as to his understanding.
160	Babot Examination 51:14-18	359 TTABVUE 52	132. to the extent it calls for legal conclusion as to U.S. law, but witness can answer as to his understanding.
161	Babot Examination 51:21-24	359 TTABVUE 52	133. to the extent it calls for legal conclusion as to U.S. law, but witness can answer as to his understanding.
162	Babot Examination 52:2-5	359 TTABVUE 53	134. beyond the scope of Declarant's Declaration; vague.
163	Babot Examination 52:8-12	359 TTABVUE 53	135. beyond the scope of Declarant's Declaration; to the extent it calls for legal conclusion as to U.S. law.
164	Babot Examination 53:3-11	359 TTABVUE 54	136. beyond the scope of Declarant's Declaration.
165	Babot Examination 53:15-23, 54:24-55:8	359 TTABVUE 54-56	137. beyond the scope of Declarant's Declaration.
166	Babot Examination 55:12-15	359 TTABVUE 56	138-A. beyond the scope of Declarant's Declaration.
167	Babot Examination 55:18-19	359 TTABVUE 56	138-B. beyond the scope of Declarant's Declaration.
168	Babot Examination 55:22-24	359 TTABVUE 56	138-C. beyond the scope of Declarant's Declaration.
169	Babot Examination 56:2-5, 11-14	359 TTABVUE 57	139-A. beyond the scope of Declarant's Declaration.
170	Babot Examination 56:18-19	359 TTABVUE 57	139-B. beyond the scope of Declarant's Declaration.

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No.	Description	TTABVUE No.[1]	Objection
171	Babot Examination 56:22-25	359 TTABVUE 57	139-C. beyond the scope of Declarant's Declaration.
172	Babot Examination 58:13-15	359 TTABVUE 59	145. as to form, vague
173	Babot Examination 58:18-20	359 TTABVUE 59	146. as to form, vague
174	Babot Examination 59:5-8	359 TTABVUE 60	147. as to form, vague
175	Babot Examination 60:6-11	359 TTABVUE 61	150. lacks personal knowledge.
176	Babot Examination 65:2-4	359 TTABVUE 66	161-B. lacks foundation.
177	Babot Examination 94:6-9	359 TTABVUE 95	245. as to relevance.
178	Babot Examination 94:15-20	359 TTABVUE 95	246. as to relevance; calls for legal conclusions as to U.S. law; misstates FDA regulations.
179	Babot Examination 94:23-95:4	359 TTABVUE 95	247. as to relevance; calls for legal conclusions as to U.S. law; misstates FDA regulations.
180	Babot Examination 95:7-10	359 TTABVUE 96	248. beyond the scope of Declarant's Declaration; as to relevance.
181	Babot Examination 95:14-17	359 TTABVUE 96	249. beyond the scope of Declarant's Declaration; as to relevance.
182	Babot Examination 95:21-96:1	359 TTABVUE 96	250. beyond the scope of Declarant's Declaration; as to relevance.
183	Babot Examination 96:9-14	359 TTABVUE 97	254. beyond the scope of Declarant's Declaration; as to relevance.
184	Babot Examination 96:19-24	359 TTABVUE 97	258. beyond the scope of Declarant's Declaration; as to relevance.
185	Babot Examination 97:4-9	359 TTABVUE 98	262. beyond the scope of Declarant's Declaration; as to relevance.
186	Babot Examination 112:18-113:1	359 TTABVUE 113-114	311. to the admission of this Exhibit as it is an incomplete printout of internet materials; mischaracterizes document.

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No.	Description	TTABVUE No.[1]	Objection
187	Babot Examination 117:22-118:1	359 TTABVUE 118-119	326. to the term "its Cuban Cohiba cigar" as vague, misleading and confusing (see General Objections).
188	Babot Examination 119:9-13	359 TTABVUE 120	330. to the term "its Cuban Cohiba cigar" as vague, misleading and confusing (see General Objections).
189	Babot Examination 128:3-10	359 TTABVUE 129	365. beyond scope of Declarant's Declaration.
190	Babot Examination 128:18-21	359 TTABVUE 129	367. beyond scope of Declarant's Declaration.
191	Babot Examination 129:23-130-1	359 TTABVUE 130	370. beyond scope of Declarant's Declaration.
192	Babot Examination 130:7-11	359 TTABVUE 131	371. beyond scope of Declarant's Declaration.
193	Babot Examination 131:1-4	359 TTABVUE 132	373. beyond scope of Declarant's Declaration.
194	Babot Examination 131:12-13	359 TTABVUE 132	374. beyond scope of Declarant's Declaration.
195	Babot Examination 132:12-15	359 TTABVUE 133	377. beyond scope of Declarant's Declaration.
196	Babot Examination 132:25-133:3	359 TTABVUE 133	378. beyond scope of Declarant's Declaration.
197	Babot Examination 133:7-11	359 TTABVUE 134	379. beyond scope of Declarant's Declaration.
198	Babot Examination 133:15-16	359 TTABVUE 134	380. beyond scope of Declarant's Declaration.
199	Babot Examination 135:16-18	359 TTABVUE 136	386-A beyond scope of Declarant's Declaration.
200	Babot Examination 135:22-25	359 TTABVUE 136	386-B beyond scope of Declarant's Declaration.
201	Babot Examination 137:14-19	359 TTABVUE 138	388. as to form, vague.
202	Babot Examination 139:16-19	359 TTABVUE 140	395. beyond the scope of Declarant's Declaration.

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No.	Description	TTABVUE No.[1]	Objection
203	Babot Examination 139:23-25	359 TTABVUE 140	396. beyond the scope of Declarant's Declaration.
204	Babot Examination 140:4-6	359 TTABVUE 141	397. beyond the scope of Declarant's Declaration.
205	Babot Examination 140:10-12	359 TTABVUE 141	398. beyond the scope of Declarant's Declaration; lack of foundation.
206	Babot Examination 140:16-18	359 TTABVUE 141	399. beyond the scope of Declarant's Declaration; lack of foundation.
207	Babot Examination 141:9-13	359 TTABVUE 142	400-C. as to form, vague, misleading and confusing.
208	Babot Examination 142:10-14	359 TTABVUE 143	404. beyond the scope of Declarant's Declaration.
209	Babot Examination 161:14-19	359 TTABVUE 189	418. mischaracterizes testimony, representation of 'notice' is not accurate.
210	Babot Examination 162:3-6	359 TTABVUE 1190-191	420. mischaracterizes testimony, representation of 'notice' is not accurate.
211	Babot Examination 162:12-15	359 TTABVUE 190	421. mischaracterizes testimony, representation of 'notice' is not accurate.
212	Babot Examination 163:1-4	359 TTABVUE 191	423. mischaracterizes testimony, representation of 'notice' is not accurate.
213	Babot Examination 163:7-10	359 TTABVUE 191	424. mischaracterizes testimony, representation of 'notice' is not accurate.
214	Babot Examination 163:18-21	359 TTABVUE 191	426. mischaracterizes testimony, representation of 'notice' is not accurate.
215	Babot Examination 164:9-12	359 TTABVUE 192	429. mischaracterizes testimony, representation of 'notice' is not accurate.
216	Babot Examination 164:15-18	359 TTABVUE 192	430. mischaracterizes testimony, representation of 'notice' is not accurate.
217	Babot Examination 165 1-4	359 TTABVUE 193	432. mischaracterizes testimony, representation of 'notice' is not accurate.
218	Babot Examination 165:7-10	359 TTABVUE 193	433. mischaracterizes testimony, representation of 'notice' is not accurate.

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No.	Description	TTABVUE No.[1]	Objection
219	Babot Examination 165:18-21	359 TTABVUE 193	435. mischaracterizes testimony, representation of 'notice' is not accurate.
220	Babot Examination 165:24-166:2	359 TTABVUE 193-194	436. mischaracterizes testimony, representation of 'notice' is not accurate.
221	Babot Examination 166:10-13	359 TTABVUE 194	438. mischaracterizes testimony, representation of 'notice' is not accurate.
222	Babot Examination 166:16-19	359 TTABVUE 194	439. mischaracterizes testimony, representation of 'notice' is not accurate.
223	Babot Examination 166:22-167:4	359 TTABVUE 194	440. mischaracterizes testimony, representation of 'notice' is not accurate.
224	Babot Examination 167:11-13	359 TTABVUE 195	442. mischaracterizes testimony, representation of 'notice' is not accurate.
225	Babot Examination 171:16-19	359 TTABVUE 195	452. mischaracterizes testimony, representation of 'notice' is not accurate.
226	Babot Examination 171:23-172:1	359 TTABVUE 195-196	453. mischaracterizes testimony, representation of 'notice' is not accurate.
227	Babot Examination 280:8-11	359 TTABVUE 308	2. as to form, vague, misleading and confusing.
228	Babot Examination 282:22-24	359 TTABVUE 310	13. as to form, vague, misleading and confusing.
229	Babot Examination 283:3-5	359 TTABVUE 311	14. as to form, vague, misleading and confusing.
230	Babot Examination 283:16-18	359 TTABVUE 311	16. as to form, vague, misleading and confusing.
231	Babot Examination 284:2-4	359 TTABVUE 312	17. as to form, vague, misleading and confusing.
232	Babot Examination 284:24-285:2	359 TTABVUE 312	19. as to form, vague, misleading and confusing.
233	Babot Examination 285:6-9	359 TTABVUE 313	20. as to form, vague, misleading and confusing.
234	Babot Examination 285:18-21	359 TTABVUE 313	21. as to form, vague, misleading and confusing.

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No.	Description	TTABVUE No.[1]	Objection
235	Babot Examination 285:24-286:1	359 TTABVUE 313	22. as to form, vague, misleading and confusing.
236	Babot Examination 286:16-19	359 TTABVUE 314	23. as to form, vague, misleading and confusing.
237	Fernandez Examination 14:23-14:1	357 TTABVUE 15	12-A. as to form, vague, misleading and confusing. Also, proper question would ask whether the witness has been shown in advance any of the questions prepared by Cubatabaco's counsel that she will be asked at this examination.
238	Fernandez Examination 14:4-7	357 TTABVUE 15	12-B. as to form, vague, misleading and confusing. Also, proper question would ask whether the witness has been shown in advance any of the questions prepared by General Cigar's counsel that she will be asked at this examination.
239	Fernandez Examination 14:13-16	357 TTABVUE 15	20-A. as to form, vague, misleading and confusing. A proper question would ask whether the witness has been told what specific written questions will be asked of her today by Cubatabaco's counsel.
240	Fernandez Examination 14:19-23	357 TTABVUE 15	20-B. as to form, vague, misleading and confusing. A proper question would ask whether the witness has been told what specific written questions will be asked of him today by General Cigar's counsel.
241	Fernandez Examination 17:10-11	357 TTABVUE 18	36. as to form, vague, misleading and confusing as "write" does not distinguish between draft, redraft, reviewing final product or similar concepts.
242	Fernandez Examination 17:21-24	357 TTABVUE 18	37. as to form, vague, misleading and confusing.
243	Fernandez Examination 18:5-7	357 TTABVUE 19	38. as to form, vague, misleading and confusing.
244	Fernandez Examination 18:11-16	357 TTABVUE 19	39. as to form, vague, misleading and confusing.
245	Fernandez Examination 18:23-19:3	357 TTABVUE 19	40. as to form, vague, misleading and confusing.
246	Fernandez Examination 19:9-12	357 TTABVUE 20	41. as to form, vague, misleading and confusing.

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No.	Description	TTABVUE No.[1]	Objection
247	Fernandez Examination 19:17-22	357 TTABVUE 20	42. as to form, vague, misleading and confusing.
248	Fernandez Examination 20:2-6	357 TTABVUE 21	43. as to form, vague, misleading and confusing.
249	Fernandez Examination 20:11-14	357 TTABVUE 21	44. as to form, vague, misleading and confusing.
250	Fernandez Examination 22:22-23:2	357 TTABVUE 23-24	45-K. lack of foundation that witness is competent in English.
251	Fernandez Examination 23:24-24:9	357 TTABVUE 24-25	46. as to form, does not define "firsthand experience"; compound question; vague, misleading and confusing.
252	Fernandez Examination 25:2-4	357 TTABVUE 26	47. as to form, does not define "firsthand experience"; compound question; vague, misleading and confusing.
253	Fernandez Examination 27:18-21	357 TTABVUE 28	53. to the extent it calls for legal conclusions as to U.S. law, but witness can answer as to her understanding.
254	Fernandez Examination 28:2-5	357 TTABVUE 29	54. to the extent it calls for legal conclusions as to U.S. law, but witness can answer as to her understanding.
255	Fernandez Examination 29:5-8	357 TTABVUE 30	56. beyond the scope of Declarant's declaration.
256	Fernandez Examination 29:11-15	357 TTABVUE 30	57-A. beyond the scope of Declarant's declaration; lack of foundation.
257	Fernandez Examination 30:13-16	357 TTABVUE 31	57-B. beyond the scope of Declarant's declaration; lack of foundation.
258	Fernandez Examination 30:22-24	357 TTABVUE 31	58. beyond the scope of Declarant's declaration; relevance.
259	Fernandez Examination 31:3-4	357 TTABVUE 32	59. beyond the scope of Declarant's declaration; relevance.
260	Fernandez Examination 32:11-13	357 TTABVUE 33	60. beyond the scope of Declarant's declaration; relevance.
261	Fernandez Examination 32:16-19	357 TTABVUE 33	61. beyond the scope of Declarant's declaration; relevance.
262	Fernandez Examination 32:22-33:1	357 TTABVUE 33-34	62. beyond the scope of Declarant's declaration; relevance.

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No.	Description	TTABVUE No.[1]	Objection
263	Fernandez Examination 33:6-11	357 TTABVUE 34	63. beyond the scope of Declarant's declaration; relevance.
264	Fernandez Examination 33:14-15	357 TTABVUE 34	64. beyond the scope of Declarant's declaration; relevance.
265	Fernandez Examination 33:18-19	357 TTABVUE 34	65. beyond the scope of Declarant's declaration; relevance.
266	Fernandez Examination 33:24-34:2	357 TTABVUE 34-35	66. beyond the scope of Declarant's declaration; relevance.
267	Fernandez Examination 34:6-10	357 TTABVUE 35	67. beyond the scope of Declarant's declaration; lack of foundation.
268	Fernandez Examination 35:2-7	357 TTABVUE 36	70. beyond the scope of Declarant's declaration; lack of foundation; mischaracterizes testimony.
269	Fernandez Examination 36:1-4	357 TTABVUE 37	72. beyond the scope of Declarant's declaration; lack of foundation
270	Fernandez Examination 36:7-11	357 TTABVUE 37	73-A. beyond the scope of Declarant's declaration; lack of foundation
271	Fernandez Examination 36:15-19	357 TTABVUE 37	73-B. beyond the scope of Declarant's declaration; lack of foundation
272	Fernandez Examination 36:22-24	357 TTABVUE 37	74. beyond the scope of Declarant's declaration; relevance.
273	Fernandez Examination 37:9-20	357 TTABVUE 38	78. beyond the scope of Declarant's declaration; relevance.
274	Fernandez Examination 37:24-38:6	357 TTABVUE 38-39	79. beyond the scope of Declarant's declaration; relevance.
275	Fernandez Examination 38:9-10	357 TTABVUE 39	80. beyond the scope of Declarant's declaration; relevance.
276	Fernandez Examination 38:15-19	357 TTABVUE 39	81. beyond the scope of Declarant's declaration; relevance.
277	Fernandez Examination 39:1-6	357 TTABVUE 40	82. beyond the scope of Declarant's declaration; lack of foundation.
278	Fernandez Examination 39:15-19	357 TTABVUE 40	84. beyond the scope of Declarant's declaration; lack of foundation.

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No.	Description	TTABVUE No.[1]	Objection
279	Fernandez Examination 39:22-25	357 TTABVUE 40	85. asked and answered.
280	Fernandez Examination 40:4-8	357 TTABVUE 41	86. asked and answered.
281	Fernandez Examination 40:13-19	357 TTABVUE 41	87. lack of foundation.
282	Fernandez Examination 40:25-41:6	357 TTABVUE 41-42	88. lack of foundation.
283	Fernandez Examination 41:11-14	357 TTABVUE 42	89. lack of foundation.
284	Fernandez Examination 42:9-15	357 TTABVUE 43	91. lack of foundation.
285	Fernandez Examination 54:7-11	357 TTABVUE 55	151. misstates testimony.
286	Fernandez Examination 55:3-9	357 TTABVUE 56	152-A. misstates testimony.
287	Fernandez Examination 56:11-15	357 TTABVUE 57	156. calls for legal conclusion as to U.S. law, but witness can answer as to her understanding.
288	Fernandez Examination 56:18-22	357 TTABVUE 57	157. calls for legal conclusion as to U.S. law, but witness can answer as to her understanding.
289	Fernandez Examination 57:4-10	357 TTABVUE 58	158. beyond the scope of Declarant's declaration.
290	Fernandez Examination 57:14-22	357 TTABVUE 58	159. beyond the scope of Declarant's declaration.
291	Fernandez Examination 58:6-9	357 TTABVUE 59	160-A. beyond the scope of Declarant's declaration.
292	Fernandez Examination 58:12-13	357 TTABVUE 59	160-B. beyond the scope of Declarant's declaration.
293	Fernandez Examination 58:17-19	357 TTABVUE 59	160-C. beyond the scope of Declarant's declaration.
294	Fernandez Examination 58:23-59:1	357 TTABVUE 59-60	161-A. beyond the scope of Declarant's declaration.

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No.	Description	TTABVUE No.[1]	Objection
295	Fernandez Examination 59:4-5	357 TTABVUE 60	161-B. beyond the scope of Declarant's declaration.
296	Fernandez Examination 59:9-12	357 TTABVUE 60	161-C. beyond the scope of Declarant's declaration.
297	Fernandez Examination 68:9-13	357 TTABVUE 69	178-A. calls for legal conclusions as to U.S. law; Lack of foundation; competence; her knowledge is not relevant.
298	Fernandez Examination 69:4-5	357 TTABVUE 70	178-B. calls for legal conclusions as to U.S. law; Lack of foundation; competence; her knowledge is not relevant.
299	Fernandez Examination 69:21-25	357 TTABVUE 70	178-C. calls for legal conclusions as to U.S. law; Lack of foundation; competence; her knowledge is not relevant.
300	Fernandez Examination 98:22-99:7	357 TTABVUE 99-100	4. calls for legal conclusion; relevance.
301	Fernandez Examination 102:16-103:2	357 TTABVUE 103-104	17. calls for legal conclusion; relevance.
302	Fernandez Examination 104:22-105:9	357 TTABVUE 105-106	24. calls for legal conclusion; relevance.
303	Fernandez Examination 107:18-108:5	357 TTABVUE 108-109	33. calls for legal conclusion; relevance.
304	Fernandez Examination 111:5-17	357 TTABVUE 112	44. calls for legal conclusion; relevance.

CT maintains the objections it made on the record at the discovery depositions and trial in the federal action between the Parties Case No. 97 Civ. 8399 (S.D.N.Y.), as stated therein. TTABVUE Docket Nos. 338, 342-346.

***Arechabala Rodrigo v. Havana Rum*, No. 22881 (TTAB Oct. 19, 1996)**

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

#15

BAC

Cancellation No. 22,881

Jose Ma. Arechabala Rodrigo

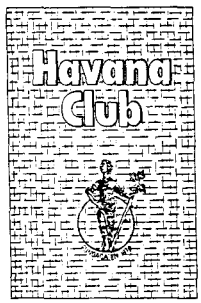
v.

Havana Rum and Liquors, S.A., dba H.R.L., S.A., and Havana Club Holding, S.A., dba HCH, S.A., joined as party defendant

Before Rice, Simms and Hanak, Administrative Trademark Judges.

By the Board:

Jose Ma. Arechabala Rodrigo, an individual residing in Madrid, Spain, on May 9, 1994, has petitioned to cancel Registration No. 1,031,651[1] for "rum" for the mark shown below:



[1]Issued January 27, 1976, based on Section 44(e) of the Trademark Act (ownership of Cuban Reg. No. 110,353 dated February 12, 1974.) Registrant disclaimed "Havana" and "Fundada en 1878" apart from the mark as shown. The drawing is lined for the color gold. Registrant filed two Section 8 affidavits of use, on January 13 and 25, 1982. The first affidavit, which refers to the mark as "still in use...", and refers to an "attached specimen" (which is not currently in the registration file), was accepted by this Office and it remains in the registration file. The second affidavit of use was returned to registrant's attorney with a letter dated June 9, 1982, explaining that only one Section 8 affidavit is necessary.

The involved registration issued to Empresa Cubana Exportadora de Alimentos y Productos Varios, dba Cubaexport (a Cuban company, hereinafter Cubaexport or original registrant). On January 10, 1994 Cubaexport assigned the mark to Havana Rum and Liquors, S.A, dba H.R.L., S.A. (a Cuban company, hereinafter HRL); and on June 22, 1994, HRL assigned the mark to Havana Club Holding, S.A., dba HCH, S.A. (a Luxembourg company, hereinafter Havana Holding). The Board instituted the petition to cancel in the name of HRL as respondent. Havana Holding was subsequently joined as a party defendant by Board order dated April 26, 1995.

As grounds for its petition to cancel petitioner alleges that he has a bona fide intent-to-use the mark HAVANA CLUB for distilled liquors in the United States, and he has filed an intent-to-use application (Serial No. 74/522,925); that respondents' mark includes the words HAVANA CLUB which are identical to the words applicant seeks to register, and rum is a distilled liquor; that petitioner anticipates that his application will be refused registration based on Reg. No. 1,031,651[2]; and that the owner of Registration No. 1,031,651 "has long abandoned the registered mark in the United States".

In its answer, respondents admitted that "petitioner's application for registration of the trademark HAVANA CLUB should be rejected", and respondents otherwise denied the

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[2]Petitioner's application Serial No. 74/522,925 (filed May 2, 1994) is currently in suspended status in Law Office 107.

salient allegations of the petition to cancel. Respondents raised the affirmative defenses of petitioner's lack of standing because the term "Havana" is of primary geographic significance and petitioner's mark is not registrable as it is geographically misdescriptive and deceptive because he is not in Cuba, and his goods would not originate in Cuba; that petitioner has no standing because respondents' HAVANA CLUB rum--because of use in foreign counties, including Spain (where petitioner resides)--is famous in the United States, and therefore, if petitioner commenced use of his mark for his goods it would be confusingly similar to respondents' famous mark; that respondents' non-use of their mark is excusable due to the legal impossibility of exporting respondents' goods to the United States; and that all owners of the involved registration have at all times intended to use the mark on the goods in the United States as soon as it is legally possible to do so.

This case now comes up on respondents' motion for summary judgment on the issue of petitioner's lack of standing, and on the issue that respondents have not abandoned their mark; and on petitioner's cross-motion for summary judgment on the same two issues.

Generally, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The purpose of summary judgment is to avoid an unnecessary

trial where additional evidence would not reasonably be expected to change the outcome. See Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); Lloyd's Food products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and Old Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In certain cases, however, even though disputes remain with respect to certain material facts, summary judgment may be granted, so long as all factual disputes are resolved in favor of the losing party and inferences drawn from the undisputed facts are viewed in the light most favorable to the losing party. See Larry Harmon Pictures Corp. v. The William's Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292, 1293 (Fed. Cir. 1991); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986) ("The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor."); and Bishop v. Wood, 426 U.S. 341, footnote 11 (1976) ("In granting summary judgment for respondents,

the District Court was required to resolve all genuine disputes as to material facts in favor of petitioner.")

Based on the evidence submitted by the parties, we find (i) that there is no genuine issue of material fact on the question of petitioner's standing and petitioner is entitled to summary judgment on that issue; and (ii) that there is no genuine issue of material fact as to the question of abandonment and respondents are entitled to judgment as a matter of law on that issue.

Turning first to the question of petitioner's standing, respondents argue that petitioner has no standing to bring this petition to cancel as a matter of law because (i) petitioner cannot register his mark, HAVANA CLUB (for distilled liquors), as it is geographically misdescriptive and deceptive if applied to goods not originating from Cuba, and it cannot originate from Cuba as petitioner cannot import distilled liquors from Cuba to the United States due to the Trading With The Enemy Act [50 USC App. 5(b)] and the Cuban Assets Control Regulations (31 CFR §515); and (ii) petitioner cannot register his mark in the United States since respondents' mark, HAVANA CLUB for rum, has achieved sufficient public recognition in the United States, based on respondents' use outside the United States, to establish that respondents have superior rights in the mark within the United States, despite the unavailability of respondents' goods in the United States.

On the question of standing petitioner contends, inter alia, that his mark is not geographically misdescriptive and that respondents' goods are being offered for production in countries other than Cuba; that he has a pending intent-to-use application which was refused registration under Section 2(d) of the Trademark Act based on respondents' registration; that his grandfather began the business of manufacturing and selling rum under the mark HAVANA CLUB in Cuba in the early 1900s (but the company was expropriated in 1960); that petitioner has an interest beyond that of the general public (i.e., he is not a mere intermeddler); that there is no requirement under the law that a plaintiff have any pending application, or that a plaintiff prove entitlement to a registration in order to have standing; and that standing requirements have been liberally construed.

As evidence petitioner submitted his declaration in which he avers that his grandfather started a business manufacturing and selling rum under the mark HAVANA CLUB in Cuba in the early 1900s; that from approximately 1934 to 1960 his family's business (Jose Arechabala, S.A.) exported HAVANA CLUB rum to the United States; that in 1960 the family business was expropriated by the Cuban government, forcing the cessation of the business and expelling family members from Cuba; and that had it not been for the expropriation of the business by the Cuban government, the family business would have continued exporting HAVANA CLUB rum to the United States.

In order to establish that there is no genuine issue of material fact as to standing, a plaintiff must prove that he is not a mere intermeddler, i.e., that he has a personal interest in the outcome of the case beyond that of the general public. See Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and Lipton Industries Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). One method by which a plaintiff may establish standing is to prove that it filed an application and that a rejection was made based on defendant's registration. Of course, a party does not have standing solely because of the allegations in its pleading. Rather, these allegations must be proven. See the Lipton case, supra, at page 189.

In this case petitioner alleged ownership of an intent-to-use application, and that he believed his application would be refused registration based on Registration No. 1,031,651. (Respondents admitted in their answer that petitioner's application should be rejected.) Petitioner stated within the arguments in his brief in support of his cross-motion for summary judgment that his application was specifically refused registration in an Office Action dated October 5, 1994. Respondents submitted a photocopy of the October 5, 1994 Office Action refusing registration to

petitioner's application Serial No. 74/522,925, based on, inter alia, respondents' Registration No.1,031,651.[3]

There is no genuine issue of material fact regarding the existence of petitioner's standing.

Respondents' argument that petitioner cannot be damaged because he cannot register his mark in the United States is not persuasive. There is no requirement that actual damage be pleaded and proved (at trial or on summary judgment) in order to establish standing or to prevail in an opposition or cancellation proceeding. See TBMP §303.03. Respondents' argument is speculative as to the possibilities of ultimate refusals to register in petitioner's pending application.

Further, respondents' reliance on the case of Coup v. Vornado Inc., 9 USPQ2d 1824 (TTAB 1988) is misplaced because that case involved the plaintiff's failure to show that it had acquired any rights in the mark VORNADO for reconditioned fans which were manufactured by another party, and plaintiff had not used the mark as a trademark for fans. That is a situation unrelated to the case at hand.

Accordingly, respondents' motion for summary judgment on the issue of petitioner's standing is denied, and petitioner's cross-motion for summary judgment on the issue of standing is granted.

Turning now to the issue of abandonment of the involved registration, respondents contend that they are entitled to

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[3]See the declaration of Caroline Rule, respondents' attorney, submitted on June 15, 1995--paragraph 5, and exhibit C thereto.

summary judgment arguing that they have not used the mark in the United States only because U. S. law prohibits respondents' use of the mark in the United States; that the Cuban Assets Control Regulations (31 CFR Part 515) forbid (i) importation of goods from Cuba or of Cuban origin into the United States, and (ii) any trademark in which a Cuban entity has, at any time since July 8, 1963 had any interest, to be used in the United States; that because use is prohibited by law, respondents' nonuse is excusable nonuse as a matter of law; and that all of the three successive owners of the involved registration have always intended to use the mark in commerce with the United States as soon as it is allowed by law, and they have never intended to abandon the mark.

Petitioner argues that respondents admit that there has been no use of their mark in the United States for 19 years; that petitioner has established a prima facie case of abandonment under Section 45 of the Trademark Act, and the burden shifts to respondents to show that they have not abandoned the mark under the law; that respondents' showing of an intent not to abandon the mark is not the proper legal test, but rather, respondents must show an intent to resume use continually from 1976 to the present; that respondents intend to "warehouse" the mark HAVANA CLUB for rum and have done so for 19 years; that the Cuban Assets Control Regulations are "permanent", whereas stoppages of use for war, prohibition, etc. have been temporary in nature; that

respondents have not produced concrete "marketing plans, advertising programs, shipment plans and distribution plans" for the 1970s, 1980s, or the 1990s; that respondents have not done all that is commercially reasonable to undertake use in the United States because one of Cubaexport's (the original registrant) officers became a member of the Cuban Ministry of Finance from 1980 to 1988 and, with Cuban officials seeking foreign investors to produce rum, it would have been "commercially reasonable for Cubaexport to meet conditions necessary to have the Trade Regulations lifted"; that Cubaexport's assignment of the mark to HRL evidenced its intent to divest itself of the mark (as a potential or inchoate property right); that HRL's subsequent assignment of the mark only five months later negates any realistic intent of HRL to use the mark in the United States; that HRL assigned the mark to Havana Holding, a Luxembourg company[4], which could then trade with the United States, except that Havana Holding immediately licensed the mark with a world-wide exclusive license to Havana Club International, S.A. (a Cuban company), thus again negating the right to trade with the United States; that Havana Holding does not control the

[4]In its papers petitioner requested that the Board take judicial notice of two separate matters: (i) that the registration is owned today by a Luxembourg company when "earlier it was, in essence and reality, owned by the Cuban Government under its communistic form of government and economy", and (ii) that "with respect to Cuba, the American public recognizes Havana as the city and capital of Cuba rather than the name of a province". Petitioner's requests that we take judicial notice of those facts are denied because such matters are not appropriate for judicial notice. See TBMP §712.

quality of the goods under the license agreement, which is therefore strong evidence of respondents' abandonment of the mark; and that the total circumstances and respondents' actions show that the mark has been abandoned as a matter of law.[5]

In their response to petitioner's cross-motion for summary judgment, respondents contend that petitioner has not even attempted to contradict the facts that (i) the owner of the mark is prohibited by law from importing Cuban rum into the United States and from using the mark in the United States, (ii) the current owner of the mark is using the mark on rum world-wide in at least 20 countries (see Prieto decl. ¶7, and Perdomo decl. I at ¶4), (iii) that the United States is a natural and historical market for Cuban rum, and that United States consumers have been exposed to HAVANA CLUB rum through, among other means, the movie "The Firm", which includes two references to HAVANA CLUB rum, the movie having been seen by 20,000,000 people in the U.S.,

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[5]Petitioner also argued that respondents' registration, being based on Section 44(e), can be correlated to an intent-to-use application with regard to (i) the requirements for assignments under Section 10 of the Trademark Act, and (ii) the requirement regarding a bona fide intent-to-use a mark. Petitioner is incorrect. A registration which issued in 1976 based on a foreign registration is not subject to the requirements of the Trademark Law Revision Act of 1988 (TLRA) regarding assignments, or bona fide intent-to-use. On these types of matters, the TLRA is not given retroactive effect. See Gordon and Breach Science Publishers S.A. v. American Institute of Physics, 859 F.Supp. 1521, 32 USPQ2d 1705 (SDNY 1994); West Indian Sea Island Cotton Association Inc. v. Threadtex Inc., 761 F. Supp. 1041, 21 USPQ2d 1881 (SDNY 1991); and Clairol Inc. v. Compagnie D'Editions et de Propegande du Journal La Vie Claire-Cevic, 24 USPQ2d 1224 (TTAB 1991).

articles in numerous U.S. magazines and newspapers, and the 400,000 United States travelers to Cuba who return to the United States with such rum (see Abarrategui decl. I at ¶6, Perdomo decl. I at ¶10, Prieto decl. ¶10, Pria decl. I at ¶8, and Diaz decl. at ¶8, and the Campagnola affidavit), and (iv) that respondents have been producing and selling the same rum under the same specifications in the same factory in Cuba under the HAVANA CLUB mark since 1972, exporting over 20 million cases of rum between 1975 and 1993 (see Abarrategui decl. I at ¶3-4, Perdomo decl. I at ¶11, Prieto decl. at ¶5-8, and Pria decl. I at ¶3-6).

Respondents argue further that each successive owner has always intended to export the goods to the United States as soon as it is legally possible to do so; that beginning in 1993 the business was reorganized with the aim of expanding world-wide exports of the rum, which led to the decision of HRL to sell the entire business to Havana Holding (the current owner of the mark) in order to assure HRL of "financing for the development of the mark internationally through the association with a foreign partner"; that HRL (a Cuban entity) is a shareholder in Havana Holding (a Luxembourg company) and, therefore, Havana Holding is prohibited from exporting the goods to the United States; that, in fact, from June 1994 to May 1995 export sales of HAVANA CLUB rum have increased by 22.6% (see Abarrategui decl. II at ¶14); that there has been continuity of some of the personnel from the 1970s to the present

involved in the HAVANA CLUB rum business; that continuous and systematic quality control has been in place since Cubaexport began to make the product, including use of CubaControl, S.A., which enforces specifications for the production of HAVANA CLUB rum; that the licensing agreement with Havana International, S.A. obligates the licensee to "maintain the same quality for which the mark has stood"[6]; that members of the Cuban Ministry of Foreign Trade as well as executives of Cubaexport held discussions with representatives of U. S. companies interested in marketing HAVANA CLUB rum in the United States (including PepsiCo Wines and Spirits International); and that petitioner has not proven abandonment, and respondents have proven that their nonuse is excusable nonuse as a matter of law because it is legally impossible for them to use their mark in the United States, and the presumption of abandonment cannot arise.

Respondents submitted the declarations of, inter alia, Miguel Antonio Pria Groso, an officer of Cubaexport from 1972 to 1980 (two declarations); Vidal Manuel Prieto Espina, managing director of HRL; Luis Francisco Perdomo Hernandez,

[6]The licensing agreement between Havana Club Holding, S.A. (licensor) and Havana Club International, S.A. (licensee) specially includes the following wording: (i) "...whose quality corresponds to the specifications of exportable rum, particularly to that of the rum marketed under the 'Trade name' (HAVANA CLUB)", that the licensee agrees to "organize the manufacturing of the 'Products' in accordance with the specifications of the 'Trade name'", the licensee must "keep independent and detailed accounts of the operations completed in relation to the 'Products'", and the licensor has the right to inspect during normal business hours with 48 hours prior notice.

vice chairman of the board of Havana Holding (two declarations); Maria Del Carmen Abarrategui Goicolea, commercial director of Havana International, S.A. (two declarations); Marta E. Sosa Brizuela, legal advisor to HRL; Philip J. Brenner, professor at the School for International Service of the American University, specializing in the study of United States-Cuban relations; and Sandra Levinson, executive director of the Center for Cuban Studies, Inc., a not-for-profit educational organization in New York; and the affidavit of Sergio Campagnola, executive vice president and general sales manager of the motion picture division of Paramount Pictures Corporation.

Abandonment of a mark is defined in Section 45(1) of the Trademark Act as "when its use has been discontinued with intent not to resume such use". The statute also states that "nonuse for two[7] consecutive years shall be prima facie evidence of abandonment". Once nonuse for two consecutive years has been shown, then the owner of the mark has the burden to demonstrate that circumstances do not justify the inference of intent not to resume use. See Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); and Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989). The presumption of

[7]Section 45(1) of the Trademark Act has been amended by P.L. 103-465, which increases from two to three years the period of time of nonuse that constitutes prima facie evidence of abandonment. This provision is effective January 1, 1996.

abandonment is readily rebutted by a showing that nonuse is due to special circumstances which excuse nonuse and is not due to any intention to abandon the mark. See Jerome Gilson, Vol. 1, Trademark Protection and Practice, §3.06[3] (1995).

The Court of Customs and Patent Appeals (the predecessor court to the Court of Appeals for the Federal Circuit) stated in the case of American Lava Corporation v. Multronics, Inc., 461 F.2d 836, 174 USPQ 107 (1972) that "Proof that a mark has not been used for two or more consecutive years makes out a prima facie case that it has been abandoned,... but the inference of abandonment is readily rebutted by a showing similar to that permitted" under Section 9(a) of excusable nonuse. The court also recognized that the Trademark Act of 1946 "evidences a more lenient attitude toward nonuse than the 1905 Act".

The Cuban Assets Control Regulations (31 CFR Part 515) prohibit, inter alia, (i) the importation into the United States of merchandise from Cuba or merchandise of Cuban origin, and (ii) the use in U.S. commerce of any trademark in which Cuba or a Cuban national has, at any time since July 8, 1963, had any interest, direct or indirect. See 31 CFR §515.201 and §515.204, and 31 CFR §515.201 and §515.311, respectively.[8]

[8]These regulations were promulgated pursuant to The Trading With The Enemy Act, 50 U.S.C. App. §5(b).

These same regulations allow for, inter alia, filing in the United States applications for trademark registrations, prosecuting said applications, receiving registration certificates and renewal certificates, and recording any instrument affecting title to trademark registrations. See 31 CFR §515.527.

The Trademark Act allows for the registration of marks under Section 44(e) based on a mark registered in the country of origin of the foreign applicant. All registrations must have a Section 8 affidavit of use or excusable nonuse filed between the fifth and sixth years, and all registrations must be renewed at the appropriate time under Section 9 of the Trademark Act in order to remain valid and subsisting. Both the Section 8 and the Section 9 affidavits must state that the registered mark is in use in commerce, or if the mark is not in use in commerce the affidavit (of either type) must show that the nonuse is due to special circumstances which excuse the nonuse, and that it is not due to any intention to abandon the mark for the involved goods or services. See Sections 8(a) and 9(a) of the Trademark Act, and Trademark Rules 2.162(f) and 2.183(c).

It is clear under the judicial interpretation of the law that abandonment does not occur under the Trademark Act where there is a temporary forced withdrawal from the market due to causes such as war, import problems, or some other involuntary action. See J. Thomas McCarthy, Vol. 2,

McCarthy on Trademarks and Unfair Competition, §17.04 (3rd ed. 1994). That is, when a party has not used a mark in the United States because such use is prohibited by U.S. law, that party has not abandoned the mark within the meaning of Section 45 of the Trademark Act. See Chandon Champagne Corporation v. San Marino Wine Corporation, 335 F.2d 531, 142 USPQ 239 (2nd Cir. 1964) ("plaintiff's forced wartime (World War II) withdrawal from the American market was not an abandonment of the mark"); F. Palicio Y Compania, S.A., et al. v. Brush, et al., 256 F. Supp. 481, 150 USPQ 607, at 616 (SDNY 1966) ("there has been no claim that the former owners have abandoned the trademarks. Nor could such claim prevail."), aff'd at 154 USPQ 75 (2nd Cir. 1967), cert. denied 389 U.S. 830 (1967); Haviland & Co., Incorporated v. Johann Haviland China Corporation, 269 F. Supp. 928, 154 USPQ 287, at 306 (SDNY 1967); Cuban Cigar Brands N.V. v. Upmann International Inc., 457 F.Supp. 1090, 199 USPQ 193, at 202 (SDNY 1978) ("the fact that plaintiff was intervened by the Cuban government and thus prevented from exporting (its goods) to this country until recently (cigars made of non-Cuban tobacco shipped from the Canary Islands) does not constitute an abandonment of the mark".); and Menendez et al. v. Faber, Coe & Gregg, Inc., et al., 345 F. Supp. 527, 174 USPQ 80, at 87 (SDNY 1972) ("trademark rights are not destroyed by temporary suspension of the business to which they are appurtenant due to causes beyond the control of their owner.."), modified in Menendez et al. v. Saks and

Company et al., 485 F.2d 1355, 179 USPQ 513 (2nd Cir. 1973). See also, Carl Zeiss Stiftung dba Carl Zeiss, et al. v. V.E.B. Carl Zeiss, Jena, et al., 293 F. Supp. 892, 160 USPQ 97 (SDNY 1968), modified 433 F.2d 686, 167 USPQ 641 (2nd Cir. 1970).

In the case before us respondents' use of their mark has been prohibited in the United States throughout the life of the registration, i.e., since 1976 (and before), and petitioner characterizes the Cuban Assets Control Regulations as "permanent".[9] We cannot agree that this situation is permanent. It is true that the regulations have remained in effect for many years, but in 1977 Congress adopted Public Law 95-223, §101(b), 91 Stat. 1626 (reprinted in 50 USCA App. §5, Note) which provided that the embargo of Cuba "shall terminate" in 1978, and also provided that the President may extend the embargo for one-year periods when it is in the national interest. Thus, the embargo expires each year (in September) unless the President extends it for another year. Further, the President is empowered to lift the embargo at any time or to modify same. In fact, over

[9]Petitioner cited the case of Silverman v. CBS, Inc., 870 F.2d 40, 9 USPQ2d 1779 (2nd Cir. 1989), cert. denied 492 U.S. 907 (1989), for the proposition that a mark is abandoned under the law once use has been discontinued with an intent not to resume use within a reasonably foreseeable future, and that respondents are in such a situation in this case because the Cuban embargo prohibition is "permanent". The Silverman case, supra, can be distinguished from the facts in the case now before us on the basis that the defendant in that case voluntarily ceased use of the mark (AMOS 'n' ANDY), which is a situation totally different from that of respondents herein, who are prohibited by law from importing their goods from Cuba into the United States.

the years the embargo regulations have been modified by the President over 70 times. See Brenner decl., pages 3-4.

The record clearly shows that for now and for the entire relevant time frame it is and has been legally impossible for respondents to use their mark in the United States. This excuses their nonuse of the mark under the Trademark Act. The record is also clear that respondents use the mark world-wide (exporting their HAVANA CLUB rum to over twenty nations), and they intend to use the mark in the United States as soon as it is legally possible to do so. As a matter of law there has been no abandonment, and there are no genuine issues of material fact regarding the question of abandonment of respondents' mark.

Accordingly, petitioner's motion for summary judgment on the issue of abandonment is denied, and respondents' motion for summary judgment on the issue of abandonment is granted. The petition to cancel is dismissed.

J. E. Rice

R. L. Simms

E. W. Hanak
Administrative Trademark
Judges, Trademark Trial
and Appeal Board

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing was served on Respondent by electronic mail on July 1, 2021 to:

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